TRANSCRIPT OF RECORD

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1904.

No. 378.

EXCELSIOR WOODEN PIPE COMPANY, APPELLANT

vs.

PACIFIC BRIDGE COMPANY AND CHARLES P. ANSON.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF WASHINGTON.

FILED JUNE 17, 1904.

(18,228.)

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EXCELSIOR WOODEN PIPE COMPANY, APPELLANT,

vs.

PACIFIC BRIDGE COMPANY AND CHARLES P. ALLEN.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF WASHINGTON.

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a In the Circuit Court of the United States for the District of Washington, Northern Division.

THE EXCELSIOR WOODEN PIPE COMPANY, a Corporation, Complainant,
vs.
PACIFIC BRIDGE COMPANY, a Corporation, and CHARLES P. Allen, Respondents.
} No. 834.

Transcript on Appeal.

Appeal from the circuit court of the United States for the district of Washington, northern division, to the Supreme Court of the United States.

1 *Bill of Complaint.*

To the honorable the judges of the circuit court of the United States for the district of Washington, northern division:

The Excelsior Wooden Pipe Company, a corporation, duly organized and existing under and by virtue of the laws of the State of California, and having its principal place of business in the city and county of San Francisco, in said State, and being a citizen of said State, complainant, brings this its bill of complaint against The Pacific Bridge Company, a corporation, created, organized and existing under and by virtue of the laws of the State of California, and having its principal place of business in the city and county of San Francisco, in said State, with branch offices in Portland, Oregon, and Seattle, Washington, and being a citizen of said State of California, and Charles P. Allen, a citizen of the United States and of the State of Colorado, and a resident of Denver, in said State, as respondents, and thereupon your orator complains and says:

1st. That heretofore, to wit, on and prior to the twenty-second day of April, 1886, Charles P. Allen, one of the respondents above named, was the original, first and sole inventor of a certain new and useful invention, to wit, a wooden pipe, more fully described in the letters patent hereinafter mentioned.

2nd. That the same was a new and useful invention, and was not known nor used by others prior to the invention thereof by the said Charles P. Allen, nor had the same been patented or described in any printed publication in this or any foreign country, before the invention or discovery of the said Charles P. Allen, and at the time of his application for letters patent thereon, as hereinafter stated, had not been in public use or on sale in the United States for two years, nor was it abandoned nor proved to have been abandoned.

2 3rd. That the said invention relates to the class of wooden pipe and to improvements therein, and was a hooped pipe composed of wooden staves, the cross-joints being interlocked by concealed metallic tongues of novel construction and arrangement, the

hoop of said pipe being composed of a novel strap belt, coupling shoe and means for engaging them; a more particular description whereof will be seen by reference to the letters patent therefor, hereinafter mentioned, to which letters patent special reference is hereby made for such further description.

4th. That the said Charles P. Allen, being, as aforesaid, the inventor thereof, did, on the twenty-second day of April, 1886, make application to the Government of the United States for the issuance to him of letters patent for said invention; and thereafter said application having lapsed under the rules and regulations of the Patent Office, said Charles P. Allen did, on the tenth day of February, 1887, duly renew said application; and, thereafter, to wit, on the twenty-second day of March, 1887, after proceedings duly and regularly had and taken in the matter of said application, letters patent of the United States were granted, issued and delivered to the said Charles P. Allen, for the said invention, granting and securing to him, his heirs and assigns, for the full term of seventeen years from the last-mentioned day, the sole and exclusive right and liberty to make, use and vend said invention, throughout the United States and territories thereof.

5th. That said letters patent were issued in due form of law, under the seal of the Patent Office of the United States, and were signed by the acting Secretary of the Interior, and countersigned by the acting Commissioner of Patents of the United States, and bear date the day and year last aforesaid, and are numbered 359,590, all of which will more fully appear from the said
3 letters patent themselves, which are ready in court to be produced by your orator, or a duly authenticated copy thereof, and of which your orator hereby makes profert.

6th. That prior to the issuance of said letters patent, all proceedings were had and taken which were required by law to be had and taken prior to the issuance of letters patent for new and useful inventions.

7th. And your orator further shows unto your honors that prior to the making and filing of this bill of complaint, and prior to the commission of the acts by the respondents, hereinafter complained of, the said Charles P. Allen, one of the respondents above named, and patentee as aforesaid, did by an instrument in writing duly executed and delivered, and dated the twentieth day of December, 1892, grant unto the Excelsior Redwood Company, a corporation, duly organized and existing under and by virtue of the laws of the State of California, and having its principal place of business in the city and county of San Francisco in said State, its successors and assigns, the exclusive right, license and privilege, within the States of northern California, Oregon, Washington, Nevada, Montana and Idaho, and Territories of Arizona and Utah, of manufacturing and selling wooden pipe under and in accordance with the said letters patent, hereinbefore named, and to the full end of the term of said letters patent, as by said exclusive license, or a duly authenticated copy thereof ready in court to be produced, will fully and at large appear.

8th. And your orator further shows unto your honors, that, thereafter, prior to the making and filing of this bill of complaint, and prior to the commission of the acts by the respondents, hereinafter complained of, the said The Excelsior Redwood Company, did, with the written consent of the said Charles P. Allen, respondent herein and patentee as aforesaid, by an instrument in writing, duly executed and delivered and bearing date the twenty-second day of December, 1892, assign and transfer unto your orator The Excelsior Wooden Pipe Company, the said exclusive license to it from said Charles P. Allen, and all rights and privileges thereunder, as by said assignment, or a duly authenticated copy thereof ready in court to be produced, will fully and at large appear.

9th. And your orator further shows, upon information and belief, that ever since the grant and issuance of said letters patent, the said Charles P. Allen, respondent above named, has been and is now the sole and exclusive owner of the same.

10th. And your orator further shows that ever since the assignment aforesaid of the Excelsior Redwood Company to your orator, The Excelsior Wooden Pipe Company, of the said exclusive license, your orator The Excelsior Wooden Pipe Company has been and now is the sole and exclusive licensee of said Charles P. Allen, respondent above named, to make and sell wooden pipe under and in accordance with said letters patent, within and throughout the States and Territories above named, for the full term of said letters patent.

11th. That your orator The Excelsior Wooden Pipe Company, in the exercise of its said exclusive license and in the enjoyment of the same has hitherto preserved and still desires and endeavors to preserve to itself, exclusively, the monopoly of making and selling the wooden pipe containing and embodying the said patented inventions throughout the territory aforesaid and to this end and to carry out such purpose and intent, your orator has been ever since the acquirement of its said exclusive license, and now is engaged in the manufacture and sale of said patented wooden pipe, and has invested large sums of money therein and has derived large gains and profits therefrom, and has been and now is prepared and willing to fill all orders and enter into and carry out all contracts for said patented wooden pipe throughout its said territory; that the said wooden pipe already made and sold by your orator under its said exclusive license has been distributed in various places throughout the said territory covered by its said exclusive license; that said wooden pipe so manufactured and sold by your orator has been put in actual use and used, and has become well known and sought after and called for by prospective purchasers, and is called the "Allen" pipe, and is well known as such; and your orator has become well known as the exclusive licensee under said patent, and all persons have, generally, acquiesced in, admitted and recognized the validity of said letters patent and have respected the rights of your orator therein, and refrained, in general, from infringing the same.

12th. And your orator further shows unto your honors that on

the twenty-ninth day of April, 1897, the said Charles P. Allen, one of the respondents herein, filed, as plaintiff, a complaint or declaration at law in the circuit court of the United States for the district of Washington, western division, against Percy Dickinson, H. S. Huson and J. Q. Barlow, copartners doing business under the firm name and style of "Dickinson & Company," and The City of Tacoma, a municipal corporation, as defendants, for the infringement of said letters patent No. 359,590, by making, selling and using wooden pipe embodying the inventions and improvements described and claimed in said letters patent.

13th. That said Charles P. Allen instituted and conducted said action at law against Dickinson & Company and the City of Tacoma, for and on behalf of his exclusive licensee, your orator The Excelsior Wooden Pipe Company, alleging in his said complaint or declaration as follows: "And the plaintiff says, that he, the said
6 Charles P. Allen, before the committing of the grievances hereinafter mentioned, to wit, on or about the 20th day of December A. D. 1892, by an instrument in writing duly executed and delivered by him, did grant unto the Excelsior Redwood Company, a corporation duly organized and existing under and by virtue of the laws of the State of California, 'an exclusive right, license and privilege to manufacture and sell wooden pipe under and in accordance with said letters patent,' within the States of northern California, Oregon, Washington, Nevada, Montana and Territories of Arizona and Utah to the full end of the term of said letters patent, which exclusive right, license and privilege to manufacture and sell wooden pipe under and in accordance with said letters patent in said States and Territories hereinbefore named was, by the said Excelsior Redwood Company, on or about the 22nd day of December, 1892, and with the consent of said Charles P. Allen in writing first had and obtained, assigned and transferred to the Excelsior Wooden Pipe Company, a corporation organized and existing under and by virtue of the laws of the State of California, which Excelsior Wooden Pipe Company is now the exclusive owner of the rights and privileges to manufacture and sell wooden pipe in the States and Territories above named, under and in accordance with said letters patent; and that said Charles P. Allen is the owner of said letters patent in all the States and Territories herein named, and that said Charles P. Allen brings this action in behalf of said Excelsior Wooden Pipe Company and for its use and benefit" as by said complaint or declaration or a duly authenticated copy of same ready in court to be produced, will fully and at large appear.

7 14th. That in the said action at law the said defendants appeared and made defense by counsel, learned in the law, and denied the title of the said plaintiff, Charles P. Allen, in said letters patent, and denied the title of your orator The Excelsior Wooden Pipe Company to its exclusive license under said letters patent, and denied the validity of said letters patent, as well as the infringement thereof; and thereby the title of said plaintiff to said letters patent, and the title of your orator to its said exclusive

license, the validity of the said letters patent and the infringement thereof were put in issue by the pleadings.

15th. That said action at law was duly brought on for trial before his honor, Judge Hanford, and a jury impaneled and sworn to try the case, and voluminous proofs were made by the respective parties in order to maintain their respective contentions, and the said case having been fully tried upon the issues so framed, as aforesaid, was duly and regularly submitted to the said jury for its consideration and decision, and the said jury having duly considered the same, did duly and regularly render and file with the clerk of said court a verdict in said action at law in favor of the plaintiff therein and against the defendants therein, and, thereafter a judgment was entered and duly made and given upon said verdict, whereby it was adjudged that the title to said letters patent lay in plaintiff and his said exclusive licensee, your orator The Excelsior Wooden Pipe Company, that said letters patent were good and valid, and that the said defendants had infringed the same. That the said judgment has never since been altered or modified and is still in full force and effect. All of which concerning said action at law will appear from the judgment-roll therein or from a duly authenticated copy of said judgment-roll ready in court to be produced.

8 16th. Your orator further shows unto your honors that in compliance with section 4900 of the Revised Statutes of the United States, it has marked and caused to be marked the patented wooden pipe manufactured and sold by it, with the word "patented" together with the day and year the said patent was granted, to wit, March 22, 1887, thereby giving notice to the public at large that the wooden pipe was covered by the said letters patent.

17th. That the invention claimed in said letters patent is of great value and has been a source of revenue to your orator The Excelsior Wooden Pipe Company by reason of the fact that it has reserved and kept to itself the exclusive monopoly under said patent of making and selling the said patented wooden pipe, within its said territory, and that by such course your orator has built up and is now enjoying a lucrative business in said wooden pipe, and can preserve the same and price thereon, only by continuing in the future the exclusive policy heretofore pursued by it.

18th. And your orator further shows unto your honors, that, notwithstanding the premises, but well knowing the same, the said Pacific Bridge Company, and the said Charles P. Allen, respondents herein, since the issuance of the said letters patent and since the acquirement by your orator of its said exclusive license, as aforesaid, did conspire to make and sell, and without the license or consent of your orator, exclusive licensee as aforesaid, have made and sold, within one year last past, in the State of Washington, and in the district of Washington, northern division thereof, wooden pipe the same or substantially the same as that described and claimed by said letters patent, and containing and embodying the invention patented in and by the said letters patent aforesaid.

9 19th. That the wooden pipe so made and sold by the said respondents was and is an infringement of said letters patent

and said infringing wooden pipe and all of it contained and does contain the said inventions claimed and patented in and by the said letters patent.

20th. And your orator further shows unto your honors that it has suffered and sustained large damages by reason of the infringement aforesaid, the exact amount of which it does not know and cannot estimate, and it avers, on information and belief, that respondents herein have made and realized large gains and profits and advantage, by reason of said infringements, the exact amount of which is likewise unknown to your orator, and it cannot estimate or calculate the same without an accounting from said respondents.

21st. And your orator shows unto your honors that said respondents are continuing and persisting in infringing upon said letters patent, and that it fears and has reason to fear and so avers that said respondents intend to continue and persist in so infringing in the future, as they have been doing in the past; all of which acts and doings are contrary to equity and good conscience, and tend to the manifest wrong and injury of your orator. That for the wrongs and injuries complained of your orator has no plain, speedy or adequate remedy at law, and, unless it shall obtain the relief herein sought, said respondents will continue to infringe upon said letters patent, and will make and sell, within the territory covered by your orator's exclusive license aforesaid, wooden pipe constituted according to the said letters patent, and your orator will thereby be deprived of large gains and profits which otherwise it would obtain and enjoy, and will suffer great and irreparable injury and damage.

10 22nd. And your orator further shows unto your honors that by reason of your orator's licensor, the said Charles P. Allen, one of the respondents herein, being, himself, an infringer upon your orator's exclusive rights and privileges under its said exclusive license, your orator is unable to join him, the said Charles P. Allen, as a party complainant in this bill of complaint, but must make and has made him a respondent herein as any other infringer.

In consideration whereof, and forasmuch as your orator is without remedy in the ordinary course of law, and cannot have adequate relief save in a court of equity, where matters of this kind are properly cognizable and relievable, to the end, therefore, that the said respondents may, if they can, but not upon oath (an answer under oath being hereby expressly waived) to the best and utmost of their knowledge, information and belief, full, true and perfect answer make to all and singular the matters and things hereinbefore charged, as perfectly and completely as if the same were here repeated at length; your orator prays that said respondent The Pacific Bridge Company, its officers, servants, agents, attorneys, employees and workmen, and that said respondent Charles P. Allen, his servants, agents, attorneys and workmen, and each and every of them may be restrained and enjoined, both provisionally and perpetually, from directly or indirectly, making, constructing, vending, selling, transferring or delivering to others, or in anywise counterfeiting or imi-

tating wooden pipe made in accordance with or embodying or containing the invention or inventions of the said letters patent or from infringing upon the same.

And that the said respondents be decreed to deliver up to be destroyed and broken up all such infringing wooden pipe as may be in their possession or undisposed of.

11 And that the said respondents be decreed to account to and with your orator for the infringing wooden pipe they have made or caused to be made and sold in the past, and upon such accounting that they be decreed to pay over to your orator such gains and profits as they may have realized therefrom and such damages as your orator may have sustained.

May it please your honors that a writ of provisional injunction issue out of and under the seal of this honorable court, on the filing of this bill of complaint, directed to said respondents, enjoining them and each of them, and their agents, officers, servants, employees, attorneys and workmen, until the further order of this court, from directly or indirectly making, vending, constructing, selling, transferring or delivering to others, within the States of northern California, Oregon, Washington, Nevada, Montana, Idaho and Utah, and the Territory of Arizona, wooden pipe made in accordance with or embodying the invention or inventions of the said letters patent and from infringing upon the same in any manner whatever.

May it please your honors, also, to grant unto your orator, the writ of subpœna issued out of and under the seal of this honorable court, directed to the said respondents, The Pacific Bridge Company and Charles P. Allen, commanding them by a day certain and under certain penalty to be and appear in this honorable court then and there to answer the premises and to stand to and abide by such order and decree as may be made against them, and that your orator may have such other, further and additional relief as it may be entitled

12 to and as may be in accordance with equity and good conscience.

And your orator will ever pray, etc.

WILSHIRE & KENAGA,
716–717 *New York Block, Seattle, W'n.*
WM. F. BOOTH,
N. A. ACKER,
Solicitors for Complainant.

WM. F. BOOTH,
N. A. ACKER,
Of Counsel.

UNITED STATES OF AMERICA,
Northern District of California, City and County of San Francisco, } *ss:*

E. F. Burrell, being duly sworn, deposes and says that he is the secretary of The Excelsior Wooden Pipe Company, the complainant in the within-entitled suit; that he has read the foregoing bill of complaint and knows the contents thereof; that the same is true of

his own knowledge, except as to the matters which are therein stated upon information and belief, and as to those matters that he believes it to be true.

E. F. BURRELL.

Subscribed and sworn to before me this 19th day of March, 1900.

[NOTARIAL SEAL.] LINCOLN SONNTAG,
Notary Public in and for said City and County of San Francisco.

(Indorsed:) Bill of complaint. Filed in the U. S. circuit court, dist. of Washington Mar. 23, 1900 A. Reeves Ayres, clerk, H. M. Walthew, dep.

13 United States Circuit Court for the District of Washington.

THE EXCELSIOR WOODEN PIPE CO. (a Corporation), Complainant,
vs.
PACIFIC BRIDGE COMPANY (a Corporation), Charles P. Allen, Respondents.
} No. 834. Appearance.

To the clerk of the above-entitled court:

You will please enter our appearance as solicitors for the Excelsior Wooden Pipe Company in the above-entitled cause.

WILSHIRE & KENAGA.
WM. F. BOOTH.
N. A. ACKER.

Indorsed: Appearance. Filed in the U. S. circuit court dist. of Washington Mar. 23 1900. A. Reeves Ayres, clerk, H. M. Walthew, dep.

14 UNITED STATES OF AMERICA:

Circuit Court of the United States, Ninth Judicial Circuit, District of Washington. In Equity.

The President of the United States of America to Pacific Bridge Company, a corporation, and Charles P. Allen, Greeting:

You are hereby commanded, that you be and appear in said circuit court of the United States aforesaid, at the court-room in Seattle on the 7th day of May A. D. 1900, to answer a bill of complaint exhibited against you in said court by the Excelsior Wooden Pipe Company, a corporation, who is a citizen of the State of California, and to do and receive what the said court shall have considered in that behalf. And this you are not to omit, under the penalty of five thousand dollars.

Witness the Honorable Melville W. Fuller, Chief Justice of the

Seal United States Circuit Court, Northern Division, District of Washington.

United States, and the seal of said circuit court, this 23rd day of March in the year of our Lord one thousand nine hundred and of our Independence the 124th.

A. REEVES AYRES, *Clerk*,
By H. M. WALTHEW,
Deputy Clerk.

Memorandum Pursuant to Rule 12, *Supreme Court U. S.*

You are hereby required to enter your appearance in the above suit, on or before the first Monday of May next at the clerk's office of said court, pursuant to said bill; otherwise the said bill will be taken *pro confesso*.

A. REEVES AYRES, *Clerk*,
By H. M. WALTHEW,
Deputy Clerk.

15 UNITED STATES MARSHAL'S OFFICE, *District of Washington.*

I hereby certify that I received the within writ on the 23 day of March, 1900, and personally served the same on the 24 day of March 1900, by delivering to and leaving with C. F. Swigert, treasurer of the within-named Pacific Bridge Company, a corporation, said defendant named therein personally, at Seattle, county of King, in said district, an attached copy thereof.

Marshal's Fees.

Service	2.00
Mileage	.12
	2.12

C. W. IDE, *U. S. Marshal*,
By JOHN STRINGER, *Deputy.*

March 24 1900.

Indorsed: Subpœna. Filed in the U. S. circuit court dist. of Washington Mar. 24 1900 A. Reeves Ayres, clerk, H. M. Walthew, dep.

16 In the Circuit Court of the United States for the District of Washington, Northern Division.

THE EXCELSIOR WOODEN PIPE COMPANY, Complainant,
vs.
PACIFIC BRIDGE COMPANY, a Corporation, and CHARLES P. Allen, Defendants.
} Stipulation.

It is hereby stipulated by and between The Excelsior Wooden Pipe Company, complainant, through its solicitors, Messrs. Wilshire

and Kenaga, William Booth, and N. A. Acker, and The Pacific Bridge Company, a corporation, and C. P. Allen, respondents, by their attorney A. R. Titlow, Esq., that said respondents and each of them have thirty (30) days from the 7th day of May 1900 in which to answer in this cause, and that the judge of the said above-named court may grant an order giving said respondents, and each of them, said additional time, and that no default in any manner shall be taken or entered or claimed against said respondents, or either of them, on account of their not pleading or answering prior to the expiration of said thirty (30) days from the 7th day of May, 1900, and that said respondents may at any time prior to the expiration of said thirty (30) days answer either jointly or separately.

WILSHIRE & KENAGA,
WM. F. BOOTH, AND
N. A. ACKER,
Solicitors for Complainant.
A. R. TITLOW,
Solicitor for Respondent.

Indorsed: Stipulation. Filed in the U. S. circuit court dist. of Washington May 9 1900 A. Reeves Ayres, clerk, H. M. Walthew, dep.

17 In the Circuit Court of the United States for the District of Washington, Northern Division.

THE EXCELSIOR WOODEN PIPE COMPANY, Plaintiff, *vs.* PACIFIC BRIDGE COMPANY, a Corporation, and Charles P. Allen, Respondents.	Order Extending Time for Respondent to Answer.

This cause coming on on the application of respondents, The Pacific Bridge Company and Charles P. Allen, for an extension of time in which to answer, said application being made on the stipulation between complainant and respondent-, through their respective solicitors.

It is hereby ordered, that said respondents, and each of them, may answer, either separately or jointly, any time prior to the expiration of thirty (30) days from and after the 7th day of May, 1900, and that neither of said respondents shall stand in default for want of any pleading or answer prior to said time.

Done this 8th day of May, 1900.

C. H. HANFORD,
Judge of said Court.

The above order is satisfactory to us upon the stipulation herein made.

WILSHIRE & KENAGA,
WM. F. BOOTH, AND
N. A. ACKER,
Solicitors for Complainant.

Indorsed: Ordered. Filed in the U. S. circuit court dist. of Washington May 9, 1900 A. Reeves Ayres, clerk, H. M. Walthew, dep.

18 United States Circuit Court for the District of Washington.

EXCELSIOR WOODEN PIPE CO. vs. PACIFIC BRIDGE CO. } No. 834. Appearance.

To the clerk of the above-entitled court:

You will please enter my appearance as solicitor for respondents Pacific Bridge Co. & C. P. Allen in the above-entitled cause.

A. R. TITLOW.

Indorsed: Appearance. Filed May 9 1900 A. Reeves Ayres, clerk, A. N. Moore, deputy clerk.

19 In the Circuit Court of the United States for the District of Washington, Northern Division.

THE EXCELSIOR WOODEN PIPE CO., a Corporation, Complainant, vs. THE PACIFIC BRIDGE COMPANY, a Corporation, and C. P. Allen, Respondents. } In Equity. No. 834.

Answer of the Above-named Respondents, The Pacific Bridge Company, a Corporation, and C. P. Allen, to the Bill of Complaint.

In answer to the said bill of complaint, the Pacific Bridge Company a corporation, and C. P. Allen, say as follows:

First. Referring to the first paragraph or subdivision of said bill of complaint, admit that, to wit, on and prior to the 22nd day of April, 1886, C. P. Allen was the original, first and sole inventor of a certain new and useful invention, to wit, a wooden pipe, which is more fully described in letters patent in the bill of complaint referred to.

Second. Referring to the second paragraph or subdivision of said bill of complaint, admit that the said new and useful invention was not known or used by others prior to the invention thereof by said C. P. Allen, nor had the same been patented or described in any printed publication in this or any foreign country before the invention or discovery by him and at the time of his application for letters patent thereon and it had not been in public use or on sale in the United States for two (2) years, nor was it abandoned or proved to have been abandoned.

Third. Referring to the third paragraph or subdivision of said bill of complaint, admit that said invention relates to wooden pipe and improvements therein and that the same is a hoop pipe com-

posed of wooden staves or cross-joints being interlocked by
20 concealed metallic tongues of novel construction and arrangement; that the hoop of said pipe is composed of a novel strap belt coupling shoe and means for engaging them; that there is a more particular description which will be seen by reference to the letters patent therefor, to which letters patent special reference is hereby made for such further description.

Fourth. Referring to the fourth paragraph or subdivision of said bill of complaint, admit that said Allen being, as aforesaid, the inventor thereof did, on the 22nd day of April, 1886, make application to the Government of the United States for the issuance to him of letters patent of said invention and that thereafter said application having lapsed under the rules and regulations of the Patent Office he did, on the 10th day of February, 1887, duly renew said application and thereafter, to wit, on the 22nd day of March, 1887, after proceedings duly and regularly had and taken in the matter of said application for letters patent, letters patent of the United States were granted and issued to him for the said invention, granting and securing to him, his heirs and assigns, for the full term of seventeen years from the last-mentioned date, the sole and exclusive right and liberty to make, use and vend said invention throughout the United States and Territories thereof.

Fifth. Referring to the fifth paragraph or subdivision of said bill of complaint, admit that letters patent were issued in due form of law, under the seal of the Patent Office of the United States, and were signed by the acting Secretary of the Interior and countersigned by the acting Commissioner of Patents of the United States and bear date the year last aforesaid and are numbered 359,590, all of which will more fully appear from said letters patent themselves, which are ready in court to be produced by these respondents.

21 Sixth. Referring to the sixth paragraph or subdivision of said bill of complaint, admit that prior to the issuance of said letters patent all proceedings were had and taken which were required by law to be had and taken prior to the issuance of letters patent for new and useful inventions.

Seventh. Referring to paragraph or subdivision seven of said bill of complaint, these respondents allege and show unto this honorable court that said Allen did, on or about the 11th day of March, 1893, make a grant to the said Excelsior Redwood Company, a corporation organized and existing under and by virtue of the laws of the State of California, and having its principal place of business in the city and county of San Francisco, in said State, and to its successors and assigns, which assignment was in the words and figures following, to wit:

"*License and Agreement.*

This agreement, made this 11th day of March 1893, by and between Charles P. Allen, of Denver, Colorado, party of the first part, and the Excelsior Redwood Company, a corporation duly organized and existing under and by virtue of the laws of the State of Cali-

fornia, and having its principal place of business in the city and county of San Francisco in said State, party of the second part,

Witnesseth: That, whereas, the party of the first part is the owner and holder, for, to and in the States and Territories hereinafter mentioned, of the whole right, title and interest in and to letters patent of the United States, No. 359,590, dated March 22, 1887, for 'wooden pipe.'

And, whereas, the party of the second part is desirous of obtaining for, to and within the said States and Territories hereinafter mentioned an exclusive right, license and privilege to manufacture and sell wooden pipe under and in accordance with said letters patent,

22 Now, therefore, the parties have agreed as follows: The party of the first part hereby grants, subject to the conditions hereinafter stated, unto the party of the second part, its successors and assigns, the exclusive right, license and privilege, within the States of northern California, Oregon, Washington, Nevada, Montana and Idaho, and Territories of Arizona and Utah, of manufacturing and selling wooden pipe under and in accordance with the said letters patent, to the full end of the term of said letters patent.

The party of the second part agrees to pay unto the party of the first part, as a license fee or royalty under this license and agreement, the following sums, to wit: One dollar ($1.00) on every one thousand feet, board measure, of lumber employed in the manufacture of said pipe, and two and one-half per cent. (2½%) on the cost at factory of all steel and iron used in said manufacture.

The said licensee or royalty is to be paid by the said party of the second part to the said party of the first part upon the final payment to the party of the second part of the contract price on each and every contract taken by said party of the second part, involving the manufacture and sale of said patented wooden pipe. The right, license and privilege hereby granted is not transferable or assignable, either in whole or in part, by the party of the second part, without the consent of the party of the first part. It is agreed that in case the party of the second part shall fail to use the above-described patent in any pipe constructed by them, of twelve (12) inches diameter and upwards, or from any cause the said party of the second part shall cease the manufacture of wooden pipe, then and in that event all rights and privileges granted by this agreement and license to the said party of the second part shall at once be revoked.

23 It is understood and agreed that this agreement is binding upon the heirs, legal representatives and assigns of the party of the first part, and upon the successors and assigns of the party of the second part.

In witness whereof, the said party of the first part has hereunto set his hand at Denver, Colorado, Dec. 20th, 1892, and the party of the second part has caused its name to be signed and its corporate seal affixed at San Francisco, California, by its president and secre-

tary thereunto duly authorized by a resolution of its board of directors.

(Signed) C. P. ALLEN.
(Signed) EXCELSIOR RED WOOD CO.,
By C. HOOPER, *President, and*
E. F. BURRELL, *Secretary.*

[Seal Excelsior Redwood Company, Incorporated Apr. 14, 1886.]"

And they further show unto this honorable court and allege that the foregoing was the only grant ever made to the Excelsior Redwood Company. That on said day said C. P. Allen agreed with said Excelsior Redwood Company, a corporation, as follows, to wit:

"This agreement, made this 11th day of March, 1893, by and between Charles P. Allen, of Denver, Colorado, party of the first part, and the Excelsior Redwood Company, a corporation duly organized and existing under and by virtue of the laws of the State of California, and having its principal place of business in the city and county of San Francisco in said State, party of the second part,

24 Witnesseth: That, whereas, under date of March 11th, A. D. 1893, an agreement was entered into by and between the parties hereto, and whereas, in said agreement certain rights were granted within the States of northern California and other States and Territories,

And, whereas, said agreement does not specify what part of the State of California is designated by the word 'northern California,'

Now, therefore, the parties have agreed as follows: That 'northern California' shall be considered that portion of the State of California situated north of an east and west line drawn through the Tehachapi pass,

In witness whereof, the said party of the first part has hereunto set his hand at Denver, Colorado, Dec. 30th, 1892, and the party of the second part has caused its name to be signed and its corporate seal affixed at San Francisco, California, by its president and secretary thereunto duly authorized by a resolution of its board of directors.

(S'g'd) C. P. ALLEN.
(S'g'd) EXCELSIOR REDWOOD CO.,
By C. HOOPER, *President, and*
[SEAL.] E. F. BURRELL, *Secretary.*"

That said contracts and grant were the only grant ever made by the said C. P. Allen to the said Excelsior Redwood Company, and these respondents deny that said C. P. Allen made any other grant of whatever kind or nature than the one above set forth to the said Excelsior Redwood Company, and allege that the foregoing is the sole and only grant ever made to said company and that the same was made upon the conditions therein expressed and implied from said instrument.

25 Eighth. Referring to the eighth paragraph or subdivision of said bill of complaint, they allege and show unto this honorable court that said C. P. Allen did, after the grant herein set forth to the Excelsior Redwood Company, consent, in writing, to a transfer of the rights so granted to the said Excelsior Redwood Company, by said respondent C. P. Allen, to the Excelsior Wooden Pipe Company of such rights so granted by said respondent to said Excelsior Redwood Company, and allege the fact to be that said grant was no greater than the rights granted by said respondent to the said Excelsior Redwood Company, and in this connection allege that said grant was made upon the conditions in said instrument above set forth and that the same have not been complied with and the said Excelsior Wooden Pipe Company took said grant or transfer from said Excelsior Redwood Company upon the same conditions as mentioned and set forth hereinbefore and that said conditions have not been complied with and that said Excelsior Wooden Pipe Company have abandoned and forfeited all their rights thereunder, as hereinafter set forth.

Ninth. Referring to paragraph or subdivision nine of said bill of complaint, these respondents say: That it is not true, as therein alleged, that said Allen is the sole and exclusive owner of said letters patent and has been ever since the issuance thereof, but say that he has granted part of the territory therein covered since the issuance of said letters patent and has granted licenses to other persons and corporations to manufacture and sell wooden stave pipe, as covered by his letters patent in various parts of the United States and Territories thereof, including the territory and right to manufacture and sell and construct wooden stave pipe in the county of King, State of Washington, mentioned and referred to in the bill of complaint herein.

26 Tenth. Referring to paragraph or subdivision ten of the bill of complaint herein, these respondents say: That they deny that the Excelsior Wooden Pipe Company is the sole and exclusive licensee of this respondent to make and sell wooden pipe under and in accordance with said letters patent within and throughout the Territories and States named in the grant hereinbefore set forth for the full term of said letters patent, or at all, and deny that said Excelsior Wooden Pipe Company has any right whatever or any license to construct, make, sell wooden pipe under and in accordance with said letters patent in said States and Territories, and allege the fact to be that the right that the said complainant heretofore had, long prior to the commencement of this action and long prior to the acts complained of in said bill of complaint, the said complainant had abandoned and forfeited the right to make and sell such wooden pipe, as is more fully hereinafter set forth.

Eleventh. Referring to paragraph or subdivision eleven of said bill of complaint, these respondents say: That it is not true that said Excelsior Wooden Pipe Company has heretofore preserved and still desires and endeavors to preserve to itself the exclusive monopoly of making and selling the wooden pipe containing and embodying the said patented invention throughout the territory in the

above-mentioned grant set forth, and say that it is not true that said complainant has invested large sums of money therein, and say that it is not true that said wooden pipe has gained a reputation by reason of its being put into actual use through the efforts of said complainant; and say that it is not true that said complainant has become well known as the exclusive licensee under the said patent, and, in this connection, state the fact to be that said
27 complainant has not recognized the validity of the respondent Allen's patent, has discouraged others from recognizing the validity of said respondent's patent, has abandoned its rights that it once had under said before-mentioned grant and has forfeited each and every of the same, as will all more fully appear as hereinafter set forth.

Twelfth. Referring to paragraph or subdivision 12 of the said bill of complaint herein, these respondents admit that said Allen did commence an action in the circuit court of the United States for the district of Washington, western division, on or about the 29th day of April, 1897, against Percy Dickinson, H. S. Huson and J. Q. Barlow, copartners doing business under the firm name and style of "Dickinson & Company," and The City of Tacoma, a municipal corporation, of Pierce county, State of Washington, for the infringement of said letters patent, by making, selling, and using wooden pipe and embodying the invention and improvements described and claimed in said letters patent.

Thirteenth. Referring to paragraph or subdivision 13 of the bill of complaint, these respondents admit that said action was commenced, but say it is not true that, as alleged in said paragraph or subdivision, said action was instituted and prosecuted for and on behalf of the complainant herein, but say that said action was prosecuted on behalf of said Allen and on his own account as patentee and for and on account of himself, and also for the use and benefit of said complainant herein, but that the interests in said action of the respondent and complainant in said action were separate and distinct and were so adjudicated in said action to be, as will more fully appear by the pleadings in said action and the judgment and decree therein obtained, which this respondent is ready and willing and will produce in court, or a duly certified and authenticated copy of the same.

28 Fourteenth. Referring to paragraph or subdivision 14 of the said bill of complaint, these respondents admit that the defendants, the said Dickinson & Company and The City of Tacoma, named in said action, appeared and made a defense to said action above referred to by counsel learned in the law and denied the title of said respondent Allen to said letters patent; but these respondents allege, in this connection, that the title of the said Excelsior Wooden Pipe Company, the complainant herein, as the exclusive licensee under the said letters patent was not put in issue and adjudicated in favor of the said Excelsior Wooden Pipe Company, but admit that the validity of said letters patent *were* in question in said action and the infringements thereof were put in issue by the pleadings.

Fifteenth. Referring to paragraph or subdivision 15 of said bill of complaint, these respondents admit that the action at law above referred to, was brought on for trial before his honor Judge C. H. Hanford, and a jury impanelled and sworn to try the case, and that voluminous proofs were made by said defendants and said plaintiff to maintain their respective contentions and admit that the suit having been fully tried as between said parties upon the issues framed between them, was duly and regularly submitted to said jury for its consideration and decision and that the jury, having duly considered the same, did duly and regularly file with the clerk of said court a verdict in said action at law in favor of the plaintiff therein and against the defendants therein, and admit that thereafter judgment was duly made and given upon the said verdict, whereby it was adjudged that the title to said letters patent lay in the plaintiff and that said letters patent were good and valid and that the said defendants had infringed upon the same and admit that said judgment has never since been altered
29 or modified and is still in full force and effect, all of which concerning said action will appear from the judgment-roll therein or from a duly authenticated copy of said judgment-roll, ready in court to be produced; but say it is not true, as in said paragraph or subdivision alleged, that the complainant in this case made its proof or that its rights were in issue and submitted to said jury; and that it is not true that said jury found a verdict in favor of said complainant herein as licensee, or otherwise; and say that it is not true that judgment was rendered on said verdict, adjudging that said complainant herein was the exclusive licensee of the rights of the said plaintiff therein, but, in this connection, allege the fact to be, that said complainant herein, to wit, The Excelsior Wooden Pipe Company in said action in said paragraph or subdivision referred to, did not act in good faith with said respondent Allen, who was the plaintiff therein, and did not furnish the proofs therein that it was the duty of the said Excelsior Wooden Pipe Company to furnish and acted in bad faith in said cause with the purpose and intent of defeating the rights of the said respondent Allen as said plaintiff in said action referred to, as will more fully hereinafter appear.

Sixteenth. Referring to paragraph or subdivision sixteen of said bill of complaint, these respondents say that they have no knowledge of the facts therein stated and not sufficient information as to the same to form a belief, therefore, they deny that said complainant, in compliance with section 4900 of the Revised Statutes of the United States, has marked and caused to be marked the wooden pipe sold by it with the word "patented" together with the year said patent was granted, to wit, March 22nd, 1887.

30 Seventeenth. Referring to paragraph or subdivision seventeen of said bill of complaint, these respondents say it is not true as claimed in said paragraph or subdivision 17 that said letters patent are of great value and have been a source of great revenue to said complainant, The Excelsior Wooden Pipe Company; and say that it is not true that the said complainant has built up and

now enjoys a lucrative business in said wooden pipe; and says it is not true that the said Excelsior Wooden Pipe Company has followed the exclusive policy therein mentioned by preserving to itself a monopoly of the manufacture and sale of the said wooden pipe within the territory claimed by it, but allege the fact to be that all rights that the said Excelsior Wooden Pipe Company once had, long prior to the acts complained of in the said bill of complaint having been committed, and long prior to the commencement of this action, the said Excelsior Wooden Pipe Company had abandoned all its rights it once had under said before-mentioned grant and forfeited the same and had discouraged the validity of said patent and had violated all the terms of the said grant, and permitted others than itself to make, sell and use said wooden pipe within said territory without recognizing said patentee or his rights therein, as will each and all more fully hereinafter appear.

Eighteenth. Referring to paragraph or subdivision eighteen of the said bill of complaint, these respondents say: That it is not true that these respondents conspired together to make and sell in the State of Washington, northern division, of the district of Washington, wooden pipe, the same or substantially the same as that described or claimed by said letters patent, but admit that said Allen has granted a license within the said territory of the State of Washington to the said Pacific Bridge Company to make and sell
31 wooden pipe to the city of Seattle, the same or substantially the same as that described or claimed by said letters patent and containing and embodying the invention patented in and by said letters patent aforesaid; and, in this connection, allege and say; that at the time of such grant to the said Pacific Bridge Company, the said complainant had abandoned and forfeited all rights it once had within the said territory and had no right whatever, and has not now any right whatsoever to claim as a licensee or grantee of said Respondent Allen under said letters patent, as will more fully appear hereinafter.

Nineteenth. Referring to paragraph or subdivision nineteen of the said bill of complaint, these respondents say: That the pipe so manufactured, as aforesaid, and sold by the said Pacific Bridge Company, they believe, contains the said invention claimed and patented in and by the said letters patent, but say that it is not true that the said Pacific Bridge Company, or C. P. Allen, or both of said respondents combined, have infringed in any manner whatever upon said patent or upon the rights or supposed rights of the said complainant and that said respondents or neither of them have violated the rights of said complainant therein.

Twenty. Referring to paragraph or subdivision twenty of the said bill of complaint, these respondents say: That it is not true, as therein alleged, or otherwise, that the said complainant, The Excelsior Wooden Pipe Company, has suffered and sustained large damages by reason of the making, constructing and selling of the said wooden pipe by the said Pacific Bridge Company, as before mentioned, and allege the fact to be, that said complainant has suffered no damages whatever on account of the same; and say that it is not

true, as therein alleged, that the said Pacific Bridge Company
32 and said respondent Allen, or either of them, have made and realized large gains and profits and advantage by reason of the manufacture and sale of said wooden pipe above set forth, and, in this connection, allege that there was no infringement whatever or violation of the rights of the said complainant herein, as will more fully hereinafter appear.

Twenty-first. Referring to paragraph or subdivision 21 of said bill of complaint, these respondents say: That it is not true, as in said paragraph or subdivision alleged, that these respondents are persistently infringing upon the said letters patent or upon the rights of the said complainant; and say that it is not true that said respondents intend to continue to persist in infringing in the future upon the said letters patent, or at all, or upon the rights of the said complainant; and say it is not true that the said respondents, or either of them are doing anything against good conscience or contrary to equity, or to the wrong and injury of the said complainant; and they say that it is not true that said complainant has no plain, speedy and adequate remedy at law; and that it is not true that said respondents, or either of them, will infringe upon said letters patent, or upon the rights of the said complainants if said complainant should not obtain the relief sought for in this action; and in this connection alleges that within the territory mentioned and covered by the grant hereinbefore set forth, that the complainant in this action has now no existing rights whatever under said grant to make, construct, or sell within the said Territory of Washington, the wooden pipe invented and covered by the said letters patent herein referred to and that the same has long since been abandoned by said complainant and forfeited, as will more fully hereinafter appear. These respondents say it is not true that said complainant will be deprived of large gains and profits, as in said paragraph or
33 subdivision alleged, or otherwise, by reason of these respondents, or either of them, making, selling or constructing within the said territory of the State of Washington, wooden pipe, and it is not true that it will suffer great and irreparable injury and damage.

Twenty-second. Referring to paragraph or subdivision 22, of the said bill of complaint, these respondents say that it is not true, as therein alleged, or otherwise, that said respondent Allen or The Pacific Bridge Company, respondent herein, is an infringer on the rights of the said complainant, and it is not true, as therein alleged, or otherwise, that the said complainant has an existing license in the territory claimed.

Twenty-third. These respondents further show that the respondent The Pacific Bridge Company has a contract with the city of Seattle, a municipal corporation of the first class, located within the northern division of the district of Washington, in King county, to construct a wooden stave pipe, which said contract of construction was not complete at the beginning of this action and will not be complete for quite a period of time to come; that no profits have at this time accrued to said respondent, The Pacific Bridge Company, or to said C. P. Allen, arising out of said contract of construction

with the said municipal corporation and it is now indefinite and uncertain as to whether there ever will be any profits arising to said Pacific Bridge Company, or to said C. P. Allen, and also uncertain, if any such should arise, as to the amount thereof, but these respondents further say that at the time of entering into the said contract by the said Pacific Bridge Company with the said municipal corporation, the city of Seattle, that there were other processes of wooden stave pipe that the said Pacific Bridge Company could have used
34 which were open to the said Pacific Bridge Company and the public and which would have come within the terms of the contract and specifications required by the said municipal corporation, and which could have been used by the said Pacific Bridge Company in the construction of said wooden stave pipe and there has been no advantage derived by the said respondent, The Pacific Bridge Company, from the using of the wooden stave pipe in such construction over what it would have had in such other processes then open to it and the public, and adequate to enable it to have obtained equally beneficial results, and that other bidders that were competing with the said respondent, The Pacific Bridge Company, for such contract did not take into consideration the Allen patent, but were depending and relying upon such other processes then open to them and the public and that said contract is the only contract for the construction of the said wooden stave pipe under the said Allen patent that the said Pacific Bridge Company, or the said C. P. Allen, have within the State of Washington, in the northern division of the district of Washington of this court, and that said respondents, or neither of them, have any contract to make, construct or sell any wooden stave pipe covered by said Allen patent in the said northern division, other than as herein alleged, with the said city of Seattle, which is now in course of construction by the said Pacific Bridge Company.

Twenty-fourth. These respondents further say that a long time prior to the commencement of this action and a long time prior to the making, construction and selling of said wooden stave pipe in the said northern division of the district of Washington, to said city of Seattle, the license hereinbefore set forth, granted by the said respondent C. P. Allen, to the said Excelsior Redwood Company, and thereafter by said Excelsior Redwood Company assigned to said complainant, had been revoked by said patentee, said C. P. Allen, and said revocation was duly
35 and properly made and said complainant properly, duly and fully notified, and that a long time prior to the said making and constructing of said wooden stave pipe and the commencement of this suit said complainant itself had abandoned said license and renounced the validity of said license and the conditions upon which the same was granted by said Allen to the said Excelsior Redwood Company and had refused to recognize the validity of said patent granted to said C. P. Allen, and had abandoned the use of the pipe covered by said Allen patent and failed to use the same and was making and using other pipe in its stead and covered by another patent within the territory covered by said license and had ceased

to manufacture said wooden pipe so covered by said patent within the territory so granted by said license and had failed, neglected and refused to account to said respondent, C. P. Allen, for the royalties agreed upon by the terms of said license, which were conditions of granting such license at the time the same was granted and in many instances failed to report at all or pay royalties upon work done within the said granted territory, and in many other instances failed, neglected and refused to report all of the lumber and other materials used in the construction of such patented wooden stave pipe within the said territory granted, but would only partially report, and in many other instances where such pipe was made, sold and constructed by the said Excelsior Wooden Pipe Company, failed, neglected and refused to report at all for a period of from one to five years, after a report and accounting was due under and by virtue of the terms and conditions of said grant or license and then when same was reported did not pay such royalties or tender to said respondent, said C. P. Allen, moneys due thereunder, and in many other instances constructed, made and sold said wooden pipe so covered by said patent within the said granted territory that were never reported at all to said patentee, or respondent herein,
36 said C. P. Allen, and never have in any way accounted for such royalties under such work, or reported the same; and in a number of other instances within the said granted territory, without the consent and knowledge of the said respondent, said C. P. Allen, the owner of said patent and licensor, the said Excelsior Wooden Pipe Company granted rights to other persons and corporations to build and construct wooden stave pipes which was an infringement upon said patent of said respondent, C. P. Allen; that said complainant did not report the same to the said respondent, C. P. Allen, nor ask his consent, nor report and pay royalties on the lumber and materials used in the construction of the same, although the said complainant received valuable considerations for such grant to such persons and such corporations; and in many other instances said complainant, since said assignment to it by the said Excelsior Redwood Company of the rights under said license, have built and constructed in foreign States and countries, wooden stave pipes which were identical with the pipes covered by the patented pipes of the said respondent, C. P. Allen, herein, and in violation of the terms of the said licenses and conditions upon which the same were granted, and did not report the same to said respondent, said C. P. Allen, pay any royalties thereon, or account for such royalties in any way whatsoever, and that the same and each and every of the above acts and doings of the said complainant were done with the intent and purpose to deceive, defraud and deprive the said respondent, said C. P. Allen, of his royalties, and done in the worst faith towards said patentee and licensor, and with the purpose and intent of abandoning said license and with the purpose and intent not to recognize the said license or grant as being in force and with the purpose and intent of renouncing the validity of said patent held and owned by the said respondent, C. P. Allen, and with the purpose and in-
37 tent of not only failing to recognize the validity of said patent in said C. P. Allen, but with the purpose and intent of recogniz-

ing a higher right and a superior and better right to construct such wooden stave pipe so covered by the said patent of said C. P. Allen under another patent or patents other than that of said C. P. Allen herein and bring said patents into disrepute; and, further, that in the said mentioned referred to and described action in complainant's bill of complaint herein, wherein said action was waged in the name of said respondent, C. P. Allen, herein, as plaintiff therein, and against the said City of Tacoma, a municipal corporation, and Percy Dickinson, H. S. Huson and J. Q. Barlow, doing business as copartners under the firm name and style of Dickinson & Company, and wherein the said complainant herein, as shown by the complaint or declaration in said cause, was to be a beneficiary in the said cause, if the same were prosecuted to a final and successful termination in behalf of said plaintiff and complainant herein as a beneficiary and as licensee therein, the said complainant owing the duty to the said plaintiff in said cause to aid and assist in every material way in furnishing evidence, which it had agreed to do that the said suit might in all its aspects be prosecuted to a successful termination and after said Excelsior Wooden Pipe Company in said cause had agreed to furnish evidence for said prosecution of said case in behalf of the said plaintiff and itself as beneficiary therein, and while said Excelsior Wooden Pipe Company was pretending to desire such successful termination, it was secretly and quietly aiding and abetting the defense in said case and doing all in its power to defeat said action, to the end that in the said case the validity of said patent, which was in question, might be determined against said respondent, said C. P. Allen, and said patent held invalid and to that end the said complainant
38 herein in said case was secretly and clandestinely furnishing aid and comfort and evidence to said defendants in said case and refused to furnish the evidence it had agreed to for the plaintiff's use in said case, and which was material to a successul prosecution on behalf of the said plaintiff in said case, all of which was wholly within the power of said Excelsior Wooden Pipe Company to furnish and which said evidence and facts were in existence, consisting of written documents and other evidence within its possession and under its control and which was not in the power of the said plaintiff to furnish without the hearty co-operation of said Excelsior Wooden Pipe Company, which said respondent herein, C. P. Allen, did not have as plaintiff in said cause, and that the evidence in said cause, which the said Excelsior Wooden Pipe Company agreed to furnish for the trial of said case and which was wholly within its power to furnish and supply, and which said Excelsior Wooden Pipe Company led said plaintiff in said cause to believe would be furnished up and to the time of trial, and was then purposely and maliciously withheld in order that said C. P. Allen, as plaintiff in said cause, might be defeated in said action in sustaining and maintaining the validity of the said patent, all for the purpose and to the end that the validity of the said patent, might be defeated in said cause and that said Excelsior Wooden Pipe Company might then manufacture, construct, use and sell within any and all territory of the United States and other countries and foreign States wooden stave pipe contemplated

and covered by said Allen patent with impugnity and without in any way accounting to the said C. P. Allen, as patentee for such wooden stave pipe, and on account of each and all of said acts of said complainant said respondent Allen prior to the commencement of this action and to the acts complained of in the bill of complaint
39 herein, accepted the abandonment of said complainant of said license and the rights thereunder it had and the renunciation of the same on the part of the said complainant and on account of said acts of said complainant, revoked said license and duly and properly notified said complainant of the same in writing prior to the commencement of this action and prior to the acts complained of in the bill of complaint herein; and that after said abandonment of said license and failure to use said patent and renunciation of the same by said complainant, The Excelsior Wooden Pipe Company, and after said respondent, C. P. Allen, had revoked said license and right thereunder, and accepted said abandonment of said license, and the rights growing out of the same, by said Excelsior Wooden Pipe Company, said respondent, C. P. Allen, granted to this respondent, the said Pacific Bridge Company, the right to build, construct and sell said wooden stave pipe in said county of King, State of Washington, district of Washington and northern division thereof, and that said complainant prior to the same had not filed for record in the Patent Office any record of its license or grant from said respondent, C. P. Allen, and has not since filed such, as required by law.

Wherefore, respondents pray that the bill of complaint herein may be dismissed, that respondents have judgment for their and each of their costs against said complainant, that no injunction at any time or in any form be granted complainant against respondents, or either of them, and they not be compelled to account, or either of them.

PACIFIC BRIDGE COMPANY,
By C. F. SWIGERT, *Treasurer*,
C. P. ALLEN,
By W. S. ALLEN, *His Attorney-in-fact*,
Respondents.

A. R. TITLOW,
Solicitor for Pacific Bridge Company and C. P. Allen, Respondents, 202, 203, 204 National Bank of Commerce Bldg., Tacoma, Washington.

40 STATE OF WASHINGTON,
City of Seattle, County of King, District of Washington, Northern Division, } ss:

C. F. Swigert, being duly sworn, deposes and says: That he is the official treasurer of The Pacific Bridge Company, one of the respondents in the above-entitled cause, and is authorized to verify the answer herein for and on behalf of the Pacific Bridge Company and the respondent C. P. Allen; that so much of the foregoing answer as concerns the Pacific Bridge Company's own acts and deeds

is true to the best of my own knowledge, and so much thereof as concerns the acts and deeds of the respondent, C. P. Allen, or any other person or persons, I believe to be true.

C. F. SWIGERT.

Subscribed and sworn to before me this 9th day of June, 1900.

[NOTARIAL SEAL.] ANDREW KNOX,
Notary Public in and for the State of Washington, Residing at Seattle, King County, State of Washington.

Received copy of the within answer this 9th day of June, 1900.

WILSHIRE & KENAGA,
WM. F. BOOTH, &
N. A. ACKER,
Solicitors for Complainant.

Indorsed: Answer. Filed in the U. S. circuit court dist. of Washington Jun- 9 1900 A. Reeves Ayres, clerk, H. M. Walthew, dep.

41 Circuit Court of the United States, District of Washington, Northern Division.

EXCELSIOR WOODEN PIPE CO., Complainant,
vs.
PACIFIC BRIDGE CO. and CHARLES P. ALLEN, Respondents.
} In Equity. No. 834.

This repliant, saving and reserving unto itself all and all manner of advantage of exception to the manifold insufficiencies of the said answer, for replication thereunto saith that it will aver and prove its said bill to be true, certain, and sufficient in the law to be answered unto, and that the said answer of the said defendants is uncertain, untrue, and insufficient to be replied unto by this repliant, without this, that any other matter or thing whatsoever in the said answer contained material or effectual in the law to be replied unto, confessed and avoided, traversed or denied is true. All which matters and things this repliant is and will be ready to aver and prove as this honorable court shall direct, and humbly prays, as in and by its said bill it hath already prayed.

WILSHIRE & KENAGA,
N. A. ACKER, AND
WM. F. BOOTH,
Solicitors for Complainant.

42 UNITED STATES OF AMERICA,
District of Washington, Northern Div., } ss:

W. W. Wilshire, being first duly sworn on oath, says: That he is one of the solicitors for complainant in the above-entitled action; that he has read the foregoing replication, knows the contents thereof, and believes the same to be true; that he makes this affidavit

because complainant is a non-resident of the State of Washington, and is absent from said State, it being a foreign corporation, organized and existing under and by virtue of the laws of the State of California, with its residence and principal place of business at San Francisco, said State.

W. W. WILSHIRE.

Subscribed and sworn to before me this 18th day of June, A. D. 1900.

[NOTARIAL SEAL.] G. E. DE STEIGUER,
Notary Public in and for Washington, Residing at Seattle.

I hereby acknowledge the receipt of a full & true copy of the within replication, and admit due and timely service of the same this 19th day of June, 1900.

A. R. TITLOW,
Solicitor for the Respondents Pacific Bridge Company and Charles P. Allen.

Indorsed: Replication. Filed in the U. S. circuit court dist. of Washington Jun- 21 1900 A. Reeves Ayres, clerk, A. N. Moore, dep.

43 In the Circuit Court of the United States for the District of Washington, Northern Division. In Equity.

EXCELSIOR WOODEN PIPE COMPANY, a Corporation, Complainant,
vs.
PACIFIC BRIDGE COMPANY, a Corporation, and CHARLES P. Allen, Respondents. } No. 834.

STATE OF WASHINGTON, }
County of King, } *ss:*

I, C. F. Swigert, being first duly — upon oath say:

That I am the official treasurer of The Pacific Bridge Company, a corporation, one of the respondents above named, and have the entire management and control of the construction work for the said Pacific Bridge Company of the pipe line water works now being constructed by the Pacific Bridge Company for the city of Seattle, in King county, State of Washington:

That I make this affidavit on behalf of the said Pacific Bridge Company, and also on behalf of its co-respondent, Charles P. Allen, who is a resident and citizen of the State of Colorado, and is not now in the State of Washington:

That said city of Seattle has a population of about eighty thousand (80,000) inhabitants and that said city is rapidly growing in population and is badly in need of a more adequate supply of water and such as is contemplated by the system of water works now being built and constructed for said city by the said Pacific Bridge

Company, both for protection against fire and for pure and fresh water for general utility to supply the inhabitants thereof:

That said Pacific Bridge Company is under heavy bonds
44 to complete said work within a specified time and has been crowding said work with every possible speed, and that it is incumbent upon said respondent said Pacific Bridge Company to complete said work, or as much thereof, during the favorable weather before the wet season sets in:

That the said respondent is informed and believes that it has a full, complete, perfect and meritorious defense to this action.

That the issues in this action were made up on or about the 19th day of June A. D. 1900, and that thereafter the complainant in the State of California, city of San Francisco, took the deposition of David C. Henny, the active manager of said complainant, The Excelsior Wooden Pipe Company, a corporation; that said deposition of said David C. Henny was begun on or about the 11th day of July, but said deposition was not completed till about the 7th day of August, 1900—that is to say: a statement of the time, places and amounts of work, which the said David C. Henny had sworn to, that the said Excelsior Wooden Pipe Company had done under the Allen patent covering wooden stave pipe throughout the States of Oregon, northern California, Utah, Idaho and Montana, and such other places as said complainant had done work putting in wooden stave pipe under the Allen patent, and other patents, as shown by said statement, which included, also, work in British Columbia, Hawaiian islands, and other places;

That one of the defenses set up in this action by said Pacific Bridge Company and said Charles P. Allen, respondents, is that the said Excelsior Wooden Pipe Company had acted in the worst of faith to the patentee, said Charles P. Allen, and had forfeited its right to a license in any of the territory of the United States whatever and said forfeiture had been in force and was in force at the time of the commencement of this action and prior thereto.

45 And another of said defenses is that said Excelsior Wooden Pipe Company had abandoned its license to manufacture and sell wooden stave pipe covered by the Allen patent and had been manufacturing and selling other wooden stave pipe and had not accounted as the grant of license by said Charles P. Allen, patentee, to said complainant's grantor, provided and was conditioned; and that the principal and prime question in this action is whether the grant made upon such condition by said Charles P. Allen to the Excelsior Redwood Company, a corporation, who is the grantor of the complainant herein, was still in force.

That in order to determine the merits of the same, after getting said statement on or about the 9th day of August, 1900, it became necessary for this respondent, and said Charles P. Allen, respondent herein, to visit each place where said statement showed that said complainant had done work in putting in wooden stave pipe and to find out whether the same was accurately reported, or whether or not as in other instances—and many of them—said complainant had not reported a true and correct amount done at the time when the

same was done and the royalties that would be due thereunder, as this is the first pretended full statement that has ever been made to the said Charles P. Allen, although the grant by the said Charles P. Allen to the Excelsior Redwood Company was made in the fall of the year 1892 or the spring of 1893, and that the said work has been done throughout the territory as above shown, and that it has been absolutely impossible for the respondents to visit said places to ascertain said facts, save and except from a few, and of the few that said respondents have been able to ascertain about, said testimony concerning the same was incorrect, inaccurate and fell very far short of the actual amount of work done and of the actual
46 amount of material used, and of the actual amount of royalties due thereunder, if said license should have been in force.

That the complainant herein cannot suffer any damage whatever by reason of any delay in this action as it would be impossible to determine until the said water works at Seattle *was* completed, whether or not there would be any profits whatever and in the event that complainant should succeed in this action it would — left to be ascertained after the completion of the said work what, if any, profits would accrue from said work;

That respondents can and will, on or before the 1st day of January, 1901, have fully investigated the facts of their defense herein, as above mentioned, and will have time to prepare its testimony and be ready for trial of this case upon the merits, should this honorable court hold that it has jurisdiction in said cause, which, affiant is informed and believes, it is very doubtful if this court has jurisdiction, as affiant is informed and believes that there is no diverse citizenship involved in this case that would give this court jurisdiction; neither does affiant believe, from such information, that this is a case arising under the patent laws of the United States, but is solely and purely a question of contract arising out of the grant made by the respondent, Charles P. Allen, to said Excelsior Redwood Company, which said Excelsior Redwood Company thereafter made an attempted grant and transfer to the complainant herein and the proper jurisdiction to determine whether or not said contract is in force, as affiant is informed and believes, belongs to the jurisdiction of the State courts, but notwithstanding this, affiant says that said respondents, and each of them, are anxious to have the merits of this case determined and determined speedily for both complainant's interest and the interest of the respondents herein,
47 and have and will exercise all due and proper diligence to bring about a speedy determination of the rights of the parties herein, and that respondents have already done so far as was within a possibility to do so without absolute and unqualified injury to said respondent under its contract with said city of Seattle and to said city of Seattle under said contract of construction of said water works.

That the places where the said complainant has constructed and sold wooden stave pipe are so many and such distances apart

throughout said territory that it would be almost a physical impossibility to have made a thorough investigation by this time;

That there has been no intentional delay upon the part of respondents, or either of them and will not be any such, but respondents, and each of them, will try this case upon the merits with their testimony all taken by the first of January next, should this honorable court hold that it has jurisdiction herein.

Further deponent saith not.

C. F. SWIGERT.

Subscribed and sworn to before me this 15th day of October, 1900.

G. F. WEBSTER,
Justice of the Peace, Webster Precinct, King Co., Wash.

Received a copy of the within affidavit this 17th day of October 1900.

N. A. ACKER,
WM. F. BOOTH, AND
WILSHIRE & KENAGA,
Attorneys for Complainant.

Filed in the U. S. circuit court dist. of Washington.
Oct. 18 1900.

A. REEVES AYRES, *Clerk.*
H. M. WALTHEW, *Dep.*

48 In the Circuit Court of the United States for the District of Washington, Northern Division.

EXCELSIOR WOODEN PIPE COMPANY, a Corporation, Complainant,
vs.
PACIFIC BRIDGE COMPANY, a Corporation, and Charles P. Allen, Respondents.

Motion for an Order Extending Time to Take Testimony.

Comes now the above-named respondents, The Pacific Bridge Company, a corporation, and Charles P. Allen, and moves the court for an order extending the time to take testimony of respondents herein until the first day of January, 1901, upon the following grounds, to wit:

1st. That sufficient time has not been allowed for respondents to take their testimony.

2nd. Upon the ground that there has been no unnecessary delay and all due and reasonable diligence has been used to get the testimony of respondents.

3rd. Upon the further ground that the same can be done without any loss, damage or inconvenience to any of the parties to this suit, and that the case can be ready for trial upon its merits and the testimony all taken by the first day of January next.

4th. Upon the further ground that it would have been almost a

physical impossibility to have obtained the testimony since the completion of the taking of deposition of David C. Henny, complainant's witness in this cause. That said testimony could not have been taken or obtained after such was completed.

This motion is supported by the affidavit of C. F. Swigert on file herein, and said affidavit is hereby referred to in support of this motion and made a part hereof.

A. R. TITLOW,
Solicitor for Respondents.

49 Received a copy of the within motion this 17th day of October, 1900.

N. A. ACKER &
WM. F. BOOTH AND
WILSHIRE & KENAGA,
Attorneys for Complainant.

Indorsed: Motion for an order extending time to take testimony. Filed in the U. S. circuit court dist. of Washington Oct. 18 1900 A. Reeves Ayres, clerk, H. M. Walthew, dep.

50 In the Circuit Court of the United States for the District of Washington, Northern Division.

EXCELSIOR WOODEN PIPE COMPANY (a Corporation), Complainant,
vs.
PACIFIC BRIDGE COMPANY (a Corporation) and Charles P. Allen, Respondents.
} In Equity. No. 834.

STATE OF CALIFORNIA,
City and County of San Francisco, } ss:

David C. Henny, being duly sworn, deposes and says, that he is, and has been, at all times since the grant of the exclusive license mentioned in the bill of complaint, in the above-entitled cause, a stockholder in, and manager of the above-named complainant; that he has read a copy of the affidavit of C. F. Swigert, treasurer of the respondent, The Pacific Bridge Co., on motion of respondents for an extension of time to take testimony; that he is willing to admit that the city of Seattle has the population stated in said affidavit, and that said city is in need of an adequate supply of water, for the purposes stated; that he is fully informed of the nature of the acts upon which the infringement charged in the bill of complaint herein is based; that said acts consist in the manufacture and sale, by the respondents herein, of that certain wooden pipe made in accordance with and covered and patented in and by the Allen patent, sued on, and under which complainant has an exclusive territorial license, and the continuance and threatened continuance by said respondents of the unlawful and unwarranted manufacture and sale of said patented wooden pipe, said manufacture and sale by said respondents being under that certain contract of said Pacific Bridge Co. with the

city of Seattle, dated April 19th, 1899, pursuant to the joint bid of said Pacific Bridge Co. and said Charles P. Allen, respondents
51 herein, of April 12th, 1899, made in response to a call for bids, dated March 7th, 1899, by the board of public works of the city of Seattle, said call for bids being for that certain work advertised under the title of "plans, specifications and contract for constructing the Cedar River water supply system;" affiant states that the completion of this work required by the said city of Seattle cannot be affected by the prompt trial of the issues of this case, for the reason that, as your affiant is informed and believes, the manufacture, sale, furnishing and laying of said patented wooden pipe in the work contracted for by these respondents, which said work was to be completed, under the said specifications and contract on or before June 15, 1900, is far progressed, and is nearly completed, and that said infringing acts under this particular Seattle contract and work will be terminated long prior to any decision no matter how prompt may be the hearing or trial of the issues herein; so that your affiant is informed and believes that, under the circumstances of the case, the work of utility which the city requires will not and cannot be injuriously affected, in so far as its completion is concerned, by a prompt trial of the issues herein; further, your affiant states that under the said contract of the said city of Seattle with said respondents the city is entitled to withhold from the contractors a percentage of the final payment, for the purpose of responding to various claims, among others claims for damages or royalties for the use of patented devices in said work, and that there is a time limit, after the completion of the work, for the withholding of such percentage; affiant states that complainant herein has used diligence in the prosecution of this case, with the purpose of availing itself of this provision of the said contract, by seeking as speedy a trial as possible, and avoiding the possibilities of a barren judgment.

Affiant further says that the record in this case shows that
52 upon the application of respondents, based upon stipulation, an order of court was made giving respondents permission to answer within 30 days from May 7th, 1900, which said time expired June 6th, 1900; the answer was filed June 9th, 1900, and, as your affiant is informed and believes, said untimely filing was made without any further stipulation of parties, or order of court, but with seeming disregard of the rules and orders of this honorable court; the record further shows that the replication was filed and the cause at issue on the 21st day of June, 1900; affiant further states that he urged his solicitors to the prompt taking of *prima facie* testimony, and accordingly, such testimony was taken on July 11th, 12th and 13th, 1900, and the *prima facie* case of complainant was declared, by its solicitors, on said last-named day to be closed; affiant says with regard to the statement of affiant Swigert, that the testimony was not completed until August 7th, 1900, that during the course of affiant's long and searching cross-examination by the solicitors for respondents, affiant was repeatedly asked as to where, when and for whom his company, complainant herein, had made the patented wooden pipe, and as to the conditions, construction and extent of

each piece of work, and affiant as repeatedly and fully answered; affiant was finally asked if he would furnish a written tabulated statement to contain certain matters which were, substantially, those which had been asked and answered for the three days of his examination; it was decided by counsel for both sides, in presence of your affiant, that in view of the time it would take to prepare such a statement, it might be prepared by him after the conclusion of the deposition, and form a part thereof, a copy being furnished solicitor for respondents; affiant thereafter prepared, with much labor and care, and at the expenditure of considerable time, the said statement, and with the exception of a few
53 days' delay, awaiting the return of one of his solicitors, a copy of said statement was forwarded to counsel for respondents on August 7th, 1900; affiant also states that during the taking of complainant's testimony, respondents had in attendance, at and during the entire examination, a special and expert stenographer of their own, who, in addition to the official stenographer, took down for and on behalf of respondents the entire proceedings. Affiant further states that the record shows that after the testimony of July 11th, 12th and 13th, as aforesaid, no further testimony was taken by either party within three months from the time when the cause was at issue; affiant is informed by his solicitors and believes that respondents made no attempt prior to said three months to have said time extended, either by stipulation or order of court, but in apparent disregard of the equity rule 69, as affiant is informed and believes, allowed the prescribed time to expire without any effort whatever to extend the same.

Affiant is further informed and believes that the several matters set up in the affidavit of C. F. Swigert herein as material to the defense of said case, and which are said to require time to investigate, are wholly immaterial to any issues of the case; and affiant states that none of said matters is true or ever had any existence, but affiant is informed and believes that even if any or all of said matters is or are true, or ever had any existence, it or they were long since known to or was or were within the power of respondents to know, and they do not require time to now discover them; affiant further states that he is informed and believes that even if such matters, any one or all of them, is or are true, or ever had any existence, proof of the same is irrelevant, incompetent and immaterial in this case, and even if such proof is admitted in evidence it is wholly insuffi-
54 cient to sustain the defense of forfeiture of complainant's license, or to show a revocation or rescission of the same.

Affiant further states, that he is informed by his solicitors and believes, that the question as to whether complainant's license was or is still in force is not the principal or prime question in this action, but, on the contrary, is no question at all herein, and is not properly involved in any of the true issues of the pleadings; but if said question is involved in any way at all, it is merely incidental to the true issue, which is the invasion of complainant's rights under the patent sued on, by the infringement of the respondents, which said infringement is the principal and prime question; affiant fur-

ther states that he is informed by his solicitors and believes, that the above-entitled case is not a question of contract arising out of the grant of its said license, nor any question of contract, nor is it a case to determine whether said contract, or any contract, is in force; that complainant never brought this action, or any action, to determine any such question; that such question cannot and does not arise in this case, as competent, or relevant, or material to the proper issues thereof, but that, if any phase of this question be found in any manner competent or relevant or material, it can be, and is only as incidental to the principal and prime question as affiant has heretofore stated; that this case, as formed by the pleadings, and the proof so far elicited, and any possible proof which may hereafter be obtained, and found pertinent, and as governed by the well-settled rules of law applicable to such cases, is one for the infringement of a patent, pure and simple, as the principal and prime question, and the only proper question; and affiant is informed by his solicitors and believes, the issues and questions stated by C. F. Swigert in his affidavit herein, are not the true
55 issues, but are immaterial, incompetent and irrelevant to this case, and tend to confuse the same.

Affiant further states that he is informed by his solicitors and believes, that this honorable court has full jurisdiction, and exclusive jurisdiction of this case, both as to subject-matter, and as to parties, and that the State courts have no jurisdiction whatever of said case, and complainant could not have the relief sought from said State courts.

Affiant further states that to grant respondents the time they ask in which to take testimony, is virtually giving them nearly six months' time, because their testimony might have been taken at any time after about the 15th day of July, 1900; and such extension will throw the case over the coming term of this honorable court, and postpone the hearing of the same far beyond reasonable limits; that such extension and postponement will work injury to complainant, by deferring the time when this complainant can enforce its just rights, not only against the present infringement, but also against, what this affiant believes to be a concerted action on the part of its licensor Charles P. Allen, with various parties, to invade and infringe the rights of this complainant, under the said patent, throughout the entire territory of said complainant.

DAVID C. HENNY.

Subscribed and sworn to before me this 22nd day of October 1900.

D. B. RICHARDS,

[NOTARIAL SEAL.] *Notary Public in and for the City and County of San Francisco.*

56 Receipt of a true copy of the within affidavit and due service thereof this 25th day of Oct. 1900 is hereby admitted.

A. R. TITLOW,
BOGLE & RICHARDSON,
Attorneys for Respondents.

Indorsed: Affidavit. Filed in the U. S. circuit court dist. of Washington Oct. 25 1900 A. Reeves Ayres, clerk. A. N. Moore, dep.

57 OCTOBER 29, 1900.

General Order Book, Circuit Court, volume 6, page 427.

EXCELSIOR WOODEN PIPE CO.
vs.
PACIFIC BRIDGE CO. & C. P. ALLEN. } 834.

Now on this day this cause coming on to be heard upon motion of respondents for an order extending time to take testimony, the court after hearing argument of respective counsel takes said matter under advisement.

58 In the Circuit Court of the United States for the District of Washington, Northern Division.

EXCELSIOR WOODEN PIPE COMPANY (a Corporation), Complainant,
vs.
PACIFIC BRIDGE COMPANY (a Corporation) and Charles P. Allen, Respondents. } In Equity. No. 834.

Application for Order Shortening the Time for Service of Notice of Hearing Motion for Judgment and Decree on the Pleadings.

Comes now the above-named complainant, by its solicitors, Wm. F. Booth, N. A. Acker and Wilshire & Kenaga, and hereby applies to this honorable court for an order shortening the time for notice of hearing the motion of the complainant, hereto attached, for judgment and decree on the pleadings and papers on file, so that said motion may be brought on for hearing at ten o'clock a. m. on Monday, the 5th day of November 1900, and notice of said hearing served forthwith, this 2nd day of November, 1900, upon Bogle & Richardson, resident solicitors of record for the above-named respondents.

Complainant shows the court that on said 5th day of November, 1900, the parties hereto, by their said solicitors, will appear for the argument of the question of the jurisdiction of this court in said cause, that said day is the last on which this court can hear this motion for a long time owing to the intended absence of Hon. C. H. Hanford, judge of said court, and that said motion can be properly and conveniently taken up in connection with said argument on the question of jurisdiction. That the chief counsel for the complainant reside in San Francisco, California, and will be present on said day for said argument, and the chief counsel of the respondents reside at Tacoma, Washington, nearby the city of Seattle, said State,

59 and will also be present on said day for said argument, that it will occasion great inconvenience and expense to complainant's said chief counsel to come from San Francisco for the hearing of said motion at another time, and the full presentation of

the questions involved in said motion in the manner desired by all of complainant's counsel will require the presence of complainant's said San Francisco counsel at the hearing of said motion.

WM. F. BOOTH,
N. A. ACKER, AND
WILSHIRE & KENAGA,
Solicitors for Complainant.

STATE OF WASHINGTON, } ss:
County of King, }

W. W. Wilshire, being first duly sworn, on oath deposes and says: I am one of the solicitors for the complainant named in the above-entitled cause: I have read the foregoing application, know the contents thereof and that the same is true, except as to matters stated upon information, and as to such matters I believe the same to be true.

W. W. WILSHIRE.

Subscribed and sworn to before me this 2nd day of November, 1900.

[NOTARIAL SEAL.] N. S. PETERSON,
Notary Public in and for the State of Washington, Residing at Seattle, in said State.

Order.

Now, upon hearing the foregoing application, it is hereby ordered that the time for notice of the hearing of the motion of the above-named complainant for judgment and decree on the pleadings and papers on file in the above-entitled cause be shortened so that said hearing be at ten o'clock a. m. on Monday the 5th day of November, 1900, and said notice be served forthwith, this 2nd day of November, 1900, on the resident solicitors of record for the above-named respondents, namely, Messrs. Bogle & Richardson.

Dated this 2nd day of November 1900.

C. H. HANFORD, *Judge.*

60 In the Circuit Court of the United States for the District of Washington, Northern Division.

EXCELSIOR WOODEN PIPE COMPANY (a Corporation), Complainant, *vs.* PACIFIC BRIDGE COMPANY (a Corporation) and Charles P. Allen, Respondents.	In Equity. No. 834. Motion for Judgment on the Pleadings and Papers on File.

Comes now the above-named complainant, by its attorneys, Wm. F. Booth, N. A. Acker, and Wilshire & Kenaga, and moves the court for judgment and decree in favor of the complainant and against

the above-named respondents, as prayed in the bill of complaint herein.

This motion is based on the pleadings and the papers on file in the above-entitled cause.

WM. F. BOOTH,
N. A. ACKER, AND
WILSHIRE & KENAGA,
Attorneys for Complainant.

Indorsed: Motion for decree & application for shortening of time for notice of hearing motion. Filed this 2nd day of Nov. 1900. A. Reeves Ayres, clerk, by A. N. Moore, deputy.

61 In the Circuit Court of the United States for the District of Washington, Northern Division.

EXCELSIOR WOODEN PIPE COMPANY (a Corporation), Complainant, *vs.* PACIFIC BRIDGE COMPANY (a Corporation) and Charles P. Allen, Respondents.	In Equity. No. 834. Notice of Hearing Complainant's Motion for Judgment and Decree on the Pleadings and Papers on File.

To the above-named respondents and to Messrs. A. R. Titlow and Bogle & Richardson, their solicitors:

You and each of you are hereby notified that, pursuant to the order of the above-entitled court hereto attached, made on the application of the complainant hereto attached, the motion of the above-named complainant, a true copy of which is hereto attached, will be brought on for hearing in the above-entitled court in the court-room thereof at the city of Seattle, in King county, State of Washington, at the hour of ten o'clock a. m. on Monday, the 5th day of November, 1900, which said motion of the complainant is for judgment and decree in favor of the complainant and against the said respondents, as prayed in the bill of complaint herein, and is based on the pleadings and papers on file in the above-entitled cause.

WM. F. BOOTH,
N. A. ACKER, AND
WILSHIRE & KENAGA,
Solicitors for Complainant.

62 In the Circuit Court of the United States for the District of Washington, Northern Division.

EXCELSIOR WOODEN PIPE COMPANY (a Corporation), Complainant,
vs.
PACIFIC BRIDGE COMPANY (a Corporation) and Charles P. Allen, Respondents.
} In Equity. No. 834.

Application for Order Shortening Time for Service of Notice of Hearing Motion for Judgment and Decree on the Pleadings.

Comes now the above-named complainant, by its solicitors, Wm. F. Booth, N. A. Acker, and Wilshire & Kenaga, and hereby applies to this honorable court for an order shortening the time for notice of hearing the motion of the complainant, hereto attached, for judgment and decree on the pleadings and papers on file, so that said motion may be brought on for hearing at ten o'clock a. m. on Monday, the 5th day of November, 1900, and notice of said hearing served forthwith this 2nd day of November 1900, upon Bogle & Richardson, resident solicitors of record for the above-named respondents.

Complainant shows the court that on said 5th day of November, 1900, the parties hereto, by their said solicitors, will appear for the argument of the question of the jurisdiction of this court in said cause, that said day is the last on which this court can hear this motion for a long time owing to the intended absence of Hon. C. H. Hanford, judge of said court, and that said motion can be properly and conveniently taken up in connection with said argument on the question of jurisdiction. That the chief counsel for the complainant reside in San Francisco, California, and will be present on said day for said argument, and the chief counsel of the respondents reside at Tacoma, Washington, near by the city of Seattle, said State, and will also be present on said day for said argument, that it will occasion great inconvenience and expense to complainant's said chief counsel to come from San Francisco for the hearing of said motion at another time, and the full presentation of the questions involved in said motion in the manner desired by all of complainant's counsel will require the presence of complainant's said San Francisco counsel at the hearing of said motion.

WM. F. BOOTH,
N. A. ACKER, AND
WILSHIRE & KENAGA,
Solicitors for Complainant.

STATE OF WASHINGTON, } ss:
County of King, }

W. W. Wilshire, being first duly sworn, on oath deposes and says: I am one of the solicitors for the complainant named in the above-entitled cause; I have read the foregoing application, know the

contents thereof and that the same is true, except as to matters stated upon information, and as to such matters I believe the same to be true.

W. W. WILSHIRE.

Subscribed and sworn to before me this 2nd day of November, 1900.

[NOTARIAL SEAL.] N. S. PETERSON,
Notary Public in and for the State of Washington,
Residing at Seattle, in said State.

63 *Order.*

Now, upon hearing the foregoing application, it is hereby ordered that the time for notice of the hearing of the motion of the above-named complainant for judgment and decree on the pleadings and papers on file in the above-entitled cause be shortened so that said hearing be at ten o'clock a. m. on Monday the 5th day of November, 1900, and said notice be served forthwith, this 2nd day of November, 1900, on the resident solicitors of record for the above-named respondents, namely, Messrs. Bogle & Richardson.

Dated this 2nd day of November, 1900.

C. H. HANFORD, *Judge.*

In the Circuit Court of the United States for the District of Washington, Northern Division.

EXCELSIOR WOODEN PIPE COMPANY (a Corporation), Complainant,
vs.
PACIFIC BRIDGE COMPANY (a Corporation) and Charles P. Allen, Respondents.
} In Equity. No. 834.

Comes now the abve-named complainant, by its attorneys, Wm. F. Booth, N. A. Acker and Wilshire & Kenaga, and moves the court for judgment and decree in favor of the complainant and against the above-named respondents, as prayed in the bill of complaint herein.

This motion is based on the pleadings and the papers on file in the above-entitled cause.

WM. F. BOOTH,
N. A. ACKER, AND
WILSHIRE & KENAGA,
Attorneys for Complainant.

Received copy of the within notice & of the motion, application & order therein mentioned, as attached to this within notice, and service of same admitted, this 2nd day of Nov. 1900.

BOGLE & RICHARDSON,
Solicitors for Respondents.

Indorsed: Notice, application, motion and order. Filed this 3rd day of November, 1900. A. Reeves Ayres, clerk, by R. M. Hopkins, deputy.

64 In the Circuit Court of the United States for the Northern Division of the District of Washington.

EXCELSIOR WOODEN PIPE COMPANY, a Corporation, Complainant, *vs.* PACIFIC BRIDGE COMPANY, a Corporation, and Charles P. Allen, Respondents.	No. 834.	Judgment and Decree.

This cause having been heard on the motion of defendants for an extension of time for the taking of testimony of the defendants herein, and upon such hearing it appearing to the satisfaction of the court, upon an examination of the pleadings herein, that said suit does not really and substantially involve a dispute or controversy properly within the jurisdiction of this court, and that this court should not further exercise jurisdiction—it is therefore

Ordered and decreed that said suit be and the same is hereby dismissed for want of jurisdiction; and that the defendants, The Pacific Bridge Company and Charles P. Allen, do have and recover of the complainant, The Excelsior Wooden Pipe Company, their costs herein, for which let execution issue, if necessary.

Dated at Seattle, Washington, this November 5th, 1900.

C. H. HANFORD, *Judge.*

Indorsed: Judgment & decree dist. of Washington Nov. 5 1900 Filed in the U. S. circuit court A. Reeves Ayres, clerk, H. M. Walthew, dep.

65 In the Circuit Court of the United States for the District of Washington, Northern Division.

THE EXCELSIOR WOODEN PIPE COMPANY (a Corporation), Complainant, *vs.* PACIFIC BRIDGE COMPANY (a Corporation) and CHARLES P. Allen, Respondents.	No. 834.	

Petition for Order Allowing Appeal.

Excelsior Wooden Pipe Company, the complainant in the above-entitled cause, conceived itself aggrieved by the final order and decree made and entered on the fifth day of November, 1900, in the above-entitled cause, whereby it was ordered and decreed that the said suit be dismissed, and the defendants do have and recover their costs, now comes, by Messrs. Wilshire & Kenaga, Wm. F. Booth, Esq., and N. A. Acker, Esq., its solicitors and counsel, and petitions said court for an order allowing it, Excelsior Wooden Pipe Company, to prosecute an appeal from said final order and decree, to the honorable the United States circuit court of appeals for the ninth circuit, under and according to the laws of the United States in that behalf made and provided; and also that an order be made fixing the amount of security

which complainant. Excelsior Wooden Pipe Company, shall give and furnish upon such appeal, and that upon giving such security, all further proceedings in this court be suspended and stayed until the determination of said appeal by said United States circuit
66 court of appeals for the ninth circuit.

And your petitioner will ever pray.

WILSHIRE & KENAGA,
WM. F. BOOTH,
N. A. ACKER,
Solicitors for Complainant, Excelsior Wooden Pipe Company.

Indorsed: Petition for order allowing appeal. Filed in the U. S. circuit court dist. of Washington Dec. 3 1900 A. Reeves Ayres, clerk, R. M. Hopkins, dep.

67 In the United States Circuit Court, District of Washington, Northern Division.

At a stated term, to wit, the September term, A. D. 1900, of the circuit court of the United States of America, of the ninth judicial circuit, in and for the district of Washington, held at the court-room in the city of Spokane on Friday, the 30th day of November, in the year of our Lord one thousand nine hundred.

Present: The Honorable C. H. Hanford, United States district judge.

In Equity.

EXCELSIOR WOODEN PIPE COMPANY (a Corporation), Complainant, *vs.* PACIFIC BRIDGE COMPANY and CHARLES P. ALLEN, Respondents.	No. 834.

Order Allowing Appeal.

On motion of Messrs. Wilshire & Kenaga, William F. Booth, Esq., and N. A. Acker, Esq., counsel for Excelsior Wooden Pipe Company, complainant in the above-entitled cause, it is ordered that an appeal to the United States circuit court of appeals for the ninth circuit from the final order and decree filed and entered herein, to wit, on the fifth day of November, 1900, be, and the same hereby is, allowed, and that a transcript of the record, and all proceedings herein be forthwith transmitted to said United States circuit court of appeals for the ninth circuit upon said complainant, Excelsior Wooden Pipe Company, giving a bond in the sum of five hundred dollars.

C. H. HANFORD,
Presiding Judge.

Indorsed: Order allowing appeal Filed in the U. S. circuit court dist. of Washington Dec. 3 1900 A. Reeves Ayres, clerk, R. M. Hopkins, dep.

68 In the United States Circuit Court of Appeals for the Ninth Circuit.

EXCELSIOR WOODEN PIPE COMPANY, Appellant,
vs.
PACIFIC BRIDGE COMPANY and CHARLES P. ALLEN, Appellees.

Assignment of Errors.

Now comes Excelsior Wooden Pipe Company, appellant herein, by Messrs. Wilshire & Kenaga, Wm. F. Booth and N. A. Acker, its solicitors, and particularly specified the following as the errors upon which it will rely, and which it will urge upon its appeal, in the above-entitled cause:

First.

That the circuit court of the United States for the district of Washington, northern division, erred in not denying the motion of the respondents for an order extending time to take testimony.

Second.

That the said court erred in not granting the motion of complainant for a decree on the pleadings and papers on file in the case.

Third.

That the said court erred in not holding that it had jurisdiction of said suit.

Fourth.

That the said court erred in holding that it had no jurisdiction of said suit.

Fifth.

That the said court erred in dismissing said suit.

69 In order that the foregoing assignment of errors may be and appear of record, the appellant presents the same to the court, and prays that such disposition be made thereof as in accordance with law and the statutes of the United States in such cases made and provided.

All of which is respectfully submitted.

WILSHIRE & KENAGA,
WM. F. BOOTH,
N. A. ACKER,
Solicitors for Appellants.

Indorsed: Assignment of errors. Filed in the U. S. circuit court dist. of Washington. Dec. 3 1900 A. Reeves Ayres, clerk, R. M. Hopkins, dep.

70 In the Circuit Court of the United States for the District of Washington, Northern Division.

EXCELSIOR WOODEN PIPE COMPANY, a Corporation, Complainant,
vs.
PACIFIC BRIDGE COMPANY, a Corporation, and Charles P. Allen, Respondents.

No. 834. In Equity. Bond on Appeal.

(2½c. in revenue stamps affixed and cancelled.)

Know all men by these presents, that we, Excelsior Wooden Pipe Company as principal, and Fidelity and Deposit Company of Maryland as surety are jointly and severally held and firmly bound unto the above-named respondents, Pacific Bridge Company and Charles P. Allen in the penal sum of five hundred dollars ($500.00), for the payment of which we jointly and severally bind ourselves and each of our successors and assigns firmly by these presents.

Witness our hands this 28th day of November, A. D. 1900.

The condition of the above obligation is such that whereas the above-named Excelsior Wooden Pipe Company has prosecuted an appeal to the United States circuit court of appeals for the ninth circuit in the above-entitled action, .

Now, therefore, if the said Excelsior Wooden Pipe Company, complainant and appellant shall prosecute its said appeal to effect, and answer all costs if it shall fail so to do, then this obligation to be void, otherwise to remain in full force and effect.

EXCELSIOR WOODEN PIPE CO., *Principal*,
By WILSHIRE & KENAGA, *Its Attorneys.*
FIDELITY AND DEPOSIT COMPANY OF MARYLAND, *Surety*,
By W. W. WILSHIRE,
One of Its Local Board of Directors.

Attest: JOHN A. WHALLEY & CO.,
General Agents.

[Seal F. & D. C. of M.]

71 The foregoing bond is hereby approved this 30th day of November, A. D. 1900.

C. H. HANFORD, *Judge.*

Indorsed: Bond on appeal. Filed in the U. S. circuit court dist. of Washington Dec. 3 1900. A. Reeves Ayres, clerk, R. M. Hopkins, dep.

72 In the Circuit Court of the United States for the District of Washington, Northern Division.

THE EXCELSIOR WOODEN PIPE COMPANY, a Corporation, Complainant,
vs.
PACIFIC BRIDGE COMPANY, a Corporation, and CHARLES P. ALLEN, Respondents.
No. 834.

UNITED STATES OF AMERICA, *District of Washington,* } ss:

I, A. Reeves Ayres, clerk of the circuit court of the United States for the district of Washington, do hereby certify that on the 3rd day of December, 1900, upon the appeal of the above-entitled cause from the circuit court of the United States for the district of Washington, to the United States circuit court of appeals for the ninth judicial circuit, there was duly and regularly issued in said cause out of said circuit court, in proper form, an original citation, directed to the appellees in said appeal mentioned, wherein and whereby said appellees were required to be and appear in said United States circuit court of appeals for the ninth circuit within the time limited therefor by law and the rules of said appellate court; and that on the 4th day of December, 1900, said original citation was filed by me in the above-entitled court and cause with the admission by the solicitors for appellees therein of service thereof endorsed thereon; that said original citation was by me attached to and made a part of the transcript on appeal above mentioned, and, together with said transcript, was by me forwarded to the United States circuit court of appeals for the ninth circuit.

Witness my hand, and the seal of said circuit court, this 10th day of July, 1901.

{Seal United States Circuit Court, Northern Division, District of Washington.}

A. REEVES AYRES, *Clerk,*
By H. M. WALTHEW,
Deputy Clerk.

73 MAY 27, 1901.

General Order Book, Circuit Court, volume 6, page 582.

EXCELSIOR WOODEN PIPE COMPANY
vs.
PACIFIC BRIDGE COMPANY ET AL.
834.

Now on this 27th day of May, 1901, comes W. W. Wilshire, Esq., and presents the mandate of the circuit court of appeals in the above-entitled cause, and upon motion it is ordered that said mandate be filed and spread at large upon the records of this court.

74 UNITED STATES OF AMERICA, *ss:*

[SEAL.] The President of the United States of America to the honorable the judges of the circuit court of the United States for the district of Washington, northern division, Greeting:

Whereas, lately in the circuit court of the United States for the district of Washington, northern division, before you, or some of you, in a cause between Excelsior Wooden Pipe Company (a corporation), complainant, and Pacific Bridge Company (a corporation), and Charles P. Allen, respondents, No. 834, an order or decree was duly filed and entered, which said order or decree is of record in said cause in the office of the clerk of said circuit court (to which record reference is hereby made and the same is hereby expressly made a part hereof), as by the inspection of the transcript of the record of the said circuit court, which was brought into the United States circuit court of appeals for the ninth circuit by virtue of an appeal agreeably to the act of Congress in such cases made and provided, fully and at large appears:

And whereas, on the 13th day of February in the year of our Lord one thousand, nine hundred and one, the said cause came on to be heard before the said circuit court of appeals, on the said transcript of record, and a motion of counsel for the appellees to dismiss the appeal, and was duly submitted to the court for consideration and decision:

On consideration whereof, it is now here ordered, adjudged and decreed by this court, that the appeal herein be, and the same is hereby dismissed.

(MAY 6, 1901.)

75 You, therefore, are hereby commanded that such further proceedings be had in said cause, as according to right and justice and the laws of the United States ought to be had, the said appeal notwithstanding.

Witness the Honorable Melville W. Fuller, Chief Justice of the United States, the 22nd day of May in the year of our Lord one thousand nine hundred and one.

F. D. MONCKTON,
Clerk of the United States Circuit Court of Appeals for the Ninth Circuit.

Indorsed: Mandate. Filed in the U. S. circuit court dist. of Washington May 27 1901 A. Reeves Ayres, clerk, A. N. Moore, dep.

76 In the United States Circuit Court of Appeals for the Ninth Circuit.

EXCELSIOR WOODEN PIPE COMPANY, Appellant,
vs.
PACIFIC BRIDGE COMPANY and CHARLES P. Allen, Appellees.

No. 668. Motion to Dismiss.

The appellees, Pacific Bridge Company, and Charles P. Allen, by their attorneys, A. R. Titlow, W. H. Bogle and Chas. Richardson, move the court for an order dismissing the appeal of The Excelsior Wooden Pipe Company, appellant herein, for lack of jurisdiction in this court to hear and determine the question presented by the record herein for determination, for the reason that the order of the circuit court of the United States from which such appeal is prosecuted was and is an order dismissing said cause solely for want of jurisdiction in said circuit court to hear and determine the same, and in which order no other question was involved, nor determined by said circuit court; and this court is without authority to exercise appellate jurisdiction to review by appeal a final decision of the circuit court in which decision the jurisdiction of that court was the sole question in issue and decided.

A. R. TITLOW,
W. H. BOGLE,
CHAS. RICHARDSON,
Solicitors for Appellees.

(Endorsed:) Receipt of a copy and due service hereof admitted this 24th day of Jan'y, 1901. Wm. F. Booth, N. A. Acker and Wilshire & Kenaga, attorneys for plaintiff. Motion to dismiss. Filed Jan. 28, 1901, F. D. Monckton, clerk.

77 I, Frank D. Monckton, clerk of the United States circuit court of appeals for the ninth circuit, do hereby certify the foregoing to be a full, true and correct copy of a motion to dismiss filed in the above-entitled cause as the original thereof remains and appears of record in my office.

Attest my hand and the seal of said circuit court of appeals at San Francisco, California, this 22nd day of May, A. D. 1901.

[SEAL.] F. D. MONCKTON, *Clerk.*

(10c. revenue stamp affixed and cancelled.)

Indorsed: Certified copy of motion to dismiss appeal to U. S. circuit court of appeals. Filed in the U. S. circuit court dist. of Washington May 27 1901 A. Reeves Ayres, clerk, A. N. Moore, dep.

78 In the United States Circuit Court of Appeals for the Ninth Circuit.

EXCELSIOR WOODEN PIPE COMPANY, Appellant,
vs.
PACIFIC BRIDGE COMPANY and CHARLES P. ALLEN, Appellees.

Wm. F. Booth, N. A. Acker, W. W. Wilshire, A. H. Kenaga, for appellant.
A. R. Titlow, W. H. Bogle, Chas. Richardson, for the appellees.

Before Gilbert, Ross, and Morrow, circuit judges.

GILBERT, circuit judge, delivered the opinion of the court.

The appeal is taken from an order dismissing the bill of complaint in a suit brought to enjoin infringement of certain letters patent. After the issues were made and the time within which to take proofs under equity rule 69 had expired the defendants in the suit filed a motion for extension of such time. Upon calling and hearing this motion the court asked for argument on the question of its jurisdiction of the controversy. The complainant thereupon filed a motion for a decree on the pleadings and papers on file in the cause. The court without deciding either motion dismissed the suit for want of jurisdiction upon the ground that in the opinion of the court the cause was one arising on contract and not under the patent laws of the United States, and was not a case in which there was diversity of citizenship of the parties. The complainant appealed from the decree of dismissal assigning that the court erred in dismissing the cause for want of jurisdiction, and in not denying the appellees' motion for an extension of their time to take testimony, and in not allowing the complainant's motion for a decree on pleadings and papers on file. The appellees now move to dismiss the ap-
79 peal upon the ground that the only question involved on such appeal is the question of the jurisdiction of the circuit court to entertain the suit.

The motion to dismiss must be allowed. In construing that portion of the act of March 3, 1891, establishing the circuit court of appeals which provided that appeals and writs of error may be taken from the existing circuit courts directly to the Supreme Court in any case in which the jurisdiction of the court is in issue, the Supreme Court in McLish *v.* Roff, 141 U. S. 661, held that "when that judgment is rendered, the party against whom it is rendered must elect whether he will take his writ of error or appeal to the Supreme Court upon the question of jurisdiction alone, or to the circuit court of appeals upon the whole case." In order that the circuit court of appeals may entertain the appeal there must be in the case something more than the question of the jurisdiction. In U. S. *v.* Jahn, 155 U. S. 114, the court, further construing the act, announced these general conclusions:

"(1.) If the jurisdiction of the circuit court is in issue and decided in favor of the defendant, as that disposes of the case, the plaintiff

should have the question certified and take his appeal or writ of error directly to this court; (2) if the question of jurisdiction is in issue, and the jurisdiction sustained, and then judgment or decree is rendered in favor of the defendant on the merits, the plaintiff, who has maintained the jurisdiction, must appeal to the circuit court of appeals, where, if the question of jurisdiction arises, the circuit court of appeals may certify it; (3) if the question of jurisdiction is in issue, and the jurisdiction sustained, and judgment on the merits is rendered in favor of the plaintiff, then the defendant can elect either to have the question certified and come directly to this court, or to carry the whole case to the circuit court of appeals,
80 and the question of jurisdiction can be certified by that court; (4) if in the case last supposed the plaintiff has ground of complaint in respect of the judgment he has recovered, he may also carry the case to the circuit court of appeals on the merits, and this he may do by way of cross-appeal or writ of error if the defendant has taken the case there, or independently, if the defendant has carried the case to this court on the question of jurisdiction alone, and in this instance the circuit court of appeals will suspend a decision upon the merits until the question of jurisdiction has been determined; (5) the same observations are applicable where a plaintiff objects to the jurisdiction and is, or both parties are, dissatisfied with the judgment on the merits." The present case comes within the class of cases referred to in the first clause of the language above quoted. It is a case in which the question of the jurisdiction of the circuit court only is in issue. That question was decided in favor of the defendants and the case was thereby disposed of. Although there were other questions pending before the court at the time of ruling upon the question of jurisdiction and dismissing the suit those questions have not been determined and are not involved in the present appeal. They are questions upon which the judgment of the circuit court has not been taken. It cannot be assigned as error that the circuit court failed to deny the appellees' motion for an extension of time within which to take testimony, or that it failed to allow the appellant's motion for a decree upon the pleadings. There has been no decision of any question in the case except the question of jurisdiction. The act creating the circuit courts of appeals does not give them the jurisdiction to review a judgment of a circuit court which sustains objections to its jurisdiction and on that
81 ground dismisses the suit. The question is not affected by the fact that the circuit court at the time of ordering such dismissal had before it other motions and questions which for the reason that it denied its own jurisdiction it never decided. Gates *v.* Bucki, 4 C. C. A. 116, 124. Davis *v.* Rankin, 9 C. C. A. 79. Cabot *v.* McMaster, 13 C. C. A. 39. Beck & Pauli Lith. Co. *v.* Wacker *et al.*, 22 C. C. A., 11. Evans Snider Buell Co. *v.* McCaskill, 41 C. C. A., 577. Dudley *v.* Board of Com'rs, Lake Co. 103 Fed. 209. Wetmore *v.* Rymer, 169 U. S. 115. The appeal is dismissed.

(Endorsed:) Opinion. Filed May 6 1901 F. D. Monckton, clerk.

I, Frank D. Monckton, clerk of the United States circuit court of appeals for the ninth circuit, do hereby certify the foregoing to be a full, true and correct copy of an opinion filed in the cause entitled Excelsior Wooden Pipe Company, appellant, *v.* Pacific Bridge Company *et al.* No. 668, as the original thereof remains and appears of record in my office.

Attest my hand and the seal of said circuit court at San Francisco, California, this 22nd day of May, A. D. 1901.

[SEAL.] F. D. MONCKTON, *Clerk.*

(10c. revenue stamp affixed & cancelled.)

Indorsed: Certified copy of opinion of circuit court of appeals dismissing appeal. Filed in the U. S. circuit court dist. of Washington. May 27 1901. A. Reeves Ayres, clerk, A. N. Moore, dep.

82 In the Circuit Court of the United States for the District of Washington, Northern Division.

EXCELSIOR WOODEN PIPE COMPANY, a Corporation, Complainant,
vs.
PACIFIC BRIDGE COMPANY, a Corporation, and CHARLES P. ALLEN, Respondents. } No. 834.

Petition for Order Allowing Appeal.

Excelsior Wooden Pipe Company, the complainant in the above-entitled cause, conceiving itself aggrieved by the final order and decree dismissing said suit for want of jurisdiction, said order and decree being made and entered on the fifth day of November, 1900, in the above-entitled cause as follows:

In the Circuit Court of the United States for the Northern Division of the District of Washington.

EXCELSIOR WOODEN PIPE COMPANY (a Corporation), Complainant,
vs.
PACIFIC BRIDGE COMPANY (a Corporation), and CHARLES P. Allen, Respondents. } No. 834.

Decree.

This cause having been heard on the motion of defendants for an extension of time for the taking of testimony of the defendants herein, and upon such hearing it appearing to the satisfaction of the court, upon an examination of the pleadings herein, that said suit does not really and substantially involve a dispute or controversy properly within the jurisdiction of this court, and that this court should not further exercise jurisdiction; it is, therefore,

Ordered and decreed that said suit be, and the same is, hereby

dismissed for want of jurisdiction; and that the defendants, The Pacific Bridge Company, and Charles P. Allen, do have and recover of the complainant, The Excelsior Wooden Pipe Company, their costs herein, for which let execution issue, if necessary.

Dated at Seattle, Washington, this November 5th, 1900.

C. H. HANFORD, *Judge.*

(Endorsed:) Judgment and decree. Filed November 5, 1900, A. Reeves Ayres, clerk. H. M. Walthew, deputy.

83 Now comes, by Messrs. Wilshire & Kenaga, Wm. F. Booth, Esq., and N. A. Acker, Esq., its solicitors and counsel, and petitions said court for an order allowing it, Excelsior Wooden Pipe Company, to prosecute an appeal from said final order and decree dismissing said suit for want of jurisdiction, to the honorable the Supreme Court of the United States, under and according to the laws of the United States in that behalf made and provided; and also that an order be made fixing the amount of security which complainant, Excelsior Wooden Pipe Company, shall give and furnish upon such appeal.

And your petitioner will ever pray.

WILSHIRE & KENAGA,
WM. F. BOOTH,
N. A. ACKER,
Sol's for Complainant.

Indorsed: Petition for order allowing appeal. Filed in the U. S. circuit court dist. of Washington May 27 1901 A. Reeves Ayres, clerk, A. N. Moore, dep.

84 In the United States Circuit Court, District of Washington, Northern Division.

At a stated term, to wit, the December term, A. D. 1900, of the circuit court of the United States of America, of the ninth judicial circuit, in and for the district of Washington, held at the court-room in the city of Seattle, on the 27th day of May in the year of our Lord one thousand nine hundred and one.

Present: The Honorable C. H. Hanford, United States circuit judge.

In Equity.

EXCELSIOR WOODEN PIPE COMPANY (a Corporation), Complainant,
vs.
PACIFIC BRIDGE COMPANY (a Corporation) and CHARLES P. Allen, Respondents. } No. 834.

Order Allowing Appeal.

On motion of Messrs. Wilshire & Kenaga, William F. Booth, Esq., and N. A. Acker, counsel for Excelsior Wooden Pipe Company,

complainant in the above-entitled cause, it is ordered that an appeal to the Supreme Court of the United States from the final order and decree dismissing said suit for want of jurisdiction, said order and decree being filed and entered herein, to wit, on the fifth day of November, 1900, as follows:

In the United States Circuit Court for the Northern Division of the District of Washington.

EXCELSIOR WOODEN PIPE COMPANY (a Corporation), Complainant, *vs.* PACIFIC BRIDGE COMPANY (a Corporation) and CHARLES P. ALLEN, Respondents. } No. 834.

85 *Decree.*

This cause having been heard on the motion of defendants for an extension of time for the taking of testimony of the defendants herein, and upon such hearing it appearing to the satisfaction of the court, upon an examination of the pleadings herein, that said suit does not really and substantially involve a dispute or controversy properly within the jurisdiction of this court, and that this court should not further exercise jurisdiction, it is therefore,

Ordered and decreed that said suit be, and the same is hereby, dismissed for want of jurisdiction; and that the defendants, The Pacific Bridge Company, and Charles P. Allen, do have and recover of the complainant, The Excelsior Wooden Pipe Company, their costs herein, for which let execution issue, if necessary.

Dated at Seattle, Washington, this November 5th, 1900.

C. H. HANFORD, *Judge.*

(Endorsed:) Judgment and decree. Filed November 5, 1900. A. Reeves Ayres, clerk, H. M. Walthew, deputy.

Be and the same hereby is, allowed, and that a transcript of the record and all proceedings herein be forthwith transmitted to the said the Supreme Court of the United States, upon said complainant, Excelsior Wooden Pipe Company, giving a bond in the sum of five hundred dollars.

C. H. HANFORD, *Judge.*

Indorsed: Order allowing appeal. Filed in the U. S. circuit court dist. of Washington May 27 1901 A. Reeves Ayres, clerk, A. N. Moore, dep.

86 In the Supreme Court of the United States.

EXCELSIOR WOODEN PIPE COMPANY, Appellant,
vs.
PACIFIC BRIDGE COMPANY and CHARLES P. ALLEN, Appellees.

Assignment of Errors.

Now comes Excelsior Wooden Pipe Company, appellant herein, by Messrs. Wilshire & Kenaga, Wm. F. Booth and N. A. Acker, its solicitors; and particularly specifies the following as the errors upon which it will rely, and which it will urge upon its appeal in the above-entitled cause:

First.

That the circuit court of the United States for the district of Washington, northern division, erred in holding that upon examination of the pleadings in the above-entitled suit, said suit did not really and substantially involve a dispute or controversy properly within the jurisdiction of said court and that said court should not further exercise jurisdiction.

Second.

That the said court erred in dismissing said suit for want of jurisdiction.

In order that the foregoing assignment of errors may be and appear of record, the appellant presents the same to the court, and prays that such disposition be made thereof as in accordance with law and the statutes of the United States in such cases made and provided.

All of which is respectfully submitted.

N. A. ACKER,
WM. F. BOOTH,
WILSHIRE & KENAGA,
Solicitors for Appellant.

Indorsed: Assignment of errors. Filed in the U. S. circuit court dist. of Washington, May 27 1901 A. Reeves Ayres, clerk, A. N. Moore, dep.

87 In the Circuit Court of the United States for the District of Washington, Northern Division. In Equity.

EXCELSIOR WOODEN PIPE COMPANY (a Corporation), Complainant,
vs.
PACIFIC BRIDGE COMPANY (a Corporation) and Charles P. Allen, Respondents.
No. 834.

Bond on Appeal.

Know all men by these presents, that we, Excelsior Wooden Pipe Company, as principal, and Fidelity and Deposit Company of

Maryland, as surety, are jointly and severally held and firmly bound unto the above-named respondents, Pacific Bridge Company and Charles P. Allen, in the penal sum of five hundred dollars ($500.00) for the payment of which we jointly and severally bind ourselves and each of our successors and assigns firmly by these presents.

Witness our hands this 27th day of May A. D. 1901.

The condition of the above obligation is such that, whereas the above-named Excelsior Wooden Pipe Company has prosecuted an appeal to the Supreme Court of the United States in the above-entitled action:

Now, therefore, if the said Excelsior Wooden Pipe Company, complainant and appellant, shall prosecute its said appeal to effect, and answer all costs if it shall fail so to do, then this obligation to be void; otherwise to remain in full force and effect.

EXCELSIOR WOODEN PIPE COMPANY,
By W. W. WILSHIRE,
One of Its Attorneys of Record.

[SEAL.] FIDELITY AND DEPOSIT COMPANY OF MARYLAND,
By A. CHILBERG,
Member of Seattle Local Board of Directors.

(3c. revenue stamp affixed and cancelled.)

88 The foregoing bond is hereby approved this 27th day of May 1901.

C. H. HANFORD, *Judge.*

Indorsed: Bond on appeal. Filed in the U. S. circuit court dist. of Washington. May 27 1901 A. Reeves Ayres, clerk, A. N. Moore, dep.

89 *Citation.*

UNITED STATES OF AMERICA, *ss:*

The President of the United States to Pacific Bridge Company and Charles P. Allen, Greeting:

You are hereby cited and admonished to be and appear at the Supreme Court of the United States, to be holden at the city of Washington, in the District of Columbia, on the 22nd day of July, A. D. 1901, pursuant to an order allowing appeal, filed and entered in the clerk's office of the circuit court of the United States, ninth circuit, district of Washington, northern division, in a certain action, numbered 834, wherein Excelsior Wooden Pipe Company, was named as complainant, and you, Pacific Bridge Company, and Charles P. Allen, were the respondents, Excelsior Wooden Pipe Company being now appellant, and you, Pacific Bridge Company and Charles P. Allen, are now appellees, to show cause, if any there be, why the final decree and order rendered against the said appellant, as in said order allowing appeal mentioned, should not be cor-

rected, and why speedy justice should not be done to the parties in that behalf.

Witness the Honorable Melville W. Fuller, Chief Justice of the Supreme Court of the United States this 27th day of May, 1901.

[Seal U. S. C. C.]

C. H. HANFORD,
United States District Judge, Presiding in said Circuit Court for the District of Washington.

Service of within citation and receipt of a copy thereof is hereby admitted this 27th day of May, 1901.

A. R. TITLOW,
BOGLE & RICHARDSON,
Attorneys for Appellees.

Indorsed: Citation. Filed in the U. S. circuit court dist. of Washington May 27 1901. A. Reeves Ayres, clerk, A. N. Moore, dep.

90 In the Circuit Court of the United States for the District of Washington.

EXCELSIOR WOODEN PIPE COMPANY, a Corporation, Complainant and Appellant,
vs.
PACIFIC BRIDGE CO. and CHARLES P. ALLEN, Respondents and Appellees.
No. 834. Præcipe.

To the clerk of the above-entitled court:

You will please prepare and certify for transmission to and filing in the Supreme Court of the United States a transcript on appeal to include all the pleadings, papers and entries, and the whole record in the above-entitled cause, excepting only the unpublished deposition of D. C. Henny.

WILSHIRE & KENAGA,
Solicitors for Complainant and Appellant.

Indorsed: Præcipe Filed in the U. S. circuit court dist. of Washington May 27 1901 A. Reeves Ayres, clerk, A. N. Moore, dep.

91 In the Circuit Court of the United States in and for the District of Washington, Northern Division.

EXCELSIOR WOODEN PIPE CO., Complainant,
vs.
PACIFIC BRIDGE CO. and CHARLES P. ALLEN, Respondents.
No. 834.

Stipulation as to Transcript on Appeal.

It is hereby stipulated by and between the parties hereto, that the unpublished deposition of D. C. Henny, heretofore taken in this

cause, may be omitted from the transcript of the record to be transmitted to the Supreme Court of the United States under the order allowing appeal herein.

W. W. WILSHIRE,
A. H. KENAGA,
WM. F. BOOTH,
N. A. ACKER,
Solicitors for Complainant.

A. R. TITLOW,
BOGLE & RICHARDSON,
Solicitors for Respondents.

Indorsed: Stipulation as to transcript to U. S. Sup. Ct. Filed in the U. S. circuit court dist. of Washington May 27 1901 A. Reeves Ayres, clerk, A. N. Moore, dep.

92 In the Circuit Court of the United States for the District of Washington, Northern Division.

THE EXCELSIOR WOODEN PIPE COMPANY, a Corporation, Complainant,
vs.
PACIFIC BRIDGE COMPANY, a Corporation, and CHARLES P. Allen, Respondents. } No. 834.

UNITED STATES OF AMERICA, *District of Washington,* } *ss:*

I, A. Reeves Ayres, clerk of the circuit court of the United States for the district of Washington, do hereby certify the foregoing ninety-one (91) typewritten pages, numbered from 1 to 91, inclusive, to be a full, true, and correct copy of the record and proceedings in the above and therein entitled cause as the same remains on file and of record in the office of the clerk of said court, and that the same constitute the transcript on appeal in the above-entitled cause from the circuit court of the United States for the district of Washington, northern division, to the Supreme Court of the United States.

I further certify that I annex hereto and herewith transmit the original citation in said cause.

I further certify that the cost of preparing and certifying the foregoing transcript of the record on appeal is the sum of $27.65, and that the same has been paid to me by W. W. Wilshire, Esq., of counsel for complainant and appellant above named, The Excelsior Wooden Pipe Company, a corporation.

Witness my hand and the seal of said circuit court this 10th day of July, 1901.

{Seal United States Circuit Court, Northern Division, District of Washington.}

A. REEVES AYRES, *Clerk,*
By H. M. WALTHEW,
Deputy Clerk.

93 *Citation.*

UNITED STATES OF AMERICA, *ss:*

The President of the United States to Pacific Bridge Company and Charles P. Allen, Greeting:

You are hereby cited and admonished to be and appear at the Supreme Court of the United States, to be holden at the city of Washington, in the District of Columbia, on the 22nd day of July A. D. 1901 pursuant to an order allowing appeal, filed and entered in the clerk's office of the circuit court of the United States, ninth circuit, district of Washington, northern division, in a certain action, numbered 834, wherein Excelsior Wooden Pipe Company, was named as complainant, and you, Pacific Bridge Company, and Charles P. Allen, were the respondents, Excelsior Wooden Pipe Company being now appellant, and you, Pacific Bridge Company and Charles P. Allen, are now appellees, to show cause, if any there be, why the final decree and order rendered against the said appellant, as in said order allowing appeal mentioned, should not be corrected, and why speedy justice should not be done to the parties in that behalf.

Witness the Honorable Melville W. Fuller, Chief Justice of the Supreme Court of the United States, this 27th day of May, 1901.

{ Seal United States Circuit Court, District of Washington, Northern Division. }

C. H. HANFORD,
United States District Judge, Presiding in said Circuit Court for the District of Washington.

Admission of service on inside cover.

94 Service of within citation and receipt of a copy thereof is hereby admitted this 27th day of May, 1901.

A. R. TITLOW,
BOGLE & RICHARDSON,
Attorneys for Appellees.

95 [Endorsed:] 834 Citation In the Supreme Court of the United States Excelsior Wooden Pipe Company, appellant, *vs.* Pacific Bridge Co. and Charles P. Allen appellees. Citation Filed in the U. S. circuit court, dist. of Washington, May 27 1901 A. Reeves Ayres, clerk A. N. Moore dep. N. A. Acker, W. W. Wilshire A. H. Kenaga Wm. F. Booth, solicitors for appellants.

Endorsed on cover: File No. 18,228. Washington C. C. U. S. Term No. 375. Excelsior Wooden Pipe Company, appellant *vs.* Pacific Bridge Company and Charles P. Allen. Filed July 17, 1901.

No. [illegible]

IN THE [illegible]

EXCELSIOR [illegible] COMPANY,

Appellant.

vs.

PACIFIC BRIDGE COMPANY
and CHARLES P. ALLEN,

Appellees.

Appeal from the Circuit Court of the United States for the Southern District of Washington, Northern Division.

Motion to Advance Cause, Notice of Said Motion, and Brief of Appellant upon Said Motion.

W. A. ACKER and
L. B. BACON,
Solicitors for Appellant.

Filed , 1901.

Pacific Sheet & Tin Plate Printing Co., S. F.

THE SUPREME COURT

OF THE

UNITED STATES.

October Term 1901.

EXCELSIOR WOODEN PIPE COMPANY,

Appellant,

vs.

PACIFIC BRIDGE COMPANY AND CHARLES P. ALLEN,

Appellees.

No. 375.

Motion to Advance Case.

Comes now the appellant, above named, by its counsel, N. A. Acker, Esq., and L. S. Bacon, Esq., and moves the Court to advance the above entitled case. The facts and objects of this motion are, briefly stated, these:

This is an appeal under Section 5 of the Act of March 3, 1891, from the Circuit Court of the United States for the District of Washington, Northern Division, in the case of Excelsior Wooden Pipe Company, complainant, vs. Pacific Bridge Company and Charles P. Allen, respondents, No.

834, wherein the only question in issue is the question of the jurisdiction of the Court below, and appellant desires an early determination of said question, by advancing said appeal upon the calendar under the provisions of Rule 32 of this Court, as promulgated March 10, 1890, and amended November 28, 1892.

N. A. ACKER,

L. S. BACON,
Solicitors for Appellant.

To A. R. TITLOW, Esq.,
W. H. BOGLE, Esq., and
CHARLES RICHARDSON, Esq.,
Solicitors and Counsel for Appellees.

You will please take notice that on Monday, the 4th day of November, 1901, at the opening of the Court, or as soon thereafter as counsel can be heard, appellant above named will make and present to the Supreme Court of the United States the foregoing Motion to Advance Case, and will submit said motion to said court for its decision.

Annexed hereto is a copy of the brief or argument to be submitted with said motion in support thereof.

N. A. ACKER,

and L. S. BACON,
Solicitors for Appellant.

The Supreme Court of the United States,
October Term 1901.

EXCELSIOR WOODEN PIPE COMPANY,
Appellant,

vs.

PACIFIC BRIDGE COMPANY AND CHARLES P. ALLEN,
Appellees.

No. 375.

Brief or Argument on Motion to Advance Case.

This is a motion to advance the case under Rule 32.

The appeal is from the Circuit Court of the United States for the District of Washington, Northern Division, from a final decree, dismissing the Bill of Complaint for want of jurisdiction.

The Bill of Complaint was filed March 23, 1900. (Printed Record, page 1.) The answer was filed June 9, 1900. Replication was filed June 21, 1900. Time having expired under Equity Rule 69, respondents filed a motion, October 18, 1900, for an order extending time to take testimony. (Printed Record, page 28.) This motion was submitted October 29, 1900, and taken under advisement by the Court. (Page 33).

Complainants, on November 2, 1900, filed a motion for a Decree on the Pleadings, and set it for hearing on November 5, 1900. (Page 34).

On said last named date, to-wit, November 5, 1900, the Court, after hearing, at its own request, arguments on the question of its jurisdiction, and without hearing any argument upon or considering either the respondents' motion for an Extension of Time, or complainant's motion for a Decree on the Pleadings, or deciding either motion, made and entered the final decree, (page 38), wherein it was stated that "it appearing to the satisfaction of the Court, upon an examination of the pleadings herein, that said suit does not really and substantially involve a dispute or controversy properly within the jurisdiction of this Court, and that this Court should not further exercise jurisdiction, it is, therefore, Ordered and Decreed that said suit be, and the same is, hereby dismissed for want of jurisdiction."

Thereafter, December 3, 1900, complainant perfected an appeal to the United States Circuit Court of Appeals for the Ninth Circuit, assigning as errors the failure of the Court to pass upon the two motions, as well as the dismissal of the suit for want of jurisdiction. (Pages 38–41.)

This appeal was duly docketed December 14, 1900, as No. 668, in said Circuit Court of Appeals.

Thereafter, Jan. 28, 1901, appellees filed in said Court of Appeals a Motion to Dismiss the Appeal, on the ground that said United States Circuit Court of Appeals had no jurisdiction "to hear and determine the question presented by the record herein for determination, for the reason that the order of the Circuit Court of the United States, from which such appeal is prosecuted, was and is an order dismissing said cause solely for want of jurisdiction in said Circuit Court to hear and determine the same, and in which order no other question was involved, nor determined by said Circuit Court; and this Court is without authority to exercise appellate jurisdiction to review by appeal a final decision of the Circuit Court in which decision the jurisdiction of that Court was the sole question in issue and decided." (Page 44.)

The Circuit Court of Appeals, thereafter, on May 6, 1901, granted said motion to dismiss, and did dismiss, the appeal, on the ground that the sole question at issue and the question decided by the Court below was a question of

jurisdiction. The Court of Appeals handed down a written opinion, which will be found in the record (page 45), and which is reported in 109 Federal Reporter, 497.

The mandate dismissing the appeal was duly issued (page 43), and was filed in the lower Court May 27, 1901.

On the same day, May 27, 1901, after said mandate was filed, complainant, present appellant, perfected, under Rules 35 and 36 of this Court, promulgated May 11, 1891, this appeal to the Supreme Court of the United States, assigning as the only and sole errors of the Court below the holding of said Court that it had no jurisdiction of said suit, and dismissing said suit for want of jurisdiction. (Pages 47–52.)

From the foregoing, it will be seen that the only and sole question involved in this appeal is a question of jurisdiction. The transcript shows that no other question was decided; the decree of the lower Court shows on its face that only a question of jurisdiction was involved and decided; and, finally, the dismissal of the appeal by the Circuit Court of Appeals, and the opinion of said Court therein, practically made it the law of the case that no question is involved other than that of jurisdiction of the lower Court, and that said question is the sole question in issue.

The present appeal being taken direct from the Circuit Court to this Court, under Section 5 of the Act of March 3, 1891, in accordance with Rules 35 and 36 of this Court, and the only question in issue being the question of the jurisdiction of the Court below, the present motion to advance is proper under Rule 32 of this Court, as amended November 28, 1892.

Respectfully submitted,

N. A. ACKER,

L. S. BACON,
Solicitors for Appellant.

IN THE

THE SUPREME COURT

OF THE

UNITED STATES.

October Term 1901.

EXCELSIOR WOODEN PIPE COMPANY,

Appellant,

vs.

PACIFIC BRIDGE COMPANY AND CHARLES P. ALLEN,

Appellees.

No. 375.

Appellant's Brief on Appellees' Motion to Dismiss Appeal.

This is an appeal from a final decree, dismissing the suit for want of jurisdiction.

The suit was brought in the Circuit Court of the United States for the District of Washington, Northern Division.

History of the Appeal.

The record on appeal shows the following steps in the suit:

The Bill of Complaint was filed March 23d, 1900, and process duly issued and served.

Answer was filed June 9th, 1900.

Replication was filed June 21st, 1900.

Time having expired September 21st, 1900, under Equity Rule 69, within which to take proofs, defendants filed motion to extend the time. The motion for extension was taken under advisement.

Complainant filed a motion for a decree on the pleadings and papers on file in the case.

On November 5th, 1900, these motions being on the calendar, the Court, without hearing them, requested argument on the question of jurisdiction, heard such argument, and, thereupon, divested itself of jurisdiction, and the same day made a decree dismissing the bill for want of jurisdiction. (Page 38 of record).

Thereafter, on December 3d, 1900, complainant perfected an appeal from said decree to the United States Circuit Court of Appeals for the Ninth Circuit. (Record pages 38 to 41).

Appellees, on January 28th, 1901, filed in said Court of Appeals a motion to dismiss said appeal "for lack of jurisdiction in this Court to hear and determine the question presented by the record herein for determination, for the reason that the order of the Circuit Court of the United States from which such appeal is prosecuted was and is an order dismissing said cause solely for want of jurisdiction in said Circuit Court to hear and determine the same, and in which order no other question was involved, nor determined by said Circuit Court; and this Court is without authority to exercise appellate jurisdiction to review by appeal a final decision of the Circuit Court in which decision the jurisdiction of that Court was the sole question in issue and decided."

On May 6th, 1901, the United States Circuit Court of Appeals for the Ninth Circuit, allowed said motion, and dismissed the appeal for want of jurisdiction to entertain it, upon the grounds set forth in the motion, to wit, that the sole question in the case was the jurisdiction of the Court below. The opinion of the Circuit Court of Appeals, granting the motion to dismiss, will be found in the

printed record page 45. It is also reported in 109 Federal Reporter, 497.

The mandate of said Court of Appeals dismissing the appeal was thereafter duly issued, and on the 27th day of May, 1901, was filed and spread upon the minutes of the Court below. (Record pages 42–43).

On the same day, the 27th day of May, 1901, complainant, present appellant, perfected the present appeal to this Court from the order and decree of the Circuit Court of the United States for the District of Washington, Northern Division, made and entered on the 5th day of November, 1900, dismissing said suit for want of jurisdiction. (Record pages 47–52).

This appeal is taken under Section 5 of the Act of March 3rd, 1891, defining and regulating in certain cases the jurisdiction of the Courts of the United States.

The appeal is perfected in accordance with Rules 35 and 36 of this Court.

The errors assigned (page 50 of printed record), are:—

First—The error of the Court in holding that upon examination of the pleadings, the suit did not really and substantially involve a dispute or controversy properly within the jurisdiction of the Court, and that said Court should not further exercise jurisdiction.

Second—The error of the Court in dismissing the suit for want of jurisdiction.

Argument.

The present appeal is timely. It may be taken at any time within two years from the making and entering of the final decree appealed from.

Holt vs. Indiana Manufacturing Co., 176, U. S. 68.

If, however, the appeal from the question of jurisdiction is taken up by way of the certificate mentioned in the first clause of Sec. 5 of the Act of 1891, said certificate must be signed within the term at which the decree ap-

pealed from was made. Otherwise the appeal is out of time.

Maynard vs; Hecht, 151 U. S. 324.
Colvin vs. Jacksonville, 158 U. S. 456.
The Bayonne, 162 U. S. 329.
Merrit vs. Bowdoin College, 169 U. S. 551.

When, therefore, a certificate is *used*, or when one is *needed* to present the sole question of jurisdiction to this Court, the term of the lower Court affects and limits the time within which the appeal may be taken. Otherwise the two year limit is unaffected.

It is not every case which needs a certificate, to present the sole question of jurisdiction, upon appeals of this nature.

Where the decree appealed from shows on its face that the sole question decided is one of jurisdiction, and where the record on appeal shows that the only question presented to this Court for determination is one of jurisdiction, these are held to be the equivalent of a certificate, and no certificate is needed.

Huntington vs. Laidley, 176, U. S. 668.
Re Lehigh Mining & Manufacturing Co., 156 U. S. 322.
Shields vs. Coleman, 157 U. S. 168.
Interior Construction & Improvement Co. vs. Gibney, 160 U. S. 217.
Van Wagenen vs. Sewall, 160 U. S. 369.
Chappell vs. U. S., 160, U. S. 499.
State of Ark. vs. Schlierholz, 179 U. S. 598.

In Huntington vs. Laidley, and also in State of Ark. vs. Schlierholz, above cited, the Court says: "In order to maintain the appellate jurisdiction of this Court, under this clause, the record must distinctly and unequivocally show that the Court below stands up for consideration a single and definite question of jurisdiction. *This may appear in either of two ways: by the terms of the decree ap-*

pealed from, and of the order allowing the appeal, or by a separate certificate of the Court below."

In the present appeal, the first of these ways is adopted. The decree (page 38) shows by its terms the determination of the sole question of jurisdiction. The order allowing this appeal (page 48) shows on its face that the sole question sent up for consideration is one of jurisdiction. The petition for said order (page 47) shows the same; the assignments of error (page 50) embody only this single question; and the motion of appellees in the Circuit Court of Appeals (page 44) and the opinion of the said Court (page 45) present further evidence of this sole question of jurisdiction, herewith presented for consideration.

It follows that in this appeal, no separate certificate is required, and the appeal is both timely and proper, and is unaffected either by the absence of such certificate, or by term signing.

The case of Holt vs. Indiana Manufacturing Co., above cited, appears to have taken the course of the case at bar, in that it was first appealed to the Circuit Court of Appeals, which Court dismissed it for want of jurisdiction to entertain the appeal, and it was, thereafter, taken to this Court. The time elapsing, one year and six months, between the last appeal and the entry of the decree appealed from, precludes any question of term time.

Colvin vs. City of Jacksonville, 158 U. S., 456, and The Bayonne, 159 U. S., 687, do not, as counsel for appellees state, hold that the equivalent of a formal certificate must also be done in term time. These cases hold nothing further than that the *certificates* used therein, were out of term time.

The case of Davis vs. Geissler, 162 U. S 290, resembles the case at bar no further than the use of the customary words in dismissing for want of jurisdiction. That case was *at law*, and it does not appear from the writ of error, nor from any proceeding in the case, that the question of jurisdiction was the sole question sent up by the lower court.

In the case at bar every step, the decree itself, the determination in the Circuit Court of Appeals, the peti-

tion for and order allowing the appeal, and the assignment of errors, shows plainly this sole question. This Court does not have to pick out from the record the question of jurisdiction from amongst others. There is no other question there.

We submit that there can be no greater conformity with what this Court has said to be the equivalent of a formal certificate, than this record presents.

The peculiar reasons for requiring the signing of a formal certificate during term time, do not apply to regular appeal proceedings within the two years limit. And if such regular appeal proceedings are proper, in a given case, without a formal certificate, being of themselves the equivalent of such certificate, there is no good reason why term time should affect them.

Respectfully submitted,

N. A. ACKER,
L. S. BACON,
W. W. WILSHIRE,

Solicitors for Appellant.

No. 375.

FILED
JAN 3 1902
JAMES H. MCKENNEY,
Clerk.

Brief of Acker, Bacon & Wilshire
No. 375
for Appellant.

IN THE SUPREME COURT OF THE UNITED STATES.

October Term, 1901.

Filed Jan. 3, 1902.

EXCELSIOR WOODEN PIPE COMPANY,
Appellant,

vs.

PACIFIC BRIDGE COMPANY
AND CHARLES P. ALLEN,
Appellees.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF WASHINGTON, NORTHERN DIVISION.

Notice of Submission of Cause, and Brief of Appellant upon said Submission.

N. A. ACKER,
L. S. BACON,
WM. F. BOOTH,
W. W. WILSHIRE,
A. H. KENAGA,
Solicitors for Appellant.

Filed , 1902.

Smith & Van Orden Print. 305 Clay St., S. F.

THE SUPREME COURT

OF THE

UNITED STATES.

October Term 1901.

EXCELSIOR WOODEN PIPE COMPANY,
Appellant,

vs.

PACIFIC BRIDGE COMPANY AND CHARLES P. ALLEN;
Appellees.

No. 375.

Notice of Submission of Case.

To JAMES B. HOWE,
W. H. BOGLE, and
A. R. TITLOW,
Solicitors for Appellees.

The above entitled case having been advanced under Rule 32 by order of Court of the 4th day of November, 1901, you will please take notice that on Monday, the 3rd day of February, 1902, at the opening of the Court, or as soon thereafter as counsel can be heard, appellant

above named will submit said case to the Supreme Court of the United States for its decision.

Annexed hereto is a copy of the brief or argument to be submitted with said case in support thereof.

N. A. ACKER.
L. S. BACON,
W. W. WILSHIRE,

Solicitors for Appellant.

Supreme Court of the United States,
October Term 1901.

EXCELSIOR WOODEN PIPE COMPANY,
Appellant.

vs.

PACIFIC BRIDGE COMPANY AND CHARLES P. ALLEN,
Appellees.

No. 375.

BRIEF OF APPELLANT.

On Submission of Case.

This is an appeal from a final decree, dismissing the suit for want of jurisdiction.

The suit was brought in the Circuit Court of the United States for the District of Washington, Northern Division.

History of the Case.

The record on appeal shows the following steps in the suit:

The Bill of Complaint was filed March 23rd, 1900.

Answer was filed June 9th, 1900.

Replication was filed on June 21st, 1900.

Time having expired September 21st, 1900, under Equity Rule 69, within which to take proofs, defendants filed motion to extend the time. The motion for extension was taken under advisement.

Complaint filed a motion for a decree on the pleadings and papers on file in the case.

On November 5, 1900, these motions being on the calendar, the Court, without hearing them, requested argument on the question of jurisdiction, heard such argument, and, thereupon, divested itself of jurisdiction, and the same day made a decree dismissing the bill for want of jurisdiction. (Page 38 of record.)

Thereafter on December 3, 1900, complainant perfected an appeal from said decree, to the United States Circuit Court of Appeals for the Ninth Circuit. (Record pages 38 to 41.)

Appellees, on January 28, 1901, filed in said Court of Appeals, a motion to dismiss said appeal "for lack of jurisdiction in this Court to hear and determine the question presented by the record herein for determination, for the reason that the order of the Circuit Court of the United States from which such appeal is prosecuted was and is an order dismissing said cause solely for want of jurisdiction in said circuit court to hear and determine the same, and in which order no other question was involved, nor determined by said circuit court: and this court is without authority to exercise appellate jurisdiction to review by appeal a final decision of the circuit court in which decision the jurisdiction of that court was the sole question in issue and decided."

On May 6th, 1901, the United States Circuit Court of Appeals for the Ninth Circuit, allowed said motion, and dismissed the appeal for want of jurisdiction to entertain it, upon the grounds set forth in the motion, to wit, that the sole question in the case was the jurisdiction of the court below. The opinion of the Circuit Court of Appeals, granting the motion to dismiss, will be found in the printed record page 45. It is also reported in 109, Federal Reporter 497.

The mandate of said Court of Appeals dismissing the appeal was thereafter duly issued, and on the 27th day of May, 1901, was filed and spread upon the minutes of the court below. (Record pages 42–43.)

On the same day, the 27th day of May, 1901, complainant, present appellant, perfected the present appeal to this Court, from the order and decree of the Circuit Court of the United States for the district of Washington, Northern Division, made and entered on the 5th day of November, 1900, dismissing said suit for want of jurisdiction. (Record pages 47–52.)

Statement of the Case.

This appeal is taken under Section 5 of the Act of March 3rd, 1891, defining and regulating in certain cases the jurisdiction of the Courts of the United States.

The appeal is perfected in accordance with Rules 35 and 36 of this Court.

From the Bill of Complaint, (pages 1 to 7 of the printed record) it will be seen that the suit is one for infringement of letters patent.

The bill is of the usual form, setting forth the patent, the title of complainant, namely, its exclusive license, under which it acquires its capacity to sue, the acts of infringement, and the usual prayers for damages, profits, accounting and injunctions.

The answer (pages 11 to 23 of printed record) is a joint answer of both defendants. It does not raise any issue as to the validity of the patent, nor as to the acts charged against said defendants as infringements. It admits that complainant acquired its title, to wit, its exclusive license, in the manner set forth, and sets out, in full, the license itself. But it denies that this license is a subsisting one, and alleges that it has been forfeited, has been revoked and is no longer in force. It also sets up that after the alleged revocation of said license, defendant Allen granted a license to defendant Pacific

Bridge Co. (Page 23.) In short the answer admits the patent, and the infringement, but denies the title of complainant.

The replication (page 24) is the usual general replication. Upon these pleadings, the Court held that it had no jurisdiction of the case, and dismissed the suit upon that ground.

From the foregoing, it will appear that the sole question herein involved is the jurisdiction of the Court below, over the suit.

Specification of Errors.

The errors assigned (page 50 of printed record,) are:

First, the error of the Court in holding that upon examination of the pleadings, the suit did not really and substantially involve a dispute or controversy properly within the jurisdiction of the Court, and that said Court should not further exercise jurisdiction.

Second, the error of the Court in dismissing the suit for want of jurisdiction.

Argument.

JURISDICTION OF COURT TO ENTERTAIN APPEAL.

The present appeal is timely. It may be taken at any time within two years from the making and entering of the final decree appealed from.

Holt vs. Indiana Manufacturing Co., 176 U. S. 68.

If, however, the appeal from the question of jurisdiction is taken up by way of the certificate mentioned in the first clause of Sec. 5 of the Act of 1891, said certificate

must be signed within the term at which the decree appealed from was made. Otherwise the appeal is out of time.

Maynard vs. Hecht, 151 U. S. 324.
Colvin vs. Jacksonville, 158 U. S. 456.
The Bayonne, 162 U. S. 329.
Merrit vs. Bowdoin College, 169 U. S. 551.

When, therefore, a certificate is used, or when one is needed to present the sole question of jurisdiction to this Court, the term of the lower Court affects and limits the time within which the appeal may be taken. Otherwise, the two year limit is unaffected.

It is not every case which needs a certificate, to present the sole question of jurisdiction, upon appeals of this nature.

Where the decree appealed from shows on its face, that the sole question decided is one of jurisdiction, and where the record on appeal shows that the only question presented to this Court for determination is one of jurisdiction, these are held to be the equivalent of a certificate, and no certificate is needed.

Huntington vs. Laidley, 176 U. S. 668.
Ex Lehigh Mining and Manufacturing Co., 156 U. S. 322.
Shields vs. Coleman, 157 U. S. 168.
Interior Construction & Improvement Co. vs. Gibney, 160 U. S. 217.
Van Wagenen vs. Sewall, 160 U. S. 369.
Chappell vs. U. S., 160 U. S. 499.
State of Ark. vs. Schlierholz, 179 U. S. 598.

In Huntington vs. Laidley and also in State of Arkansas vs. Schlierholz, above cited, the Court says: "In order to maintain the appellate jurisdiction of this Court, under this clause, the record must distinctly and unequivocally show that the Court below sends up for consideration a single and definite question of jurisdiction. *This may appear in either of two ways: by the terms of the decree*

appealed from, and of the order allowing the appeal, or by a separate certificate of the Court below."

In the present appeal, the first of these ways is adopted. The decree (page 38) shows by its terms the determination of the sole question of jurisdiction. The order allowing this appeal (page 48) shows on its face that the sole question sent up for consideration is one of jurisdiction. The petition for said order (page 47) shows the same; the assignments of error (page 50) embody only this single question; and the motion of appellees in the Circuit Court of Appeals (page 44) and the opinion of the said Court (page 45) present further evidence of this sole question of jurisdiction, herewith presented for consideration.

It follows that in this appeal, no separate certificate is required, and the appeal is both timely and proper, and is unaffected either by the absence of such certificate, or by term signing.

Argument.

MERITS.

The merits of this appeal involve the sole question of the jurisdiction of the Circuit Court over the suit.

The question of jurisdiction was raised by the Court itself, in the following manner.

Defendants, not having taken any proofs within the three months provided for in Equity Rule 69, applied to the Court, by motion, (page 28 of the record) for further time. In support of this motion, defendants filed the affidavit of C. F. Swigert, (page 25 of the record.) In this affidavit, Mr. Swigert, who is the official treasurer of the Pacific Bridge Co., took occasion (page 27) to express his doubts of the jurisdiction of the Court over the suit, as in his opinion, it was one arising on contract, and not one arising under the patent laws of the United States. In the resisting affidavit of D. C. Henny (page 29 of record),

affiant expresses himself as entertaining no doubt upon this subject.

When the motion for an extension of time came up before the Court, and the affidavits upon said motion were read, the Court was impressed with the situation, as it bore upon jurisdiction, and requested argument on this matter.

The motion for extension of time was taken under advisement (page 33) and the matter set over for one week with the understanding that the question of jurisdiction would then be argued. During said week the motion of complainant for a decree upon the pleadings was made, (page 34 of record) and set for the same time, (page 34 of record). Accordingly, on November 5th both motions being on the calendar, the Court, without hearing said motions, requested argument upon jurisdiction to be, at once, proceeded with. This was done, and at its conclusion, the Court, in a brief oral opinion, held that from a consideration of the Bill and Answer, the suit was not one arising under the patent laws, but was one arising solely out of contract; and, over such a suit, in the absence of diverse citizenship, the Court had no jurisdiction. The decree (page 38 of record) was made and entered the same day.

The real question, then, is:

Is this a case arising under the patent laws, or is it not?

The bill of Complaint, on its face, shows that the suit is a patent suit. It contains the ordinary allegations of a bill for infringement of a patent, to wit, the patent, the title and the infringement. It contains nothing else; it asks for no other relief than that usual in an infringement suit. It sets up no contract with defendants, *which it asks to have enforced or rescinded.* It suggests no forfeiture; it does not ask for a construction of any contract; it suggests nothing by way of contract, nor the existence of any, other than the plain statement of its title, giving complainant the capacity to sue; but it does not ask for a construction of this title, nor for its enforcement as a contract. It assumes its validity, and simply asks for the usual relief from infringement.

The Bill, thus, sets forth a case arising under the patent laws, and, as such, is within the jurisdiction of the Federal Court.

Rev. Stat. 629 sub. 9.
" " 711 " 5.

It differs from the usual Bill, however, in that it is brought in the name of the licensee alone, against infringers, the Pacific Bridge Co., and the licensor Allen, and in paragraph 22, it alleges the reason for this to be that the licensor Allen is himself an infringer, and is therefore made a defendant. This however, does not change the character of the suit as being one arising under the patent laws.

The authority of the licensee to sue his licensor as an infringer, and to join him with other defendants, is well settled.

Littlefield vs. Perry, 21 Wall. 205.
Waterman vs. Mackenzie, 138 U. S. 252.
Waterman vs. Shipman, 55 Fed. 982.

The Bill of Complaint, therefore, does not show a want of jurisdiction over the case.

In suits for infringements of patents, it is the Bill which creates or mars the jurisdictional situation.

"The subject matter of the action, *as set forth in the bill*, gave the Court jurisdiction, and exclusive jurisdiction, to try it."

White vs. Rankin, 144 U. S. 628.

In that line of cases in which this Court has refused to maintain jurisdiction, on the ground that they arise out of contract alone, and not under the patent laws, it will be found that in each instance, there was something *in the Bill itself* which showed that the object was other than, or in addition to, the usual relief in an infringement case.

In Wilson vs. Sanford, 10 Howard, 99, the licensor, in addition to treating his licensee as an infringer, claimed that the license was forfeited by breach of condition, and asked that it be declared forfeited, and for a reinvestiture of the title.

In Hartell vs. Tilghmam, 99 U. S. 547, the same course was pursued by the plaintiff.

In Albright vs. Teas, 106 U. S. 613, the suit was, on its face, one to recover amounts due under a contract.

Also in Manufacturing Co. vs. Hyatt, 125 U. S. 46, the suit was directly on a royalty contract.

In Felix vs. Scharnweber, 125 U. S. 54, the action was upon an agreement to pay royalties.

Marsh vs. Nichols, 140 U. S. 344, was an action for the specific performance of a contract to transfer a patent.

Wade vs. Lawler, 165 U. S. 624, was a suit to rescind a contract for the exchange of goods for an invention.

Pratt vs. Paris Gaslight & Coke Co., 168 U. S 255, was an action to recover the price of a patented machine sold.

Holt vs. Indiana Manufacturing Co., 176 U. S. 68, was a bill to enjoin the levying of a tax on a patent.

The lack of jurisdiction in all these cases was apparent from the bill itself. Where the bill is a plain suit for infringement of a patent and neither suggests nor asks for other or additional relief than is usual in such cases, the Court has jurisdiction.

White vs. Rankin (supra).

We contend that our bill is such as to give jurisdiction to the Federal Court. It asks for nothing more than the usual relief. It sets up nothing more than the necessary facts to obtain such relief. Complainant being a licensee, alleges no more than is required to show its title and capacity to sue. It is satisfied with that title. It does not ask for its enforcement. It does not allege that defendants deny that title, or that said defendants claim that it is forfeited, or revoked, or that its conditions have been violated, and then ask that it be declared to be a subsist-

ing license and not forfeited or revoked, and that it be enforced. Our bill includes nothing of this character.

We have a right in the letters patent, namely, that of an exclusive lecensee. That right is infringed, in the ordinary way, by the manufacture and sale of the patented article, which we, alone, have the right to manufacture and sell. This infringement is an invasion of our monopoly under the patent. It is as much an invasion of our right under the patent, as if the patent, had originally been granted to us, without intervention of assignment or license, *and from our situation a case arises under the patent laws*, as truly as if the situation involved the direct grant of the patent.

Does the answer, in the present case, change the situation, in this respect.

The answer, reduced to its lowest terms, is this:

There is such a patent, and it is valid.

Complainant had, at one time, an exclusive license under the patent.

Defendants are making and selling the patented device.

But, complainant's license was not subsisting at the time that this suit was brought, having been forfeited, and revoked, prior thereto, on account of the breach of conditions of the license.

Further, defendant, Pacific Bridge Company, has a license under the patent to manufacture and sell, from defendant Allen, which said license was granted subsequently to the alleged forfeiture and revocation of the prior license to complainant.

The situation created by such an answer is this:

Of the three essentials of a patent suit, namely, the validity of the patent, the title and the infringement, two; the validity of the patent, and the infringement are admitted, while the third, the title, is denied.

There are three essentials to the statement of a patent suit—first the patent; second, the title, and third, the infringement.

Robinson on Patents, sec. 857.

Admittedly, if the patent, that is, its validity, be called in question, there is a Federal question involved.

It is equally true that if the infringement be denied, the suit is still one arising under the patent laws. Yet this may not be so plain, for such denial may not call into question or require the construction of any act of Congress. Nevertheless, it does not change the character of the suit, even though it be the sole question in the cause, nor can it oust the Court of jurisdiction.

Osborn vs. U. S. Bank.
9 Wheaton, 738. (See page 826.)

The remaining consideration is, will the denial of title change the nature of the suit?

If such were true, it would rest with the defendant to oust the Federal Courts of jurisdiction in any case for the infringement of a patent, wherein the suit was brought by an assignee under the patent, or by a licensee; for the defendant could, by his answer, (true or otherwise) admit the validity of the patent and the infringement, and deny the title of the plaintiff, and by pointing out that title to have grown out of contract, either assignment or license, contend that the only question in the case is one of contract, and of such the Federal Court has no jurisdiction.

To such length has this suggestion been actually carried, that in White vs. Rankin, 144 U. S., 628, it was contended that the averment in the bill that the defendants have made, used and sold machines, containing the patented inventions without the *license* of the plaintiff, of itself raised a question of license or contract, sufficient to defeat Federal jurisdiction. The Court, however, said that such averment could not be regarded as raising such a question.

Also in Atherton Machine Co. vs. Atwood Morrison Co., 102 Fed. 949, the defendant demurred to the jurisdiction, on the ground that the suit was one growing out of contract, as appeared from the bill which set up certain assignments, the contention being that an assignment was a contract. The Circuit Court held this point good, sus-

tained the demurrer and dismissed the bill for want of jurisdiction. But the Court of Appeals reversed the lower court, holding that the case was one arising under the patent laws, and within the jurisdiction of the Federal Court.

A denial of title, the answer admitting both the validity of the patent and the infringement, will not divest the Court of jurisdiction.

Littlefield vs. Perry, 21 Wallace 205, and
Atherton Machine Co. vs. Atwood Morrison Co, 102 Fed. 949.
Waterman vs. Shipman, 55 Fed. 982.

In Littlefield vs. Perry, the Court says: "Such a suit may involve the construction of a contract, as well as the patent, but that will not oust the Court of its jurisdiction. If the patent is involved it carries with it the whole case."

In the Atherton case the Court on page 956 says: "An averment of title in the complainant must necessarily be made, and is the necessary foundation for all the rights asserted or litigated by the complainant. *It is an averment* without which complainant has no proper standing in Court." The Court also says the title is the "creature of the patent law and not of the common law and *whether admitted or attacked* by the opposing party, the questions are raised under the patent laws, and are, therefore, within the meaning of Revised Statutes of the United States, justiceable in the Circuit Courts."

In Waterman vs. Shipman, the Court held that the licensee had a right to join the licensor with other parties defendant, and that such a suit arose under the patent laws of the United States. In that case there was only a denial of title.

It, therefore, appears that it is not necessary, in order to involve a patent, that the answer should deny its validity or deny infringement. The title to the patent is as essential to an infringement suit as anything else, and it must be set up; and when the title is involved, the

patent is involved in the sense of the enjoyment of the monopoly under it, and this confers federal jurisdiction.

Nor is there any distinction to be drawn in this regard between title vesting by assignment, and title founded on license, on the ground that one is provided for by Federal Statute and the other not. In Littlefield vs. Perry (see pages 222 and 223) the court holds that whether complainant's were technically assignees or licensees the action was maintainable.

In the case at bar, we have merely set up our title. It must be remembered that this is not a suit by our licensor, Allen, against us, his licensee. He is not treating us as an infringer. He is not bringing a suit to annul the license he has given us. He does not allege any rescission of our license by a Court of Equity. Nor have we brought this suit against our licensor to enforce our license. It is in force; it has never been rescinded; we are satisfied with it. We plead it as our title to sue.

The conclusion must be, that the answer of defendants, does not change the jurisdictional situation.

The answer of the Pacific Bridge Co., that it has a license subsequent to complainant's license will not oust the Court of jurisdiction.

White vs. Rankin (supra).

In fact, it is difficult to see that the Answer, in regard to the forfeiture and revocation of complainant's admittedly once-existing exclusive license, is material, or that it can be considered at all, in the absence of any allegation of mutual agreement to terminate said license, or of its rescission by a competent court of equity.

Hartell vs. Tilghman, 99 U. S. 547 (556).
Standard Dental Manufacturing Co. vs. National Tooth Co., 95 Fed. 291 (294).
Hanifen vs. Lupton 95 Fed. 465.

Concluding, we beg to present another brief view.

We must have our licensor, Allen, in the case, on one side or the other.

Waterman vs. Mackenzie, 138 U. S. 252.

As he is charged with being an infringer we may make him a defendant, and we have the direct authority of Littlefield vs. Perry, 21 Wallace 205, that we may sue him as an infringer in an action for infringement, *and that the Federal Court will retain jurisdiction* of such a suit, notwithstanding that *no question of the infringing acts, nor of the validity of the patent is raised, but only a question of title.*

Now, we can join with him other defendants who are joint infringers with him? Yes.

Waterman vs. Shipman, 55 Fed. 982.

In this case the Circuit Court of Appeals, for the second circuit, held that a licensee who has the exclusive right to manufacture and sell a patented article can maintain a suit in equity against the patentee, if the latter is guilty of an infringement by making and selling himself, to redress the wrong occasioned thereby, *and that he may join other parties defendant with the* owner, who have combined with him to commit the infringement: and, finally, *that such a suit arises under the patent laws* of the United States.

We submit therefore, that our assignments of error are well taken, for that the Court was wrong in concluding that the case at bar was one arisng on contract and not under the patent laws, and that it, consequently, erred in divesting itself of jurisdiction, and in dismissing the suit.

Respectfully submitted,

N. A. ACKER,
L. S. BACON,
WM. F. BOOTH,
W. W. WILSHIRE,
A. H. KENAGA,

Solicitors for Appellant.

Filed Oct. 22, 1901.

IN THE SUPREME COURT OF THE UNITED STATES.

October Term, 1901.

EXCELSIOR WOODEN PIPE COMPANY,
Appellant,

vs.

PACIFIC BRIDGE COMPANY
AND CHARLES E. ALLEN,
Appellee.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES, FOR THE DISTRICT OF WASHINGTON, NORTHERN DIVISION.

Brief for Appellees on Motion of Appellant to Advance Case.

JAMES B. HOWE,
W. H. BOGLE AND
A. R. TITLOW,
Solicitors for Appellees.

Filed ..... 1901.

IN THE

SUPREME COURT

OF THE

UNITED STATES.

OCTOBER TERM, 1901.

EXCELSIOR WOODEN PIPE COMPANY, *Appellant.* vs. PACIFIC BRIDGE COMPANY AND CHARLES P. ALLEN, *Appellees.*	No. 375.

Brief for Appellees on Motion of Appellant to Advance Case.

The appellees have filed and served a motion to dismiss the appeal in this cause for want of jurisdiction in this court to hear and determine the same; and they now interpose that motion and the grounds upon which it rests as reasons for not advancing the case on the docket.

The decree appealed from in this case was rendered on November 5th, 1900, (Record, page 38); the first step taken by appellant toward the present appeal was taken

on May 27th, 1901, by filing a petition for an appeal and an assignment of errors in said Circuit Court.

Under the Act of Congress, approved April 5th, 1890, two terms of the Circuit Court for the Northern Division of the District of Washington are held annually at Seattle, one term beginning on the first Tuesday in June, and the other on the first Tuesday in December. The June term, at which the decree appealed from was rendered, necessarily expired by operation of law before the December term began.

The appeal in this case is on the question of jurisdiction alone, no contention being made that the action involved "the construction or application of the Constitution of the United States."

The act of March 3rd, 1891, as heretofore construed by this court, in effect provides that there can be no appeal to this court on the question of jurisdiction, unless the trial court, during the term at which the judgment, decree or order is given, certifies that the question of jurisdiction alone is involved.

Colvin vs. City of Jacksonville, 158 U. S., 456.
The Bayonne, 159 U. S., 687.
Merritt vs. Bowdoin College, 167 U. S., 745.
S. C., 169 U. S., 551.
Chappell vs. U. S., 160 U. S., 499.
Davis vs. Geissler, 162 U. S., 290.
Huntington vs. Laidley, 176 U. S., 668.

This court has repeatedly held, notably in *Colvin vs. City of Jacksonville*, 157 U. S., 368, *Davis vs. Geissler*, 162 U. S., 290, and *Merritt vs. Bowdoin College*, 167 U. S., 745, that, in order to maintain the appellate jurisdiction of this court under the 5th section of the act of March 3rd, 1891, there must be, in addition to the terms of the order appealed from, some

further act of the trial court, either in the form of a formal certificate, or of an order authorizing or allowing the appeal and which is equivalent to a formal certificate, whereby the question of jurisdiction alone is distinctly sent by the trial court to this court for decision. The fact that this court can ascertain, from the terms of the order or decree appealed from, that the question of jurisdiction alone was involved, is not sufficient to give appellate jurisdiction under the clause in question.

This court has also held that this certificate of the trial court, whether in the form of a certificate or of an order approving and allowing an appeal, must be granted by the trial court during the term at which the order appealed from was rendered.

Colvin vs. City of Jacksonville, 158 U. S., 456.
The Bayonne, 159 U. S., 687.

When the June term, 1900, of the Circuit Court of the Northern Division of the District of Washington expired on December 3rd, 1900, that court had no longer any power or authority to grant any certificate or to make any order granting or allowing any appeal to this court upon the question of its jurisdiction alone. This case, therefore, is controlled by *Davis vs. Geissler*, 162 U. S., 290, in which case the terms of the judgment dismissing the case were the same as are contained in the order of dismissal in the present case. The effect of this clause of the act of March 3rd, 1891, as heretofore construed by this court is to limit the right of direct appeal to this court on the question of jurisdiction, to the duration of the term at which the order appealed from was rendered; no appeal can be entertained without a certificate from the trial court presenting the jurisdictional question to this court, and no such certificate can be granted by the trial court after the expiration of the term at which the

order appealed from was rendered. This has been the construction given by the Circuit Court of Appeals to the decisions of this court above referred to.

Reed vs. Stanley, 97 Fed. 523.

The appeal should be dismissed.

JAMES B. HOWE,
W. H. BOGLE AND
A. R. TITLOW,
Solicitors for Appellees.

No. 978.

Filed Oct. 22, 1901.

IN THE SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1901.

EXCELSIOR WOODEN PIPE COMPANY,
Appellant,

vs.

PACIFIC BRIDGE COMPANY
AND CHARLES F. ALLEN,
Appellees.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES, FOR THE DISTRICT OF WASHINGTON, NORTHERN DIVISION.

Motion to Dismiss the Appeal; Notice of Said Motion; Brief of Appellees upon Said Motion.

JAMES B. HOWE,
W. H. BOGLE AND
A. R. TITLOW,
Solicitors for Appellees.

Filed , 1901.

IN THE

SUPREME COURT

OF THE

UNITED STATES.

OCTOBER TERM, 1901.

EXCELSIOR WOODEN PIPE COMPANY, *Appellant,* vs. PACIFIC BRIDGE COMPANY AND CHARLES P. ALLEN, *Appellees.*	No. 375.

MOTION TO DISMISS APPEAL.

Come now the appellees, Pacific Bridge Company and Charles P. Allen, by their solicitors, James B. Howe, W. H. Bogle and A. R. Titlow, and move the Court to dismiss the appeal herein for want of jurisdiction to hear and determine the same, because—

FIRST. The final decree of the Circuit Court from which said appeal was taken was made and entered on the 5th day of November, 1900; the then term of said Circuit Court expired on the first Monday in December, 1900—(Act of Congress, approved April 5th, 1890,)—and no

appeal was taken or asked for by said appellant, nor was any certificate of the trial court certifying the question of jurisdiction to this court asked for by appellant or given by said trial court during said term of court—the appeal herein having been asked for and the assignments of error filed on the 27th day of May, 1901.

SECOND. The question of the jurisdiction of the Circuit Court has not been certified by said Circuit Court to this court for decision, as required by the Act of March 3rd, 1891, to confer jurisdiction of the appeal on this court.

JAMES B. HOWE,
W. H. BOGLE and
A. R. TITLOW,
Solicitors for Appellees.

In the Supreme Court of the United States.

October Term, 1901.

EXCELSIOR WOODEN PIPE COMPANY, *Appellant,*

vs.

PACIFIC BRIDGE COMPANY AND CHARLES P. ALLEN, *Appellees.*

No. 375.

NOTICE.

To N. A. ACKER, ESQ., and
L. S. BACON, ESQ.,
Solicitors and counsel for Appellant:

You will please take notice that on Monday, the 25th day of November, 1901, at the opening of the court, or as soon thereafter as counsel can be heard, appellees above named will make and present to the Supreme Court of the United States the foregoing motion to dismiss the appeal in this cause, and will submit said motion to said court for its decision.

Annexed hereto is a copy of the brief to be submitted with said motion in support thereof.

JAMES B. HOWE,
W. H. BOGLE and
A. R. TITLOW,
Solicitors for Appellees.

In the Supreme Court of the United States.

October Term, 1901.

EXCELSIOR WOODEN PIPE COMPANY, *Appellant,*

vs.

PACIFIC BRIDGE COMPANY AND CHARLES P. ALLEN, *Appellees.*

No. 375.

Brief for Appellees on Motion to Dismiss Appeal.

The decree appealed from in this case was rendered on November 5th, 1900, (Record, page 38); the first step taken by appellant toward the present appeal was taken on May 27th, 1901, by filing a petition for an appeal and an assignment of errors in said Circuit Court.

Under the Act of Congress, approved April 5th, 1890, two terms of the Circuit Court for the Northern Division of the District of Washington are held annually at Seattle, one term beginning on the first Tuesday in June, and the other on the first Tuesday in December. The June term, at which the decree appealed from was rendered, necessarily expired by operation of law before the December term began.

The appeal in this case is on the question of jurisdiction alone, no contention being made that the action involved "the construction or application of the Constitution of the United States."

The act of March 3rd, 1891, as heretofore construed by this court, in effect provides that there can be no appeal to this court on the question of jurisdiction, unless

the trial court, during the term at which the judgment, decree or order is given, certifies that the question of jurisdiction alone is involved.

Colvin vs. City of Jacksonville, 158 U. S., 456.
The Bayonne, 159 U. S., 687.
Merritt vs. Bowdoin College, 167 U. S., 745.
S. C., 169 U. S., 551.
Chappell vs. U. S., 160 U. S., 499.
Davis vs. Geissler, 162 U. S., 290.
Huntington vs. Laidley, 176 U. S., 668.

This court has repeatedly held, notably in *Colvin vs. City of Jacksonville*, 157 U. S., 368, *Davis vs. Geissler*, 162 U. S., 290, and *Merritt vs. Bowdoin College*, 167 U. S., 745, that, in order to maintain the appellate jurisdiction of this court under the 5th section of the act of March 3rd, 1891, there must be, in addition to the terms of the order appealed from, some further act of the trial court, either in the form of a formal certificate, or of an order authorizing or allowing the appeal and which is equivalent to a formal certificate, whereby the question of jurisdiction alone is distinctly sent by the trial court to this court for decision. The fact that this court can ascertain, from the terms of the order or decree appealed from, that the question of jurisdiction alone was involved, is not sufficient to give appellate jurisdiction under the clause in question.

This court has also held that this certificate of the trial court, whether in the form of a certificate or of an order approving and allowing an appeal, must be granted by the trial court during the term at which the order appealed from was rendered.

Colvin vs. City of Jacksonville, 158 U. S., 456.
The Bayonne, 159 U. S., 687.

When the June term, 1900, of the Circuit Court of the

Northern Division of the District of Washington expired on December 3rd, 1900, that court had no longer any power or authority to grant any certificate or to make any order granting or allowing any appeal to this court upon the question of its jurisdiction alone. This case, therefore, is controlled by *Davis vs. Geissler*, 162 U. S., 290, in which case the terms of the judgment dismissing the case were the same as are contained in the order of dismissal in the present case. The effect of this clause of the act of March 3rd, 1891, as heretofore construed by this court is to limit the right of direct appeal to this court on the question of jurisdiction, to the duration of the term at which the order appealed from was rendered; no appeal can be entertained without a certificate from the trial court presenting the jurisdictional question to this court, and no such certificate can be granted by the trial court after the expiration of the term at which the order appealed from was rendered. This has been the construction given by the Circuit Court of Appeals to the decisions of this court above referred to.

Reed vs. Stanley, 97 Fed. 523.

The appeal should be dismissed.

JAMES B. HOWE,
W. H. BOGLE AND
A. R. TITLOW,
Solicitors for Appellees.

No. 375.

Brf. of Howe for Appellees

FILED
JAN 21 1902
[illegible] H. KENNEY,
[illegible]

THE SUPREME COURT

Filed Jan. 21. 1902.

OF THE UNITED STATES.

EXCELSIOR WOODEN PIPE COMPANY,
Appellant,
vs.
PACIFIC BRIDGE COMPANY AND CHARLES P. ALLEN,
Appellees.
} No. 375.

Appeal from the Circuit Court of the United States for the District of Washington, Northern Division.

JAMES B. HOWE,
A. R. TITLOW,
W. H. BOGLE,
Solicitors for Appellees.

THE SUPREME COURT

OF THE

UNITED STATES.

October Term, 1901.

EXCELSIOR WOODEN PIPE COMPANY,
Appellant,
vs.
PACIFIC BRIDGE COMPANY AND CHARLES P. ALLEN,
Appellees.
No. 375.

BRIEF FOR APPELLEES.

ON SUBMISSION OF CASE,

I.

APPELLATE JURISDICTION.

A motion has been heretofore filed in this cause by the appellees to dismiss for want of jurisdiction in this Court to hear and determine this appeal.

That motion is passed upon the following grounds:

First. The final decree of the Circuit Court from which said appeal was taken was made and entered on the 5th day of November, 1900; the then term of said

Circuit Court expired on the first Monday in December, 1900 (Act of Congress, approved April 5th, 1890), and no appeal was taken or asked for by said appellant, nor was any certificate of the trial court certifying the question of jurisdiction to this court asked for by appellant or given by said trial court during said term of court—the appeal herein having been asked for and the assignments of error filed on the 27th day of May, 1901.

Second. The question of the jurisdiction of the Circuit Court has not been certified by said Circuit Court to this Court for decision, as required by the Act of March 3rd, 1891, to confer jurisdiction of the appeal on this Court.

The order appealed from was rendered at the June term, 1900, of the Circuit Court, and was entered on November 5th, 1900.

Transcript, page 58.

The petition for an appeal to this Court was filed during the December term, 1900, on May 27th, 1901, and allowed on same day.

Transcript, pages 48–9.

Under the act of congress, approved April 5th, 1890, the Circuit Court of the United States for the northern division of the district of Washington, holds two terms annually, the June term beginning on the first Tuesday in June, and the December term beginning on the first Tuesday in December.

1. The authority of this court to review the action of the court below in this case must be found, if at all, in the first clause of sec. 5 of the judiciary act of 1891, authorizing appeals direct to this court "in any case in which the jurisdiction of the court is in issue; in such cases the question of jurisdiction alone shall be certified to the Supreme Court from the court below."

This Court has held so often that the absence of a certificate certifying the jurisdictional question is fatal to its appellate jurisdiction that it seems that question should now be considered finally settled.

Maynard vs. Hecht, 151 U. S., 324.
Moran vs. Hagerman, 151 U. S., 329.
Colvin vs. City of Jacksonville, 157 U. S., 368.
Davis vs. Geissler, 162 U. S., 290.
Merritt vs. Bowdoin College, 169 U. S., 551; S. C., 167 U. S., 745.
The Bayonne, 159 U. S., 687.

It is contended by appellant, however, that this rule is qualified by the decisions of this Court *in re* Lehigh Mining, etc., Co., 156 U. S., 322; Shields vs. Coleman, 157 U. S., 168; Huntington vs. Laidley, 176 U. S., 668, and State of Ark. vs. Schlierholz, 179 U. S., 598, and that, under the authority of these cases, no certificate is necessary "where the decree appealed from shows on its face that the sole question decided is one of jurisdiction, and where the record on appeal shows that the question presented to this Court for determination is one of jurisdiction."

Appellant's brief, page 7.

In Davis vs. Geissler, *supra*, the Court below entered an order that "It appearing to the court that this court has not jurisdiction of the subject matter of this action, it is ordered that this case be and the same is hereby dismissed at the costs of plaintiffs." To review that judgment a writ of error was sued out, but this court dismissed the case for want of appellate jurisdiction because the court below had not certified the question of jurisdiction to it, although it clearly and distinctly appeared in the order appealed from that a question of jurisdiction alone was decided by the lower court. In the case at bar, the order recites: "It appearing to the satisfaction of the court, upon an examination of the pleadings herein, that said suit does not really and substantially involve a dispute or controversy properly within the jurisdiction of this court, and that this court should not further exercise jurisdiction, it is therefore ordered and decreed that said suit be, and the same is hereby, dismissed for want of jurisdiction," etc. This order does not disclose what was the jurisdictional question upon which the lower court acted. The petition for an appeal—Transcript, page 48—petitions "for an order allowing it, Excelsior Wooden Pipe Company, to prosecute an appeal from said final order and decree dismissing said suit for want of jurisdiction, to the honorable Supreme Court," etc. It will be observed that this petition asks for an appeal from the final decree; it does not specifically ask to be permitted to appeal upon any question of jurisdiction, unless the fact that the order appealed from

recites that it is based upon a question of jurisdiction necessarily restricts the appeal to that question; nor does the petition attempt to specify what question of jurisdiction this court will be asked to review. The order allowing the appeal—Transcript, pages 48–9—sets forth the final decree in full, and allows an appeal therefrom, and directs the transmission of the entire record to this court.

Neither the order appealed from, the petition for an appeal, the order allowing the appeal, nor the assignment of errors, discloses what question of jurisdiction this court is asked to review. In Shields vs. Coleman, 157 U. S., 168, the essential requisite of the appellate jurisdiction of this court in this class of cases was defined as follows: "It is not necessary that the word 'certify' be formally used. It is sufficient if there is a plain declaration that the single matter which is by the record sent up to this court for decision is a question of jurisdiction, *and the precise question clearly, fully and separately stated.*" Tested by this rule, the appeal in the present case must fail.

In Huntington vs. Laidley, 176 U. S., 668, the order appealed from set out the facts out of which the jurisdictional question arose, and fully and clearly disclosed the precise question passed upon by the lower court; and the court below also separately certified that particular question to this court.

In re Lehigh Min. & M. Co., 156 U. S., 332, the question of jurisdiction was raised by pleas; and the circuit court, in its order sustaining the pleas and

dismissing the action, recited that it was "for reasons in writing filed herewith, as part of this order," thus disclosing the precise question decided; and the certificate in effect sent up the question of jurisdiction alone.

In Interior C. & I. Co. vs. Gibney, 160 U. S., 217, cited by appellant, the ruling was upon a plea presenting a single, definite question of jurisdiction upon the facts set up in the plea; and the petition upon which the writ of error was allowed asked only for a review of that ruling. In Van Wagenen vs. Sewall, 160 U. S., 369, cited by appellant, the appeal was dismissed because the order appealed from and the proceedings in taking the appeal did not clearly disclose the alleged jurisdictional question. So, in Chappell vs. U. S., 160 U. S., 499, the court refused to take jurisdiction for lack of a proper certificate indicating the jurisdictional question; and a similar course was followed in State of Arkansas vs. Schlierholz, 179 U. S. 600, also cited by appellant.

This court has held, in Colvin vs. City of Jacksonville, 157 U. S., 368, Davis vs. Geissler, 162 U. S., 290, and Merritt vs. Bowdoin College, 167 U. S., 745, and 169 U. S., 551, that this court does not acquire jurisdiction of an appeal from an order of the circuit court dismissing a case for want of jurisdiction. It is essential that, in addition to the terms of the order appealed from, there be either a separate certificate certifying the particular jurisdictional question to this court, or some order of the trial court in granting the appeal which indicates the jurisdictional question

with sufficient certainty, clearness and fullness to be equivalent to a formal certificate; and this certificate, or the order allowing the appeal, must distinctly send up the jurisdictional question alone for review in this court.

In Maynard vs. Hecht, *supra*, this court held that the certificate required by the 5th section of the judiciary act of 1901, was analogous in this respect to the certificate of division of opinion in civil causes under sections 650, 652 and 693 of the Revised Statutes. Under these sections, this court has frequently held that the certificate must define the precise question of law which is certified, and that this court will not search through the pleadings to ascertain the question presented to it. Thus, in United States vs. Northway, 120 U. S. 327, it was held that a certificate certifying the question, whether either of the counts in an indictment charged the defendant with an offense under the laws of the United States, was too vague and general to invoke the jurisdiction of this court. In the present case, in its most favorable aspect for appellant, the question presented to this court, namely, whether under all the allegations of the complaint and of the answer and of the replication, said suit really and substantially involved a controversy properly within the jurisdiction of the circuit court, is more vague and general than the question whether a count in a particular indictment charged an offense under the laws of the United States.

2. If the petition for appeal and the order allowing the same, could otherwise be treated by this Court as equivalent to a certificate, they are unavailing for that purpose in the present case, because they were not entered until the term subsequent to that in which the decree was rendered. As heretofore stated, the decree was rendered November 5th, 1900, being the June term of the court; the order allowing the appeal was entered at the following December term, on May 27th, 1901. No steps looking to an appeal to this court were taken during the June term. On the contrary, an appeal was first taken to the Circuit Court of Appeals, and it was only after that court had dismissed the appeal that the petition for an appeal to this court was presented.

The appellant contends that an appeal may be taken to this court at any time within two years from the entering of the final decree, citing Holt vs. Ind. Mfg. Co., 176 U. S., 68. That is doubtless true where the appeal, as in the case cited, is on other than a jurisdictional question; but this court has frequently decided that the certificate of the lower court certifying the question of jurisdiction on appeal must be executed during the term at which the decree appealed from was entered.

Colvin vs. City of Jacksonville, 158 U. S., 456.
The Bayonne, 159 U. S., 687.

If, after the expiration of the June term, 1900, and the beginning of the December term, the lower court

was without authority to formally certify the question of jurisdiction to this court, its order entered May 27th, 1901, if otherwise equivalent to the requisite certificate, must be held to be unavailing for lack of authority in the court at that time to make such certificate.

For these reasons, we think the appeal should be dismissed.

II.

JURISDICTION OF CIRCUIT COURT.

If this court sustains its appellate jurisdiction, we contend that the decree of the court below was correct. The complainant and the defendant Bridge Company are both California corporations.

The bill of complaint was filed by an alleged licensee against the patentee and a third person, and alleged, in substance:

1. The issuance of letters-patent to defendant Allen.

Par. 1–6, bill.

2. That defendant Allen granted an exclusive license to complainant's assignor to make and sell the patented articles within certain limited territory, including the state of Washington, which license was, with Allen's consent, transferred to complainant before the acts complained of were committed:

Par. 7–9, bill.

3. That complainant, since said assignment, has been and still is the exclusive licensee of said Allen within said territory.

Par. 10 of bill.

4. That complainant has preserved its monopoly in said territory, prosecuted the business of making and selling the patented articles, and has continued to use the patent and to supply the trade with said articles, etc.

Par. 11 of bill.

5. That the validity of the patent has been established at law:

Par. 22–15 of bill.

6. That defendant Allen and the Bridge Company have jointly committed acts of infringement within the prescribed territory.

The joint answer of the defendants, in substance, admits:

1. The issuance and validity of the letters-patent, and ownership by defendant Allen.

2. The making of a contract between defendant Allen and complainant's assignor, giving to complainant's assignor an exclusive license to make and sell articles embodying the patented invention in the territory described, upon certain terms and conditions set out in the answer; and

3. The doing of the acts claimed to be infringe-

ments. And the answer thereupon denied

(a) The present subsistence of the license contract.

(b) Denied that complainant had preserved the monopoly thereby given to it; and

(c) Denied that it had continued to use the license or to prosecute the business secured by it; and pleaded abandonment of the contract of license by complainant, forfeiture of all rights thereunder by failure and refusal to comply with its terms and conditions, and by acts of gross bad faith toward the patentee by seeking to defeat the patent and to destroy its monopoly; and revocation of the license by Allen for cause in pursuance to the terms of the contract—all before the alleged acts of infringement.

A general replication was filed by complainant.

From this short analysis of the pleadings it will be seen that the bill of complaint tendered two classes of issues, viz:

First. Those relating to the issuance and validity of the letters-patent, and the acts charged as infringements.

Second. Those relating to the contract between Allen and the complainant, under which contract complainant claimed to have certain contract rights in the letters-patent, and to protection as such. The answer admits all of the allegations relating to the first class of issues tendered, and takes issue on those averments relating to the contract between the parties and its present existence.

There is no controversy between the parties as to the validity or existence of the letters-patent, nor as to whether the wooden-pipe used by the Bridge Company embodies the invention covered by the patent. The only controversy or issue developed by the pleadings grows out of the contract between complainant and Allen; and we insist that the court below properly held that such controversy was not "properly within the jurisdiction of the circuit court." The question in dispute between complainant and Allen depends entirely upon the construction of the contract between them and the effect upon the rights of the parties under the contract of the matters set up in the answer; and these questions depend altogether upon general principles of common law, and not upon the patent laws.

Wilson vs. Sanford, 10 How., 99.
Hartell vs. Tilghman, 99 U. S., 547.

The contention of appellant that it is the bill alone to which the court must look to determine the question of its jurisdiction of the controversy is not borne out by the previous decisions of this Court. In Hartell vs. Tilghman, *supra*, the bill alleged letters-patent owned by complainant, and infringement by defendant, and prayed for injunction, an accounting and damages only. In the syllabus to that case the principle decided is thus stated: "A suit between citizens of the same state cannot be sustained in the circuit court as arising under the patent laws of the

United States, where the defendant admits the validity and his use of the letters-patent, and a subsisting contract is shown governing the rights of the parties in the use of the invention. Relief in such suit is founded on the contract, and not on those laws." In the present case, the defendants admit the validity and their use of the letters-patent; and the complainant itself pleads a contract which it claims is subsisting, and that it governs the rights of the parties in the use of the invention. What Federal statute or principle of patent law is involved in the determination of the rights of the parties under this contract? Absolutely none. Appellant contends that the contract pleaded is its muniment of title; and that the complainant's title is necessarily involved in an action for infringement; and he cites Littlefield vs. Perry, 21 Wall., 205; Atherton Mach. Co. vs. Atwood M. Co., 102 Fed., 949; Waterman vs. Shipman, 55 Fed., 982.

In Littlefield vs. Perry, the answer raised questions involving the validity of the patent (page 217). The extent of the decision in that case is that a licensee has such rights as enable him to maintain an equitable action against his licensor; and if such action involves questions arising under the patent laws, the Federal court has jurisdiction. So, in Waterman vs. Shipman, one of the defenses was want of novelty in the invention. The issue on that question was of course triable in the circuit court, and gave it full jurisdiction of the case. The case of Ather-

ton Mach. Co. vs. Atwood M. Co., is distinguishable from the present one in two respects; first, in that case the complainant was an *assignee*, not merely a licensee under a contract, and the court specifically pointed out that as an assignment of letters-patent are provided for by the statutes relating to patents (sec. 4884 and 4898 Rev. Stat.), a controversy over the validity or construction of such an assignment is one arising under and involving the construction of those statutes. Contracts granting a mere license, however, although conferring upon the licensee certain equitable property rights which are enforceable in any appropriate equitable tribunal, are not provided for by the Federal statutes relating to patents, and, consequently, a controversy over their construction and validity does not involve any question of patent law. Second, in the Atherton case the assignor of the plaintiff was not a party to the action, and hence the court held that any question as to the validity or construction of the assignment was collateral, and did not give character to the case. In the case at bar, the licensor is one of the defendants, and the issue as to the present existence and proper construction of the license contract, and the effect thereon of the acts of the parties thereunder as pleaded in the case, is not a collateral, but is the main and only issue in the case. No support is found in that case for the contention that a license can invoke Federal jurisdiction in a controversy with his licensor over

the construction of his contract upon the ground that the contract relates to letters-patent.

In an ordinary suit by a patentee, or an assignee, alleging letters-patent, title, infringement by defendant, and damages or profits, every question presented involves the patent laws, because the title of a patentee or an assignee is derived under the patent laws; and in such case it may be true that the jurisdiction is not defeated by an answer setting up defenses under a contract. We apprehend that the Court would retain jurisdiction to determine whether such contract existed. Such we understand to be the ruling of this court in White vs. Rankin, 144 U. S., 628; and, as there stated, if the court finds that such a contract does exist, then it should dismiss the case as one not involving a dispute or controversy properly within its jurisdiction. But where, as in the case at bar, the complaint itself asserts rights under a contract not covered by the statutes relating to patents, a non-Federal question is presented by the bill itself; and if, when the pleadings are made up, it is disclosed that the only dispute between the parties arises out of the construction of this contract, the case is brought within the principle of Hartell vs. Tilghman, *supra*.

The Court of Appeals of New York, in a case brought by a licensee against an assignee of the patentee, seeking to enjoin the assignee from manufacturing and selling the improvements in violation of the rights granted to the licensee by the contract, and

for damages, maintained the jurisdiction of the state court upon the ground that the case did not arise under the patent laws.

Mayer vs. Hardy, 27 N. E. Rep., 837.

That case is quite similar to the one at bar, and is a complete answer to the suggestion that the complainant is without remedy except in the Federal courts. Inasmuch as its rights, if any it has, come through its contract with Allen, there is no hardship in remitting it to the tribunals having jurisdiction over controversies growing out of contracts. That a patent right is the subject matter of the contract gives no right to Federal relief.

If, instead of a license to make and sell articles under letters-patent, the complainant held a long term lease from defendant to real estate acquired by defendant from the United States under the land laws, and a dispute arose between them as to the construction or present validity of such lease, it would not be contended that the circuit court would have jurisdiction of that controversy, on the ground that complainant's lessor acquired title under Federal laws. Before jurisdiction could be entertained by the circuit court, it would be necessary to present a controversy involving those laws. So long as the nature and character of the estate which passed to the grantee of the United States was not involved in the dispute, the circuit court would properly refuse to entertain jurisdiction, and leave the parties to seek their remedy

in the state courts for any violation of the terms of the lease or deprivation by the lessor of the rights of the lessee thereunder. Nor could the complainant "create a case" cognizable by the circuit court by referring in his pleadings to the land laws as the source of his title, and alleging rights thereunder, if the answer disclosed that the only dispute was over the lease. And in Hartell vs. Tilghman, this court stated that the analogy between the land laws and the patent laws, as a source of jurisdiction in Federal courts was complete.

The rule deducible from the decisions of this court may be fairly stated as follows: Where the plaintiff in his pleadings discloses a contract with defendant, and defendant admits the validity and use of the patent, but takes issue on the terms and construction of the contract, the case is one on contract and does not arise under the patent laws, although the plaintiff seeks relief by injunction, accounting and damages; but where the plaintiff does not disclose any contract with defendant, and sets up letters-patent, title and infringement, and defendant pleads a contract as the justification of his acts, the court will retain jurisdiction so far as to determine whether such contract does in fact exist, but will not determine the rights of the parties under the contract, if one is found. To the first class belongs the case of Hartell vs. Tilghman, *supra;* to the second belongs White vs. Rankin, 144 U. S., 628.

In this last case, this court very clearly intimates that if a contract governing the rights of the parties is pleaded by defendant and denied by plaintiff, the

the court should proceed to determine the fact, and, if its existence is established as a fact, dismiss the case as one not properly within its jurisdiction.

McMullen vs. Bowers, 102 Fed., 494, a case decided by the Circuit Court of Appeals for the Ninth circuit, is in point. Bowers was the patentee of an improvement in dredgers, and he gave an exclusive license to "make and use" the improvement within certain territory to a corporation; that corporation built a dredger embodying the improvement and used it in the prescribed territory; subsequently the corporation became insolvent, and the dredger was sold and purchased by Concannon, who moved it out of the territory covered by the license and used it in another territory. The bill was by Bowers, the patentee, against Concannon and others, and alleged, in substance, 1, the patent and its validity; 2, the license and its limits territorially; and, 3, the use of the dredger by defendants outside of the licensed territory, which act was alleged to be an infringement. The answer admitted (1) the patent and its validity, and (2) the doing of the acts charged as infringements; and it took issue on the construction of the license and the effect thereon of the subsequent acts of the parties. The case was dismissed by the court on its own motion, for the reason that the only controversy in the case was over the contract of the parties.

In M. & H. Trading Co. vs. Glaenzer, 30 Fed., 387, the bill was by a licensee against an agent of the

owner of the patent. The bill alleged the license of complainant; that the owner of the patent unjustly claimed that the license had become forfeited; that defendant, as agent of the owner, was selling the patented articles in disregard of complainant's rights. The answer admitted the patent and the sale of the patented articles by defendant, and denied that complainant had any cause of action, and asserted that his rights under the license had terminated by reason of the non-performance of one of the conditions of the license before the alleged acts of infringement. The court held that the rights of the parties depended wholly upon common law and equity principles as applied to the contract stated in the bill, and dismissed the case. In that case the bill not only set up the contract of license under which complainant asserted his rights, but went further and alleged that the pretense of defendant that the license had been terminated was unjust and unfounded; while in the case at bar, the complainant contented himself with pleading the contract under which he claims, and averring that it has been preserved and maintained as a subsisting contract. In other respects, the pleadings in the two cases are substantially identical.

Under the 5th section of the judiciary act of 1875, making it the duty of the circuit court to dismiss a suit whenever at *any time after the suit is brought* it becomes satisfied that it does not really and substantially involve a dispute or controversy properly within its jurisdiction, the trial court must necessarily look

to the entire pleadings to ascertain what is the matter in dispute or controversy. This statute evidently intends that the trial court is to determine its jurisdiction from a consideration of the nature and character of the dispute or controversy disclosed during the progress of the case by the entire pleadings.

Robinson vs. Anderson, 121 U. S., 522.

Respectfully submitted,

JAMES B. HOWE,
A. R. TITLOW,
W. H. BOGLE,
Solicitors for Appellees.

Supreme Court of the United States.

No. 375.—October Term, 1901.

The Excelsior Wooden Pipe Company, Appellant, *vs.* The Pacific Bridge Company et al.	On appeal from the Circuit Court of the United States for the District of Washington.

[May 5, 1902.]

This was a bill in equity filed by the Excelsior Wooden Pipe Company, a California corporation, against the Pacific Bridge Company, also a California corporation, but having a branch in the city of Seattle, Washington, and Charles P. Allen, for the infringement of a patent issued to Allen, one of the defendants, for a wooden pipe.

Beside the usual allegations of a bill for the infringement of a patent, the plaintiff averred that, prior to the acts charged against the respondents, the said Charles P. Allen, one of the defendants, had granted December 20, 1892, unto the Excelsior Redwood Company, a California corporation, the exclusive right within the Pacific States of manufacturing and selling wooden pipe under his patent to the full end of its term; that the Excelsior Redwood Company had, with the written consent of Allen, the patentee, on December 22, 1892, transferred unto the Excelsior Wooden Pipe Company, plaintiff, the said exclusive license to it, from Allen, with all rights and privileges thereunder, and that Allen had been, and still was, the exclusive owner of the patent, and the plaintiff the sole and exclusive licensee; that the plaintiff has ever since and still is engaged in the manufacture and sale of the patented articles, and has filled all orders therefor, and is well known as the exclusive licensee, and that Allen has joined with the plaintiff in suits against infringers of his patent, all of which have resulted in his favor. The gravaman of the bill lies in the allegation that, notwithstanding all this, the defendant, the Pacific Bridge Company, and the said Allen, have since such license conspired to make and sell, and without the license and consent of your orator, exclusive licensee as aforesaid, have made and sold, within one year last past, within the State of Washington, wooden pipe substantially the same as that described in the patent and embodying the invention; and therefore it brought this bill to recover damages for this infringement and for an injunction.

The answer, which was a joint one of both defendants, admitted the issue and validity of the patent and its ownership by defendant Allen.

It is also admitted a license by defendant Allen to plaintiff's assignor, whereby the latter obtained the exclusive right to make and sell the patented articles in the territory described, and set out the license in full; but it denied that this license was a subsisting one, and alleged an abandonment of the same by the plaintiff, a forfeiture of all rights thereunder by failure and refusal to comply with its terms and conditions, and by acts of bad faith toward the patentee by seeking to defeat the patent and destroy its monopoly; and a revocation of the license by Allen for cause in pursuance of the terms of the contract. It also set up that after the alleged revocation of the license the defendant Allen granted a license to his joint defendant, the Pacific Bridge Company. In short, the only defense was a denial of the license which lies at the basis of plaintiff's suit, and constitutes its title to the patent.

The usual replication was filed, and, pending an application on the part of defendants for an extension of time to take proofs, the plaintiff, apparently at the suggestion of the court, moved for a decree in its favor upon the pleadings and affidavits on file. Upon argument, which was upon the question of jurisdiction alone, the court held that the suit was not one arising under the patent laws, but solely out of a contract; that the court had no jurisdiction, and a decree was entered to that effect. Plaintiff thereupon appealed to the Circuit Court of Appeals, which dismissed the case upon the ground that it had no jurisdiction itself over the appeal, and that, as such appeal was prosecuted from an order dismissing the bill solely for want of jurisdiction, it should have been taken to this court. (109 Fed. Rep. 497.) Whereupon the mandate of the Circuit Court of Appeals being filed in the Circuit Court, an appeal from the final decree of that court, which had been entered November 5, 1900, was taken to this court.

Mr. Justice Brown delivered the opinion of the Court.

1. Motion is made by defendants to dismiss this appeal upon the ground that no appeal was taken, and no certificate of the trial court upon the question of jurisdiction, was made by such court during the term at which the decree was rendered; and that no such certificate has since or ever been made.

As the appeal was taken directly to this court, it must appear, under the fifth section of the Court of Appeals act, either that the question of jurisdiction was certified to this court, or that the decree appealed from shows upon its face that the sole question decided was one of jurisdiction. Plaintiff evidently supposed that the case was a proper one to carry to the Court of Appeals, but its appeal having been there dismissed, it took this appeal May 27, 1901, from the original decree of the Circuit Court made November 5, 1900. This decree, after reciting "that said suit does not really and substantially involve a dispute or controversy properly

within the jurisdiction of this court, and that this court should not further exercise jurisdiction, it is therefore ordered and decreed that said suit be and the same is hereby dismissed for want of jurisdiction." An appeal was taken from this decree, and the order allowing the appeal states that the appeal was allowed "from the final order and decree dismissing said suit for want of jurisdiction." This is clearly a sufficient certificate of the Circuit Court that the jurisdiction of that court was in issue, and the only question to be considered by us relates to the jurisdiction of that court. (*Shields* v. *Coleman*, 157 U. S. 168; *In re Lehigh Mining Co.* 156 U. S. 322; *Huntington* v. *Laidley*, 176 U. S. 668.)

The case, being thus in proper condition for appeal, such appeal could be taken at any time within two years. (*Allen* v. *Southern Pacific R. R. Co.*, 173 U. S. 479; *Holt* v. *Indiana Manfg. Co.*, 176 U. S. 68.)

2. The most important question is whether this is a suit under the patent laws of the United States within the meaning of R. S. sec. 629, sub. 9, which grants original jurisdiction to the Circuit Courts "of all suits at law or in equity arising under the patent or copyright laws of the United States." The rule is well settled that, if the suit be brought to enforce or set aside a contract, though such contract be connected with a patent, it is not a suit under the patent laws, and jurisdiction of the Circuit Court can only be maintained upon the ground of diversity of citizenship. But difficulties sometimes arise in determining whether the action be upon a contract or upon the patent. The first case involving this question was *Wilson* v. *Sandford*, (10 How. 99,) in which a bill filed on the equity side of the Circuit Court by the assignee of a patentee, to set aside a contract in the nature of a license upon the ground that the licensee had not complied with the terms of the contract, was held not to be a case under the patent laws. The object of the bill was to have the license set aside and forfeited, and plaintiff's title reinvested in him. Such was also the case in *Brown* v. *Shannon*, (20 How. 55,) which was a bill to enforce the specific execution of certain contracts respecting the use of the patent; and in *Albright* v. *Teas*, (106 U. S. 613,) which was a suit brought by the plaintiff for moneys alleged to be due under a contract whereby certain letters patent granted to him were transferred to the defendant. This was clearly a bill to recover royalties, and no question under the patent laws was involved. *Dale Tile Manfg. Co.* v. *Hyatt*, (125 U. S. 46,) was an action in a State court by the owner of the patent upon an agreement by which such owner granted an exclusive license to make and sell the patented articles within a certain territory. Defendant expressly acknowledged the validity of the patent. This, we held to be, clearly within the jurisdiction of the State court. A like ruling was made in the next case of *Felix* v. *Scharnweber*, (125 U. S. 54.) In the same line of cases are those of *Marsh* v. *Nichols*, (140 U. S. 344,) to enforce the specific performance of a contract to transfer an inter-

est in a patent to the plaintiff; *Wade* v. *Lawder*, (165 U. S. 624;) and *Pratt* v. *Paris Light & Coke Co.*, (168 U. S. 255,) which was an action by patentees in a State court upon the common counts to recover of the defendant the stipulated price for manufacturing and setting up an apparatus for the manufacture of water gas. Defendant pleaded that the plaintiff had agreed to save it harmless against any suit which might be brought against it for infringement, and to defend such suits at their own expense, and averred, among other things, that the patents were void and an infringement upon prior patents; that defendant had not kept plaintiffs harmless against such suits, but had refused to defend a certain suit brought against it, and that the defendant had rightfully rescinded the contract. It was held that the action was not one arising under the patent laws of the United States, and that to constitute such a cause the plaintiff must set up some right, title or interest under the patent laws, or at least make it appear that some right or privilege will be defeated by one construction or sustained by the opposite construction of those laws. That "section 711 does not deprive the State courts of the power to determine *questions* arising under the patent laws, but only of assuming jurisdiction of *cases* arising under those laws. There is a complete distinction between a case and a question arising under the patent laws. The former arises when the plaintiff in his opening pleading—be it a bill, complaint or declaration—sets up a right under the patent laws as ground for a recovery. Of such the State courts have no jurisdiction. The latter may appear in the plea or answer or in the testimony, The determination of such question is not beyond the competency of the State tribunals."

Now, as the bill in this case differs from an ordinary bill for infringement only in the fact that the suit is by a licensee against two defendants, one of whom is the licensor and owner of the patent, and the license is set forth only for the purpose of showing title, there would no difficulty whatever in sustaining it, were it not for the question whether we are not also bound to consider the averments of the answer. We think this difficulty is practically settled by a reference to section 5 of the Jurisdictional Statute of 1875, (18 Stat. 470, 472,) which provides "that if, in any suit commenced in a Circuit Court, . . . it shall appear to the satisfaction of the said Circuit Court, *at any time after such suit has been brought*, . . . that such suit does not really and substantially involve a dispute or controversy properly within the jurisdiction of said Circuit Court, . . . the said Circuit Court shall proceed no further therein, but shall dismiss the suit," &c. While it seems reasonable to say that a jurisdiction once acquired by the filing of a proper bill ought not to be taken away by any subsequent pleading, the statute is peremptory in this particular, and requires the court to dismiss the case whenever *at any time* it shall appear that its jurisdiction has been improperly invoked. We are by no

means without authority upon this question. In *Robinson* v. *Anderson*, (121 U. S. 522,) it was held that when it appeared, after all the pleadings were filed, that the averments in the declaration which alone gave the court jurisdiction, were immaterial and made for the purpose of creating a case cognizable by the court, it was the duty of the Circuit Court to dismiss the bill for want of jurisdiction. Said the Chief Justice: "Even if the complaint, standing by itself, made out a case of jurisdiction, which we do not decide, it was taken away as soon as the answers were in, because if there was jurisdiction at all it was by reason of the averments in the complaint as to what the defenses against the title of the plaintiffs would be, and these were of no avail as soon as the answers were filed and it was made to appear that no such defenses were relied on." In *Williams* v. *Nottawa*, (104 U. S. 209,) this court went so far as to dismiss a case in which judgment had been rendered for the plaintiff in the Circuit Court, because it appeared from the testimony of the plaintiff that certain bonds were put in his hands for collection in which he had no real interest. It was held that it was the duty of the Circuit Court on its own motion, as soon as the evidence was in and the collusive character of the case shown, to stop all further proceedings and dismiss the suit, the Chief Justice further remarking that this proviso of the act 1875 was a salutary one, and that it was the duty of the Circuit Courts to exercise their power under it in proper cases. See also *Wetmore* v. *Rymer*, (169 U. S. 115;) *Morris* v. *Gilmer*, (129 U. S. 315:) *Lake County Commissioners* v. *Dudley*, (173 U. S. 243.)

Is there anything in the answer to show that the court was bound to dismiss the bill for want of jurisdiction?

The bill makes the usual allegations of a bill for infringement, and puts in issue (1) the title of the plaintiff, which in this case was a license from one of the defendants, fully set forth in the margin;* (2) the validity of the patent; and (3) the infringement. The answer raises no issue as to the validity of the patent, or as to the acts charging infringement. It admits the license, but denies that it is a subsisting one, and pleads aban-

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*"*License and Agreement.*

This agreement, made this 11th day of March, 1893, by and between Charles P. Allen, of Denver, Colorado, party of the first part, and the Excelsior Redwood Company, a corporation duly organized and existing under and by virtue of the laws of the State of California, and having its principal place of business in the city and county of San Francisco in said State, party of the second part:

Witnesseth: That, whereas, the party of the first part is the owner and holder, for, to and in the States and Territories hereinafter mentioned, of the whole right, title and interest in and to letters patent of the United States, No. 359,590, dated March 22, 1887, for 'wooden pipe.'

And, whereas, the party of the second part is desirous of obtaining for, to and within the said States and Territories hereinafter mentioned an exclusive right,

donment of the same by plaintiff, a forfeiture of all rights thereunder by failure to comply with its terms and conditions, and by acts of gross bad faith towards the patentee by seeking to defeat the patent, and a revocation of the license by Allen. It will be observed that the answer raises no question of the construction of the license, but merely of its existence—that is, of the title of the plaintiff to sue. Before deciding that these allegations oust the jurisdiction of the court it must at least appear that the plaintiff has another remedy by an action in a State court. But what remedy has it? All the agreements and conditions of the license are such as are made by the plaintiff's assignor, the Excelsior Redwood Company. This company, the party of the second part, agrees *first*, to pay a license fee or royalty, the time of payment being fixed in a subsequent sentence; *second*, that it will neither transfer nor assign the license without the consent of the patentee, (it was admitted that the patentee consented to the assignment to plaintiff;) *third*, that in case the licensee should fail to use the patent in any pipe constructed by them, or from any cause it should cease to manufacture a wooden pipe, the license shall be at once revoked. The only clause in the license in which the patentee appears as promisor is that

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license and privilege to manufacture and sell wooden pipe under and in accordance with said letters patent:

Now, therefore, the parties have agreed as follows: The party of the first part hereby grants, subject to the conditions hereinafter stated, unto the party of the second part, its successors and assigns, the exclusive right, license and privilege, within the States of northern California, Oregon, Washington, Nevada, Montana and Idaho, and Territories of Arizona and Utah, of manufacturing and selling wooden pipe under and in accordance with the said letters patent, to the full end of the term of said letters patent.

The party of the second part agrees to pay unto the party of the first part, as a license fee or royalty under this license and agreement, the following sums to wit: One dollar ($1.00) on every one thousand feet, board measure, of lumber employed in the manufacture of said pipe, and two and one-half per cent (2½%) on the cost at factory of all steel and iron used in said manufacture.

The said license or royalty is to be paid by the said party of the second part to the said party of the first part upon the final payment to the party of the second part of the contract price on each and every contract taken by said party of the second part, involving the manufacture and sale of said patented wooden pipe. The right, license and privilege hereby granted is not transferable or assignable, either in whole or part, by the party of the second part, without the consent of the party of the first part. It is agreed that in case the party of the second part shall fail to use the above-described patent in any pipe constructed by them, of twelve (12) inches diameter and upwards, or from any cause the said party of the second part shall cease the manufacture of wooden pipe, then and in that event all rights and privileges granted by this agreement and license to the said party of the second part shall at once be revoked.

It is understood and agreed that this agreement is binding upon the heirs, legal representatives and assigns of the party of the first part, and upon the successors and assigns of the party of the second part."

wherein "he hereby grants, subject to the conditions hereinafter stated, unto the party of the second part, its successors and assigns, the exclusive right, license and privilege within" certain States "of manufacturing and selling wooden pipe under and in accordance with the said letters patent to the full end of the term of said letters patent."

Now, it may be freely conceded that, if the *licensee* had failed to observe any one of the three conditions of the license, the *licensor* would have been obliged to resort to the State courts either to recover the royalties, or to procure a revocation of the license. Such suit would not involve any question under the patent law.

But the same does not hold good with respect to the *licensee*. There were practically but two ways in which the patentee could impair the grant he made to the licensee, and those were by a revocation of the license by a bill in equity, or by treating it as abandoned and revoked, and granting a license to another party. He elected the latter remedy, and made a contract with the Pacific Bridge Company to make and sell wooden pipe within the same territory. A suit in a State court would either be inadequate or would involve questions under the patent law. If the licensee sued at law he would be obliged to establish the fact that the patent had been infringed, which the patentee might have denied, and in any case could only recover damages for past infringements. If he sued in equity, he could only pray an injunction against future infringments; but this is exactly what he prays in this case, and thereby raises a question under the patent laws. In either case the patentee could defeat the action by showing that he did not infringe,—in either case the defendant could so frame his answer as to put in issue the title, the validity or the infringement of the patent.

The natural and practically the only remedy, as it seems to us, was for the plaintiff to assert his title under the license and to prosecute the defendants as infringers. In doing this he does what every plaintiff is bound to do, namely, set forth his title either as patentee, assignee or licensee, and thereby puts that title in issue. The defendant is at liberty in such a case to deny the title of the plaintiff by declaring that the license no longer exists, but in our opinion this does not make it a suit upon the license or contract, but it still remains a suit for the infringement of a patent, the only question being as to the validity of plaintiff's title. There can be no doubt whatever that if the plaintiff sued some third person for an infringement of his patent, the defendant might attack the validity of his license in the same way, but it would not oust the jurisdiction of the court. Why should it do so in this case?

Much reliance is placed upon the case of *Hartell* v. *Tilghman*, (99 U. S. 547,) which was a bill by a *patentee* against one with whom he had made a contract in the nature of a license, alleging that defendants, after

paying the royalty for several months, refused to do certain other things which he charged to have been a part of the contract, and thereupon he forbade them further to use his patented process, and charged them as infringers. Defendants pleaded the contract as they understood it, and the tender of all that was due plaintiff under it, and their readiness to perform it.

Plaintiff's case was that there was a verbal agreement that he should prepare and put up his patented mechanism in defendants' workshop, and that after this was done defendants should take a license for the use of the invention. The machinery was put up, but defendants refused to sign the license apparently upon the ground that the patentee claimed the right to visit the works of the defendants, and inspect their books with a view to ascertaining the amount of work done. The dispute was as to the terms of the agreement, defendants insisting that they had never proposed to accept the license with the conditions mentioned. It was held that the patentee could not sue the defendants for an infringement, and in answer to the objection that he had no other remedy Mr. Justice Miller observed that he could establish his royalty once every year, and sue at law and recover every month or every year for what was due, and that, if he desired to assert his right of examining the works of the defendants, he could in a proper case compel them to submit to the examination. The case is the converse of the one under consideration, inasmuch as it was a suit by the patentee against the licensee for a violation of his contract, and, as the court observed, the plaintiff might have brought suit for royalties. As already said, the *patentee* might have done the same in this case, if he had sought to enforce his contract.

Much more nearly analogous to the case under consideration and practically upon all fours with it is that of *Littlefield* v. *Perry*, (21 Wall. 205.) This was a suit by an assignee against the patentee, who had made a conveyance to the plaintiff of his patent with all improvements thereon, within certain States, for which plaintiff had agreed to pay royalty upon all articles sold, with a clause of forfeiture in case of non-payment or neglect after due notice, to make and sell the patented articles to the extent of a reasonable demand therefor. There was by a supplementary document an agreement reserving to the patentee the right to apply the principle of his invention to one special purpose. It was held that whether the plaintiff was an assignee or a licensee, he had a right to maintain a suit for infringement in his own name in a Federal court against the *patentee*. Said the Chief Justice: "They," the plaintiffs, "certainly had the exclusive right to the use of the patent for certain purposes within their territory. They thus held a right under the patent. The claim is that this right has been infringed. To determine the suit, therefore, it is

necessary to inquire whether there has been an infringement, and that involves a construction of the patents, . . . such a suit may involve the construction of a contract as well as of a patent, but that will not oust the court of its jurisdiction. If a patent is involved, it carries with it the whole case."

Upon the subject of a licensee suing his own patentee the Chief Justice observed: "A mere licensee cannot sue strangers who infringe. In such cases redress is obtained through or in the name of the patentee or his assignee. Here, however, the patentee is the infringer, and, as he cannot sue himself, the licensee is powerless, so far as the courts of the United States are concerned, unless he can sue in his own name. A court of equity looks to the substance rather than form. When it has jurisdiction of parties it grants the appropriate relief without regard to whether they come as plaintiff or defendant. In this case the person who should have protected the plaintiff against all infringements has become himself the infringer."

White v. *Rankin*, (144 U. S. 628,) was a bill by a patentee for infringement, to which there was answer setting up an agreement between the plaintiff and one of the defendants to assign to him an interest in the patent on certain conditions, which it was alleged were performed, and certain other matters which it was alleged gave the defendants the right to make, use and sell the patented invention. The case was tried upon a stipulation admitting that defendants had made and sold the patented inventions, and that a certain written agreement between the plaintiff and one of the defendants had been made as above stated. The Circuit Court entered a decree dismissing the bill, which was reversed by this court. "It" (the court) "appears," said Mr. Justice Blatchford, "to have dismissed the bill on the simple ground that the defendant set up a contract of license from White. The bill being purely a bill for infringement, founded upon patents, what was set up by the defendants was set up as a defense and as showing the lawful right in them to do what they had done, and as a ground for the dismissal of the bill because they had not infringed the patents." The decree was not one upon the facts of the case, but was simply a decree that the court had no jurisdiction to try the case. The subject-matter of the action, as set forth in the bill, gave the court jurisdiction, and exclusive jurisdiction, to try it. All of the parties to the suit were citizens of California, and if jurisdiction did not exist under the patent laws it did not exist at all. "The Circuit Court found nothing as to the existence or validity of the contract, decree or deed mentioned in the stipulation. The stipulation provides that at the hearing the contract, complaint, answer, decree and deed set forth in the stipulation may be offered in evidence, subject to such objections as might be urged against

the originals thereof. The stipulation further states that the defendants do not admit that anything is due to the plaintiff from Thompson, and that they do admit that nothing had been paid by Thompson to the plaintiff under the decree of the State court of August 26, 1884, and since the making thereof. All these matters and questions ought to have been adjudicated by the Circuit Court before it could find ground to determine whether or not it should dismiss the bill. Until it had so adjudicated those questions the decision in the case of *Hartell* v. *Tilghman* could not apply."

The cases in the Circuit Courts and Courts of Appeal are too numerous to be analyzed, or even cited. One of the most recent and satisfactory is that of the *Atherton Machine Co.* v. *Atwood-Morrison Co.*, (102 Fed. Rep. 949,) in which it was broadly held that a suit in which the relief sought is an injunction and a recovery of damages for the infringement of a patent is one arising under the patent laws of the United States, although it incidentally involves a determination of the question of the ownership of the patent, which was claimed by both complainant and defendant under separate assignments from the patentee. All the cases cited herein are reviewed and the jurisdiction sustained.

The difficulty with the defendant's position in the case under consideration is that it apparently leaves the plaintiff without an adequate remedy. Defendant has broken no express covenant of the contract, since it has made no covenant. It has simply ignored the existence of the contract and granted a license to another party. It is difficult to see what remedy is available to the plaintiff in a State court that would not involve the right of the defendant to use the patent. In other words, it would be an ordinary suit for infringement in which the Federal courts would alone have jurisdiction. Whether it sued at law or in equity, its damages would be such as are usual in cases of infringement, and the only injunction it could obtain would be against the further use of the invention.

In any suit that could be brought the title of the plaintiff to sue must be put in issue, and, that being the title to the patent, is put in issue in every suit for infringement. We held in *Pratt* v. *Paris Light & Coke Co.*, (168 U. S. 255,) with respect to an action in a State court, which involved the question whether the patents were void and an infringement upon prior patents, that this did not necessarily oust the State court of its jurisdiction; and by parity of reasoning we hold in this case that the mere fact that the suit may involve the existence of the license does not oust the court of jurisdiction of a suit for the infringement of a patent.

While we do not intend to allow the jurisdiction of the Federal courts to be invoked primarily for the determination of the respective rights of parties to a contract concerning patents, yet when the bill is an ordinary

one for an infringement and the answer puts in issue the title of the plaintiff to sue, we think the jurisdiction is not ousted by the mere allegation that the license has been revoked and that the court is at liberty to go on and determine that fact. We regard this question as conclusively settled in *Perry* v. *Littlefield*, (21 Wall. 205,) and *White* v. *Rankin*, (144 U. S. 628,) and have no disposition to disturb it.

The decree of the Circuit Court is, therefore, *reversed*, and the case remanded to that court for further proceedings consistent with this opinion.

Mr. Justice GRAY did not sit in this case or participate in the decision.

True copy.

Test:

Clerk Supreme Court, U. S.